(27,141)

(27,201)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1919.

No. 387.

THE BALDWIN COMPANY, PETITIONER,

vs.

R. S. HOWARD COMPANY.

ON PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

No. 446.

THE BALDWIN COMPANY AND THE VALLEY GEM PIANO COMPANY, APPELLANTS,

vs.

R. S. HOWARD COMPANY.

APPEAL FROM THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

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THE BALDWIN COMPANY, Appellant,

vs.

R. S. HOWARD COMPANY.

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY Substituted) and THE BALDWIN COMPANY, Appellants,

vs.

R. S. HOWARD COMPANY.

No. 301—Application to Cancel.

In the United States Patent Office.

To the Commissioner of Patents:

In the matter of trade-mark No. 46,993, registered October 17, 1905, by The Baldwin Company of the City of Cincinnati, County of Hamilton, State of Ohio, a corporation organized and existing under the laws of the State of Ohio, formerly, and upon information and belief now, having its principal place of business at Eden Park Entrance, in said City of Cincinnati, the undersigned, R. S. Howard Company, a corporation duly organized and now existing under the laws of the State of New York, having its principal place of business at 35 West 42nd Street, in the City of New York, State of New York, deems itself injured by said registration and it hereby applies for the cancellation thereof.

The grounds for cancellation are as follows:

That applicant, said R. S. Howard Company, is the owner and entitled to the exclusive use of "Howard," as a trade-mark for pianos; that the above named The Baldwin Company, nor any other person, firm, corporation, or association, has the right to use said trade-mark, or any mark of which the word "Howard" is a principal or substantial feature or part, as a trade-mark for pianos.

That in the year 1889, and prior thereto, one Robert S. Howard was engaged in the City of New York, State of New York, in the sale of pianos manufactured for him, and in the year 1889 the said Howard adopted "Howard" as his trade-mark for the pianos manufactured for him and sold by him; that the said Howard continued to have manufactured and continued to sell pianos and to mark the same with said trade-mark from the time of the adoption of said trade-mark, as aforesaid, continuously until and up to the time said Howard sold, assigned and transferred said trade-mark, together with his said business of manufacturing and selling pianos to the above named R. S. Howard Company; that said Robert S. Howard sold, assigned and transferred said trade-mark, together and as a

part of his said business, to said R. S. Howard Company in the year 1902; that the said R. S. Howard Company has continued the said business of said Robert S. Howard and has continued to manufacture and to sell pianos, and has continued to mark pianos manufactured and sold by it with said trade-mark continuously from the time of said transfer and assignment of said business and trade-mark to it up to the present time, and is still continuing so to do; that the pianos marked with the said trade-mark and with the marks "Howard & Co.," "R. S. Howard & Co.," and "R. S. Howard Co.," of which the word "Howard" is the principal, substantial and dominant feature, now are, and for many years past and long prior to the year 1898, have been known, described and called for as "Howard" pianos, and the word "Howard" used in connection with the marking, advertisement and sale of pianos now is, and for many years past and long prior to the year 1898, has been, generally recognized by the trade and public as indicating and designating pianos manufactured, as aforesaid, and sold by applicant and his predecessor in business.

That applicant is injured by said registration sought to be cancelled, in that said mark registered October 17, 1905, No. 46,993, by said The Baldwin Company, is a simulation and colorable imitation of applicant's trade-marks and such near resemblance thereto as is calculated to deceive and mislead purchasers and thereby deprives applicant of profits, property and rights to which it is rightfully entitled.

That the said registration No. 46,993, registered October 17, 1905, by the said The Baldwin Company, is such a simulation, imitation and near resemblance to applicant's trade-mark as to prevent the registration in the United States Patent Office of applicant's said trade-marks, to which registration applicant is lawfully entitled and would be entitled except for said unlawful registration No. 46,993, and registration No. 31,411, registered March 8, 1898, by The Valley Gem Piano Company; that applicant is making application, concurrently herewith, to cancel said registration No. 31,411; that said unlawful registrations No. 46,993 and 31,411 deprive applicant of property and rights in and to its said trade-marks to which applicant is lawfully entitled.

Wherefore, applicant hereby makes application for the cancellation of said registration No. 46,993, registered October 17, 1905, by the said The Baldwin Company.

[R. S. Howard Company Corporate Seal, 1902, N. Y.]

R. S. HOWARD COMPANY,
By ROBT. S. HOWARD,
President.

Attest:
EDWARD M. BACKUS, Jr.,
Secretary.

SAMUEL S. WATSON,
Attorney for Applicant,
Office & Post Office Address,
32 *Nassau Street, New York, N. Y.*
ARNOLD L. DAVIS, *Of Counsel.*

STATE OF NEW YORK,
County of New York, ss:

Robert S. Howard, being duly sworn, deposes and says, that he is the president of the R. S. Howard Company, the applicant herein, and he has read the foregoing application and knows the contents thereof, and that the same is true of his own knowledge except as to the matters therein stated to be alleged on information and belief, and as to those matters he believes it to be true.

That the applicant is a corporation, and the reason why this verification is not made by the applicant is because of that fact. That deponent's knowledge and the grounds for his information and belief are derived from his participation in the management of the business of applicant as its president, and deponent is the same Robert S. Howard who adopted said trade-mark and assigned and transferred it in connection with his former business to applicant, all as stated in the foregoing application.

ROBT. S. HOWARD.

Sworn to before me this 29th day of July, 1914.
[NOTARIAL SEAL.] ANSELM P. ANDERSON,
Notary Public, Kings County, No. 90.

Certificate filed in New York County No. 39.
Register's No. Kings County 7609.
New York County 5112.
Term expires March 30, 1915.

In the United States Patent Office.

Before the Examiner of Interferences.

In re Cancellation No. 301.

R. S. HOWARD COMPANY, Petitioner,

vs.

THE BALDWIN COMPANY, Registrant.

Answer.

To the Honorable Commissioner of Patents:

The answer of The Baldwin Company, hereinafter called the registrant, to the application for cancellation of its trade-mark registration No. 46,993, dated October 17th, 1905, consisting of the word "Howard" for pianos, filed by R. S. Howard Company, hereinafter called the petitioner, in the above entitled cause.

The registrant, The Baldwin Company, a corporation duly created, organized and existing under and by virtue of the laws of the State

of Ohio, located and doing business at 142 West Fourth Street, in the City of Cincinnati, State of Ohio, now and at all times hereafter saving and reserving unto itself any and all manner of benefit and advantage of exception which may be had or taken to the manifold errors, uncertainties, ambiguities, insufficiencies and other imperfections in the petitioner's said application for cancellation contained, nevertheless, in answer unto the same or to so much and such parts thereof as this registrant is advised it is material or necessary for it to make answer to, answering says:

1. That it is the owner of the trade-mark registered in the U. S. patent Office on October 17th, 1905, Certificate of Registration No. 46,993, consisting of the word "Howard" for pianos.

2. That it has no knowledge or information other than from said petition for cancellation as to the corporation R. S. Howard Company, or whether or not it was duly organized and now exists under the laws of the State of New York, or whether or not it has its principal place of business at 35 West Forty-second Street, in the City of New York, State of New York, and cannot admit or deny the allegations of said petition relative thereto, and insists that the petitioner make strict proof thereof.

3. This registrant, further answering, denies that the petitioner R. S. Howard Company, is the owner and entitled to the exclusive use or any right to use the word "Howard" as a trade-mark for pianos and alleges that The Baldwin Company, the registrant, is the owner and entitled to the exclusive use of "Howard" as a trade-mark for pianos, and denies that the petitioner, R. S. Howard Company, or any other person, firm, corporation or association has the right to use the word "Howard" as a trade-mark for pianos, denying each and every allegation to the contrary contained in said petition for cancellation.

4. Further answering, this registrant says that it has no knowledge or information other than said petition for cancellation as to the business of Robert S. Howard in the year 1889 and prior thereto, or whether or not at that time he was engaged in the City of New York, State of New York, in the sale of pianos manufactured for him or whether or not in the year 1889 the said Howard adopted "Howard" as his trade-mark for the pianos manufactured for him and sold by him, and therefore calls for strict proof of said allegations. This registrant, however, denies that the said Howard continued to have manufactured and continued to sell pianos and to mark the same with the said trade-mark from the time of the alleged adoption of said trade-mark continuously until and up to the time of the alleged sale by Howard and transfer of said trade-mark together with his alleged business of manufacturing and selling pianos, to the petitioner, R. S. Howard Company; denies that the said Robert S. Howard owned the trade-mark "Howard" at the time of the alleged sale; denies that the said Robert S. Howard had any business or good-will in the use of the trade-mark "Howard" which might or could have

been assigned by him to the said R. S. Howard Company in the year 1902; but as to whether or not the said R. S. Howard Company has continuously, since 1902, manufactured and sold pianos, and has continuously marked the pianos manufactured and sold by it with the said trade-mark, from the time of said alleged transfer and pretended assignment of said alleged business and trade-mark up to the present time, and is still continuing so to do, this registrant has no information sufficient to form a belief, and therefore calls for strict proof of said allegations; but this registrant denies that the pianos marked with said alleged trade-mark and with the marks "Howard & Co.," "R. S. Howard & Co.," and "R. S. Howard Co.," are now or for many years past, or prior to the year 1898, have been known, described and called for as "Howard" pianos; denies that the word "Howard," used in connection with the marking, advertisement and sale of pianos, now is or for many years past or prior to the year 1898, has been generally recognized by the trade and public as indicating and designating pianos manufactured by Robert S. Howard or by R. S. Howard Company, the petitioner.

5. This registrant, further answering, denies that the petitioner, R. S. Howard Company, has been injured by the registration sought to be cancelled; denies that the petitioner, R. S. Howard Company, is the owner and entitled to the use of any trade-mark of which the said mark registered October 17th, 1905, No. 46,993, by this registrant, The Baldwin Company, is a simulation and colorable imitation; denies that any trade-mark of which R. S. Howard Company is the owner and entitled to the exclusive use, bears such near resemblance to the registrant's said trade-mark as to be calculated to deceive or mislead purchasers; and denies that the petitioner, R. S. Howard Company, has been deprived of any profits, property and rights to which it is rightfully entitled on account of the ownership, use and registration by The Baldwin Company of its said trade-mark No. 46,993, dated October 17th, 1905.

6. Further answering, this registrant denies that the petitioner, R. S. Howard Company, is lawfully entitled to the ownership, use or registration of any trade-mark which is a simulation and colorable imitation of said trade-mark registered October 17th, 1905, No. 46,993, by The Baldwin Company, or said trade-mark registered March 8th, 1898, No. 31,411, by The Valley Gem Piano Company, or lawfully entitled to the registration in the U. S. Patent Office of any trademark identical or substantially identical with the said registered mark owned and in use by The Baldwin Company and appropriated to merchandise of the same descriptive properties, or which so nearly resembles said registered trade-mark as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.

7. Upon information and belief, this registrant alleges that neither Robert S. Howard, nor his alleged successor in business, R. S. Howard Company, the petitioner, have ever used the word "Howard" as a trade-mark for pianos, but have only used the names "R. S. How-

ard," "Howard & Co.," "R. S. Howard & Co.," and "R. S. Howard Co.," merely to inform the public that the pianos were made by or for Robert S. Howard or R. S. Howard Company, and that the petitioner for cancellation has failed to show such an interest in the trade-mark "Howard" as entitles it to be heard in this cause.

8. Further answering, this registrant, The Baldwin Company, alleges that in or about the year 1896 or 1897, its predecessor in business, The Valley Gem Piano Company, began to manufacture a high grade cheap piano, and desiring to identify and distinguish its said pianos and to differentiate the same from all other pianos by whomsoever made or sold and to give to its pianos a well-defined individuality, did on or about the 15th day of December, 1896, and in advance of all others, devise, originate, appropriate, adopt, apply and use as a trade-mark for the said pianos manufactured and sold by it, the word "Howard" printed in distinctive ornamental type, resembling Old English, the capital "H" at the beginning of the word being of peculiar ornamental design having a depending tail from the upper end of the left vertical bar and from the lower end of the right vertical bar and having vertical lines crossing the cross-bar of the "H," all of the letters having pointed lateral projections in the centers of all vertical bars, which word was accompanied by the initials "V. G. P. Co." of The Valley Gem Piano Company, in the form of a monogram; that in order to secure unto itself all and singular the advantages, privileges, rights and security afforded by the Trade-Mark Act then in existence, The Valley Gem Piano Company on the 15th day of November, 1897, filed in the office of the Commissioner of Patents in the U. S. Patent Office an application for the registration of said trade-mark and after due proceedings had in the Patent Office, a Certificate of Registration was duly issued to The Valley Gem Piano Company on March 8th, 1898, No. 31,411, a specimen of said trade-mark being attached hereto marked "Exhibit A"; that during the year 1896 or 1897 Lucien Wulsin, president of The Valley Gem Piano Company and a member of the firm of D. H. Baldwin & Company, selling agents for The Valley Gem Piano Company, made a verbal agreement with Robert S. Howard, who was then in the employ of J. & C. Fischer, to sell, on commission for D. H. Baldwin & Company, the said "Howard" pianos manufactured by The Valley Gem Piano Company and branded with the trade-mark "Howard" as aforesaid, but within a few months, the business having increased, other salesmen of D. H. Baldwin & Company, were employed with the knowledge of Robert S. Howard, to sell pianos of The Valley Gem Piano Company, branded with the said trade-mark "Howard," and the said Robert S. Howard did not in any way participate in the profits accruing from the sales of said pianos, nor did he receive or claim any commission upon said sales; that subsequently on or about the 9th day of January, 1899, an agreement was entered into between D. H. Baldwin & Company, on the one part, and Robert S. Howard on the other, for the sale of a full line of pianos and organs, including pianos manufactured by The Valley Gem Piano Company, bearing the said trade-mark "Howard," in

which contract the price at which the said "Howard" pianos were sold was fixed by D. H. Baldwin & Company, and at the same time, with the full knowledge of Robert S. Howard and without any objection being raised by him, other salesmen of D. H. Baldwin & Company continued to sell pianos branded by The Valley Gem Piano Company with the trade-mark "Howard," as hereinbefore set forth, and bills for all of said pianos were rendered by D. H. Baldwin & Company, the selling agents for The Valley Gem Piano Company, and the said Robert S. Howard did not in any way participate in the profits accruing from the sales of any pianos bearing the name "Howard," except those sold by him in accordance with the memorandum of agreement, dated January 9th, 1899, copy of which is attached hereto, marked "Exhibit B."

9. That from the time The Valley Gem Piano Company began on December 15th, 1896, to manufacture pianos branded with the trade-mark "Howard" as aforesaid, until the fall of 1904, or even after April 1st, 1902, when said contract, dated January 9th, 1899, was terminated by mutual consent, no claim whatsoever to the proprietorship or rights in the trade-mark "Howard" was ever made by Robert S. Howard; said pianos became known to the public by the trade-mark "Howard" solely through the manufacture of The Valley Gem Piano Company which was continued until said company was succeeded by The Baldwin Company as hereinafter set forth, and the said trade-mark indicated the manufacture of said The Valley Gem Piano Company to the trade and never at any time meant the manufacture of Robert S. Howard, nor derived any warranty from the said Howard, nor did the said Robert S. Howard make any claim to said trade-mark in any manner whatsoever until the fall of 1904 when a letter was written by him to D. H. Baldwin & Company, dated October 6th, 1904, copy of which is attached hereto marked "Exhibit C," the said letter having been personally delivered by an attorney in Cincinnati to D. H. Baldwin & Company, and a reply thereto was made on November 4th, 1904, copy of which is attached hereto marked "Exhibit D," in which L. D. Sargent, Secretary of The Ellington Piano Company, which was then making "Howard" pianos for The Baldwin Company, the said The Baldwin Company being the owner of the trade-mark "Howard" for pianos, by virtue of an assignment thereof including the business and good-will from The Valley Gem Piano Company, expressed surprise that Robert S. Howard claimed any rights in said trade-mark inasmuch as for nearly seven years, with the actual knowledge of said Robert S. Howard, the word "Howard" with the initials "V. G. P. Co." had been registered in the Patent Office of the United States and later in Canada, as the property of The Valley Gem Piano Company, and further that during the entire seven years, the said Robert S. Howard had never asserted any rights in the name "Howard" as a trade-mark or that he had any interest therein or claimed any right to prevent The Valley Gem Piano Company from using it, and moreover the said Robert S. Howard was fully aware that The Valley Gem Piano Company and its successor, The Baldwin Company, had

expended large sums of money in advertising the said pianos under the trade-mark "Howard" and that the said Howard had accepted commissions derived from the sale of the said "Howard" pianos manufactured by The Valley Gem Piano Company under its registered trade-mark.

10. That subsequently, on or about the 21st day of January, 1905, a suit was instituted in the Supreme Court of New York County by R. S. Howard Company against The Baldwin Company and The Valley Gem Piano Company, praying that the defendants and each of them be restrained and enjoined from the use of the said name "Howard" as a trade name or trade-mark, either alone or combined with any other word or words, letters or letters, in any manner, which suit was dismissed by the said R. S. Howard Company on or about the 2nd day of March, 1905; that subsequently on June 1st, 1905, two other suits praying the same relief, were instituted in the Supreme Court of New York County by R. S. Howard Company, one against The Baldwin Company and the other against Lucien Wulsin and George W. Armstrong who were the members of the firm of D. H. Baldwin & Company, both of which suits were dismissed by R. S. Howard Company on or about the 6th day of November, 1905, and no other action has been taken by the said Robert S. Howard or R. S. Howard Company by suit or otherwise to prevent The Baldwin Company, the successor in business of The Valley Gem Piano Company, from using the word "Howard" as a trade-mark for pianos from the time that the said two suits were dismissed on or about the 6th day of November, 1905, until August 6th, 1914, when the present petition for cancellation was filed in the U. S. Patent Office; and Robert S. Howard and R. S. Howard Company have therefore acquiesced in The Valley Gem Piano Company and The Baldwin Company, its successor in business, building up their trade under the trade-mark "Howard" from December 15th, 1896, to October 6th, 1904, or for a period of about eight years, without objection, and since said suits were dismissed on November 6th, 1905, for a period of nine years more, The Baldwin Company has continued to build up its rights in the said trade-mark "Howard" for pianos, before Robert S. Howard or R. S. Howard Company again broke their silence by asserting an exclusive right by filing this petition for cancellation, and under these facts it is contended on behalf of the registrant, The Baldwin Company, that it would be inequitable to arrest at this stage, the registrant's trade, and therefore the petition for cancellation should be dismissed.

11. Further answering, this registrant says that the trade-mark "Howard" for pianos has been continuously used by The Valley Gem Piano Company and its successor in business, The Baldwin Company, in interstate and foreign commerce, from the 15th day of December, 1896, down to and including the present time, said trade-mark, together with the business and good-will of the business in connection with which the same has been used, having been duly assigned, transferred and conveyed by The Valley Gem Piano Company to The Baldwin Company, and that The Baldwin Company is

Exhibit A.

now the exclusive owner of said trade-mark and the good-will and business in connection with which the same has been used since the 15th day of December, 1896.

Wherefore, this registrant, The Baldwin Company, submits that the said application for cancellation filed by R. S. Howard Company ought not to be sustained, but without admitting that any other matter contained in said application for cancellation material to be answered unto and not herein already sufficiently answered, is true of its own knowledge, information and belief, submits R. S. Howard Company is not entitled to any relief whatsoever against this registrant, and prays that the said application for cancellation be dismissed, and the said petition be denied.

All of which this registrant is ready to aver, maintain and prove as the Honorable Commissioner of Patents may direct.

[The Baldwin Co. Seal.]

THE BALDWIN COMPANY,
By G. W. ARMSTRONG, Jr.,
President.
STEUART & STEUART,
Attorneys for Registrant.

Dated at Cincinnati, Ohio, this 16th day of September, 1914.

STATE OF OHIO,
County of Hamilton, ss:

George W. Armstrong, Jr., being duly sworn, deposes and says that he is president of The Baldwin Company, the registrant named in the foregoing answer; that he has read the said answer by him subscribed, and knows the contents thereof, and that the same is true of his own knowledge except as to the matters therein stated to be alleged on information and belief, and as to those matters, he believes it to be true.

That the registrant is a corporation and the reason why this verification is not made by the registrant, is because of that fact. That deponent's knowledge and the grounds for his information and belief are derived from his participation in the management of the business of The Baldwin Company as its president, secretary of The Valley Gem Piano Company, and a member of the firm of D. H. Baldwin & Company.

G. W. ARMSTRONG, Jr.

Subscribed and sworn to before me, a Notary Public, this 16th day of September, 1914.

[SEAL.]

GEO. W. WILSON, Jr.,
Notary Public, Hamilton County, Ohio.

My commission expires Feb. 15th, 1916.

(Here follows diagram marked Exhibit A.)

Exhibit B.

Memorandum of Agreement of employment entered into this 9th day of January, A. D., 1899, between D. H. Baldwin & Co., party of the first part, and R. S. Howard, party of the second part, witnesseth as follows:

First. Said R. S. Howard is employed as traveling representative by said D. H. Baldwin & Co. at wholesale and in jobbing to dealers from January 1st, 1899, to January 1st, 1900, on the terms and conditions herein; and from and after said first day of January, 1900, until either party shall give notice to the other of his or their intention to terminate this agreement.

Second. Said R. S. Howard is to receive an allowance at the rate of $300.00 per month for the payment of all expenses incurred by him for traveling, living and otherwise while attending to the business of D. H. Baldwin & Co., and a salary at the rate of $2,500.00 per year, payable in monthly installments, and said R. S. Howard is to have such additional compensation in the way of salary and otherwise as is hereinafter provided for. The allowance of $300.00 per month is to be made during twelve months unless R. S. Howard is incapacitated for such time as to justify proportionate reduction

Third. Said R. S. Howard is to travel regularly as the interests of Messrs. D. H. Baldwin & Co. may require and as directed by them looking after the general interests of said D. H. Baldwin & Co. and the several factories controlled by the said D. H. Baldwin & Co. devoting thereto his entire time, attention and talents; excepting that he shall, at the time best suited to the interests of the business, have one month vacation out of the twelve months of each year.

Fourth. All accounts for the business done by and through said R. S. Howard shall be kept at the general office of D. H. Baldwin & Co., in the City of Cincinnati. A special account shall be kept with the business done through said R. S. Howard, crediting to such account the profit on all Pianos shipped to said R. S. Howard's trade, the profits to be the net amount received from such trade above prices to be fixed from year to year by D. H. Baldwin & Co. for the different makes and styles of pianos, according to the conditions of manufacture. There shall also be charged to this account all money paid to R. S. Howard for salary and expense provided for above and any additional allowance which may be made in the way of salary and any losses incurred of whatever nature on said R. S. Howard's trade.

Fifth. A careful inventory of the stock out on consignment and the assets properly belonging to such account, which will be called "General Wholesale," shall be made on the 31st day of December and 30th day of June of each year. Any bad or doubtful accounts

are to be charged to this account, wholly or in part, or set aside as may be determined upon by said party of the first part. Such semi-annual inventories are to be audited by one member of the firm of D. H. Baldwin & Co. with said R. S. Howard.

Sixth. After the payment of all expenses and the salary agreed upon as above stated, namely, to R. S. Howard at the rate of $2,500.00 per year and expenses at the rate of $300.00 per month and any other salaries, expenses, or charges which are properly chargeable to this "General Wholesale" Account with R. S. Howard, any profit earned in any one year shall be credited to said R. S. Howard up to an additional $1,700.00 as additional salary for his services.

Seventh. If there be net profits shown by this account in any period of one calendar year, after the payment of all expenses salaries and charges and the additional salary to R. S. Howard as provided, there shall be credited to said R. S. Howard twenty per cent of such net profits, as shown by said account, by way of additional compensation for his services; the remaining eighty per cent being the property of the said D. H. Baldwin & Co.

Eighth. The territory especially to be developed by R. S. Howard as his field of work shall be agreed upon from time to time, according to a separate memorandum and the wholesale and jobbing business secured by him to dealers in such territory will be considered as the trade on which profits are to be calculated for credit of the General Wholesale Account kept as provided above. The understanding being in the assignment of territory to R. S. Howard that he shall develop the wholesale business of D. H. Baldwin & Co. therein with the large dealers able to buy and pay for their goods and with sufficient capital to justify the arrangement with them. If any consignments are permitted by D. H. Baldwin & Co., such consignments will be only to dealers as assistance in carrying their stock and on condition that such pianos so sent shall be paid for in cash when sold. If any exceptions are made to the rule requiring payment in cash when said instrument is sold, the payment for such pianos will be according to rules fixed by said D. H. Baldwin & Co. with such collateral as may, in their judgment, be advisable.

Ninth. The assets in the said business are understood to be the property of said D. H. Baldwin & Co. and subject to their order and control, said D. H. Baldwin & Co. being only liable to the said R. S. Howard for the amount earned by him according to the terms of this agreement.

Tenth. In making up the profit account provided for above for the General Wholesale trade of R. S. Howard, where a profit is shown in excess of the regular salary provided for, the share of profit assigned to said R. S. Howard as additional compensation, shall be paid only to him in the same proportion as the whole of such profit shall have been received in cash by the said D. H. Baldwin & Co., otherwise the 20% profit so shown in favor of R. S. Howard shall remain to his credit not to be drawn (no interest to be credited

thereon) except as in the proportion as stated above out of the cash receipts of such profits.

Eleventh. In case of the death of said R. S. Howard or of the dissolution of the firm of D. H. Baldwin & Co. or the termination of this agreement from any cause, the General Wholesale Account, provided for above, shall be closed as provided for at the expiration of the period of six months: the heirs or legal representatives of said R. S. Howard choosing one appraiser and said D. H. Baldwin & Co. or, the surviving partners thereof, choosing another; the two appraisers so selected, choosing a third appraiser. The decision of a majority of said appraisers to be binding and final to said parties. On making up the profits as provided for in this paragraph, the amount to the credit of said R. S. Howard shall become payable.

D. H. BALDWIN & CO.
R. S. HOWARD.

Memorandum of Territory for the Year 1899 to R. S. Howard in His Department of General Wholesale.

First. The Howard Piano anywhere in the United States, excepting Ohio, Indiana, Kentucky, Tennessee, Virginia, West Virginia, Illinois, south of Joliet, including, however, in Ohio the towns of Marion, Wellington and Cleveland.

Second. The Baldwin, Ellington, Valley Gem and Hamilton Pianos and Organs in the New England States; the states of New York, Pennsylvania, Maryland, District of Columbia, North Carolina, South Carolina, Florida, Georgia, Colorado, Arizona, California, Nevada, Oregon, Washington, Utah, Wyoming and Montana.

Trade already being done in above territory not to be disturbed.

Third. The prices for the year 1899, on which the profit for the General Wholesale Account in this territory is to be estimated shall be as follows:

Baldwin Pianos: Style 40/175, 31/200, 32/205, 33/225, Library Style/250, Empire/250, Shield Renaissance/300, Par. Grd. mah/435, Concert Grand/600.

Ellington Pianos: Style 17/113, 18/120, 19/120, 21/130, 22/135.

Valley Gem Pianos: Style 5/85, 10/95 (oak $95).

Hamilton Pianos: Style M—solid/95 style M—veneered/100.

Hamilton Organs: On list.

Howard Pianos: Style A/85, B/90, C/95, C ven/97.

Special on C veneered $95 for Pacific Coast, Buffalo, Cleveland, Atlanta, Denver.

All above prices will be increased one dollar ($1) per month on all Pianos except Baldwin Pianos until settled for in cash when

placed on consignment. Baldwin Pianos will be increased $2.00 per month. Organs will be increased fifty (50) cents per month.

D. H. BALDWIN & CO.
R. S. HOWARD.

Notice of advance in cost given in person Oct., 1899, on new orders.

L. W.

EXHIBIT C.

New York Athletic Club,

Central Park South.

New York, October 6th, 1904.

Messrs. D. H. Baldwin & Co., Cincinnati, Ohio.

GENTLEMEN:

You will please to take notice that all license, expressed or implied by me to you to manufacture, sell or otherwise use my name, "Howard" on any pianos, is hereby cancelled.

Very truly yours,

R. S. HOWARD.

EXHIBIT D.

November 4, 1904.

Mr. R. S. Howard, New York, N. Y.

DEAR SIR:

Your letter of October 6th, 1904, to D. H. Baldwin & Co. addressed from the Athletic Club, New York, in which you say:

"You will please to take notice that all license, expressed or implied by me to you, to manufacture, sell or otherwise use my name 'Howard' on any pianos, is hereby cancelled,"

and which you served upon the firm of D. H. Baldwin & Co. in this city, was delivered to the firm about October 20th. As The Baldwin Company own all the assets of D. H. Baldwin & Co., we take it upon ourselves to answer your communication.

We were much surprised to receive your letter of October 6th, in which you assume that we are using your name under a license from you, for the manufacture and sale of pianos. As you very well know, we are not manufacturing or selling any pianos under the name of R. S. Howard or R. S. Howard & Co. or under any designation which would lead the public to believe that they are manufactured by R. S. Howard or R. S. Howard & Co., and though unnecessary, we disclaim any intention of so doing. You also know that the word "Howard" of itself is not your property, and that the word, using it in connection with the initials "V. G. P. Co." has

been used by The Valley Gem Piano Co. and its successors, on pianos for many years; further, that for nearly seven years, to your knowledge, this word "Howard," with the initials "V. G. P. Co." has been registered in the Patent Office of the United States, and later in the Government Patent Office of Canada, as the property of The Valley Gem Piano Co. and its successors. You are also aware that this trade mark belongs to The Valley Gem Piano Co., which Corporation is practically owned by The Baldwin Company, and during the entire time you have never pretended that you were the owner of the name "Howard" as a trade mark, or had any interest therein, or any right to require that we should desist from using it. You are also aware that we have expended large sums of money in advertising this piano, you yourself accepting commissions derived from the sale of the piano called "Howard" registered by The Valley Gem Piano Co. You can readily understand our astonishment at your letter also because our trade mark was used not only while you were in our employ, but prior to that time as well as since, and even prior to its registration, as above explained. Any pianos which you manufacture and sell as R. S. Howard or R. S. Howard & Co., nobody will ever make the mistake of assuming that they are pianos known as the "Howard" piano, manufactured and sold by The Valley Gem Piano Co., or any of its agents. Whether or not you assume, in sending your communication, that you can, in manufacturing pianos as R. S. Howard or R. S. Howard & Co., get the benefit of the trade we have, at great expense in advertising, established, we do not know; but we wish to notify you now that, if you attempt, in any way, shape or form, to lead the public to believe that any piano which you manufacture or sell, is the same as the "Howard" piano manufactured and sold by The Valley Gem Piano Co., or if you attempt, in any way, shape or form, to call your piano the "Howard" piano, without some designation making it plain to the public that it is not the "Howard" piano manufactured and sold by The Valley Gem Piano Co., we will hold you liable in damages for so doing, and take steps to enjoin you from so doing or in any way pirating upon our trade mark. If you believe that the pianos you are to manufacture and sell are of such distinct merit, we are unable to understand why you do not adopt some name which can in no way be mistaken by the public, even though you should state that they are pianos manufactured by R. S. Howard or R. S. Howard & Co.

Yours truly,

L. D. SARGENT,
Secretary.
Secretary The Ellington Piano Co.,
For THE BALDWIN COMPANY.

No. 301—Supplemental Application.

In the United States Patent Office.

Before the Examiner of Interferences.

In re Cancellation No. 301.

R. S. Howard Company

against

The Baldwin Company.

To the Honorable Commissioner of Patents:

Now comes the above-named applicant and says:

That on or about August 6th, 1914, the R. S. Howard Company, the above-named applicant, filed its application in the United States Patent Office to cancel trade-mark registration No. 46,993, which was designated by the Patent Office as Cancellation Proceeding No. 301; that applicant refers to said original application and prays that it may be considered and made a part hereof as if set forth at length herein.

Applicant, upon information and belief, and by way of supplement to said original application, further alleges the following, to wit:

That the above-named respondent, The Baldwin Company, who now claims that it was at the time of the filing of said original applications, ever since has been, and now is, the owner of the said trade-marks and trade-mark registrations No. 31,411 and No. 46,993, involved in the above-entitled Cancellation Proceedings, has applied to register, and in some cases has secured registration of, the word "Howard" as a trade-mark for pianos in certain foreign countries, and that applications to register the same by the said The Baldwin Company are now pending in certain other foreign countries; that certain of said applications to register the word "Howard" as a trade-mark for pianos in foreign countries are based on one or both of said registrations in the United States, to wit: No. 31,411 and No. 46,993; that registration in the United States is a necessary requirement to secure registration by the said The Baldwin Company of the said word "Howard" for pianos in certain of said foreign countries; that the effect of the registration of the word "Howard" as a trade-mark for pianos in foreign countries by the said The Baldwin Company, as aforesaid, is to prevent this applicant from selling pianos bearing its said name and trade-mark "Howard" in such foreign countries; that in certain foreign countries in which applications have been made by said The Baldwin Company to register the word "Howard" as a trade-mark for pianos, any person selling pianos bearing marks similar to, or resemblances of, registered trade-marks for pianos, renders such person liable to criminal prosecution

and the confiscation of pianos bearing names or marks similar to, or resemblances of, such registered trade-mark; that applicant is engaged in shipping and selling pianos of its manufacture which bear its name and its trade name and trade-mark "Howard" to practically all of the civilized countries of the world, and has been so engaged continuously for many years last past, and the registration by the said The Baldwin Company of the said word "Howard" as a trade-mark for pianos in foreign countries, prevents applicant from selling its pianos bearing its said name, trade-name and trade-mark in such foreign countries, to the irreparable injury of the business of this applicant.

That applicant further alleges that said alleged trade-mark involved in these cancellation proceedings, registered October 17th, 1905, No. 46,993, by said The Baldwin Company, was not such a mark as was properly or legally registrable under the trade-mark laws of the United States in force at said date, inasmuch as it is the name of an individual not written, printed, impressed or woven in some particular or distinctive manner, and inasmuch as it was not in actual and exclusive use as a trade-mark of said The Baldwin Company, or its predecessors from whom it derived title, for ten years next preceding February twentieth, nineteen hundred and five, and inasmuch as it is a geographical name, being the name of cities and towns in several of the States of the United States as well as of cities and town in foreign countries.

That by order of the Commissioner of Patents, duly entered herein, permission has been granted to file the foregoing as a supplement to the original application herein to cancel said trade-mark registration No. 46,993.

Wherefore, applicant hereby makes and files this its Supplemental Application, for the cancellation of said trade-mark Registration No. 46,993, registered October 17, 1905, by The Baldwin Company.

R. S. HOWARD COMPANY.
ROBT. S. HOWARD,
President.

STATE OF NEW YORK,
County of New York,
Southern District of New York, ss:

On this twenty-fifth day of October, 1915, before me, a Notary Public in and for the County of New York, State of New York, personally appeared Robert S. Howard, to me personally known, who, being by me duly sworn, deposes and says that he is the president and general manager of the R. S. Howard Company, the applicant herein; that he has read the foregoing Supplemental Application for cancellation and knows the contents thereof, and that the same is true of his own knowledge, except as to the matters therein stated on information and belief, and as to those matters he believes it to be true;

That the applicant is a corporation, and the reason why this verification is not made by the applicant is because of that fact; that

deponent's knowledge and the grounds for his information and belief are derived from his participation in the active management of the business of applicant as its president and general manager, and from information imparted to deponent by applicant's attorney in these proceedings.

ROBT. S. HOWARD.

Subscribed and sworn to before me this twenty-fifth day of October, 1915.

[NOTARY'S SEAL.] JOSEPH F. MEADE,
Notary Public, 13, Bronx County.

Cert. filed in N. Y. County.

SAMUEL S. WATSON,
Attorney for Applicant, Office & Post Office Address, 32 Nassau Street, New York, N. Y.

[The Commissioner of Patents, by decision filed Oct. 9, 1915, made The Baldwin Company a party to cancellation proceedings No. 302, and by decisions filed September 25, 1915, October 11, 1915, and Nov. 6, 1915, granted permission to applicant to file the following Supplemental Application in Cancellation Proceedings No. 302.]

In the United States Patent Office.

Before the Examiner of Interferences.

In re Cancellation No. 301.

R. S. HOWARD COMPANY

vs.

THE BALDWIN COMPANY.

Answer to the Supplemental Petition for Cancellation.

To the Honorable Commissioner of Patents:

The answer of The Baldwin Company hereinafter called the respondent to the supplemental petition for cancellation filed herein by the R. S. Howard Company, hereinafter called the petitioner in the above entitled cause.

This respondent refers to its answer to the original petition for cancellation and prays that said answer may be considered and made a part hereof as if set forth at length herein.

This respondent further answering admits that it now claims that it was at the time of filing the original petitions for cancellation and has ever since been and now is the owner of the trade-marks and trade-mark registrations Nos. 31,411 and 46,993 involved in cancellation proceedings Nos. 301 and 302; admits that it has applied

to register and has secured registration of the word "Howard" as a trade-mark for pianos in many foreign countries; admits that applications to register the trade-mark "Howard" are now pending in certain foreign countries although all of said applications were prepared and executed prior to respondent's knowledge of these cancellation proceedings; admits that the applications to register the word "Howard" as a trade-mark for pianos in some foreign countries are based upon its United States registration No. 46,993; admits that registration in the United States is a necessary prerequisite to registration in certain foreign countries, but in many foreign countries in which respondent's trade-mark "Howard" is registered, prior registration in the United States is unnecessary; admits that the registration of its trade-mark in foreign countries will prevent the R. S. Howard Company from selling pianos bearing the trade-mark "Howard" in certain foreign countries; admits that in certain foreign countries in which applications have been made to register its trade-mark "Howard" for pianos, persons selling pianos bearing an infringing trade-mark are liable to criminal prosecution but does not know and therefore neither admits nor denies that the laws of any foreign countries provide for the confiscation of pianos bearing names or marks similar or resembling registered trade-marks; denies upon information and belief that the R. S. Howard Company has ever sold any pianos of its manufacture bearing the trade-mark "Howard" alone without distinguishing initials in any foreign country unless in a clandestine manner and in infringement of your respondent's registered trade-mark; respondent does not know and is not advised how long the R. S. Howard Company has been continuously engaged, if at all, in shipping and selling its pianos to foreign countries; admits that the registration of respondent's trade-mark "Howard" for pianos in foreign countries prevents the petitioner from selling its pianos bearing the infringing trade-mark therein, but denies that the R. S. Howard Company is legally damaged or injured in any way by said application and registrations.

Further answering respondent alleges upon information and belief that in all the foreign countries in which it has registered or applications have been made to register the word "Howard" as a trade-mark for pianos, the respondent or its predecessors in business were shipping pianos bearing said trade-mark to such countries long prior to the date that the R. S. Howard Company began shipping pianos bearing the name "R. S. Howard Co." to said countries.

That the registration by the respondent of the word "Howard" as a trade-mark for pianos in foreign countries does not constitute a legal injury to the trade, business and good-will of the R. S. Howard Company inasmuch as the respondent or its predecessors in business on account of priority of use of the trade-mark "Howard" for pianos in all countries where registration has been effected or where applications for registration have been filed is equitably entitled to such registration; and that the action of the respondent in filing applications for the registration of the trade-mark "Howard" for pianos in foreign countries was not influenced in any way by the present cancellation proceedings as said applications were all executed prior to

the time that either the respondent or its attorney had any knowledge of the present cancellation proceedings.

Upon information and belief this respondent further alleges that the cancellation of a trade-mark duly registered in the United States Patent Office on the ground of supposed injury resulting from foreign registrations of the same mark is not authorized nor contemplated by the provisions of the Trade-Mark Act.

This respondent further answering alleges that at the time that its application was filed in the United States Patent Office which resulted in Certificate of Registration No. 46,993, dated October 17th, 1905, it was entitled to the exclusive use of the name "Howard" as a trade-mark for pianos; that the trade-mark "Howard" as described and claimed in said Certificate of Registration No. 46,993, is written in a particular or distinctive manner; and that said name "Howard" has no geographical significance whatever as applied to pianos.

That the R. S. Howard Company is estopped to deny the validity of the trade-mark in issue inasmuch as its original petition for cancellation was limited to the issue of priority of adoption and use and the R. S. Howard Company claimed the right to register the trade-mark "Howard" but for the registrations of the respondent.

That the respondent is informed and believes and therefore alleges that the R. S. Howard Company cannot change the cause of action, which has been limited to the question of priority of adoption and use, by filing only a few days before the expiration of the time to take rebuttal testimony, a supplemental petition containing allegations to the effect that the trade-mark registered by The Baldwin Company was not properly or legally registrable at the time the registration was secured and which are contrary to the intent of the original pleadings which, in effect, admitted the registrability of the mark.

Wherefore, the respondent submits that the supplemental petition for cancellation filed by the R. S. Howard Company ought not be sustained, but without admitting that any other matter contained in said supplemental application for cancellation material to be answered unto and not herein already sufficiently answered is true of their own knowledge, information and belief, submits that the R. S. Howard Company is not entitled to any relief whatsoever against this respondent and prays that the said supplemental petition for cancellation be denied.

All of which this respondent is ready to aver, maintain and prove as the Hon. Commissioner of Patents may direct.

THE BALDWIN COMPANY,
By JOHN E. CROSS,
Its Attorney.

STATE OF OHIO,
County of Hamilton, ss:

Lucien Wulsin being sworn deposes and says that he is the treasurer of the Baldwin Company, the above named respondent; that he has read the foregoing answer to the supplemental petition for cancellation and knows the contents thereof; and that the allega-

tions contained therein are true of his own knowledge except as to the matters therein stated to be alleged on information and belief and as to those matters he believes it to be true; that the respondent is a corporation and the reason why this verification is not made by the respondent is because of that fact; that deponent's knowledge and the grounds of his information and belief are derived from his active participation in the management of the business of The Baldwin Company as its treasurer.

LUCIEN WULSIN.

Subscribed and sworn to before me a notary public this 20th day of November, 1915.

[SEAL.] GEO. W. WILSON, JR.,
Notary Public.

Amendment to Supplemental Applications Nos. 301 and 302.

[By decision of the Examiner of Interferences filed herein December 31st, 1915, permission was granted to add the following allegation to the Supplemental Applications in Cancellation Proceedings No. 301 and No. 302.]

"That on or about November 29th, 1915, The Baldwin Company filed suit in equity against the R. S. Howard Company (applicant herein) in the United States District Court for the Southern District of New York, and that subpœna in said equity suit was served upon the R. S. Howard Company on or about November 29th, 1915; that The Baldwin Company (one of the respondents above named) in said equity suit alleged, as one of its causes of action, the infringement by the R. S. Howard Company of said registered trade-marks No. 31,411, dated March 8, 1898, and No. 46,993, dated October 17, 1905, which are the trade-mark registrations involved in these cancellation proceedings, and the said The Baldwin Company has prayed for three-fold damages to be recovered from the R. S. Howard Company on account of its infringement of said registered trade-marks No. 31,411 and No. 46,993; that the said certified copy of the bill of complaint in said equity suit and the affidavit of service of subpœna in said suit upon the R. S. Howard Company, now on file in these proceedings, be taken and considered as a part of the record in these proceedings as proof of this allegation, but for this purpose only."

In the United States Patent Office.

Before the Examiner of Interferences.

Cancellation No. 301.

In re R. S. Howard Company

vs.

The Baldwin Company.

Answer to the Second Supplemental Petition for Cancellation.

To the Hon. Commissioner of Patents:

The answer of The Baldwin Company, hereinafter called the respondent, to the second supplemental petition for cancellation filed herein by the R. S. Howard Company, hereinafter called the petitioner, in the above-entitled cause:

This respondent refers to its answer to the original petition for cancellation and to its answer to the supplemental petition for cancellation and prays that said answers may be considered and made a part hereof as if set forth at length herein.

This respondent admits that on or about November 29, 1915, The Baldwin Company (Registrant herein), filed a suit in equity against the R. S. Howard Company (Petitioner herein), in the United States District Court for the Southern District of New York and that subpœna in said equity suit was served upon the R. S. Howard Company on or about November 29, 1915.

This respondent alleges that the suit referred to was promptly brought in the United States Court within the jurisdiction where the defendant has its principal place of business and is committing the acts of infringement and unfair competition referred to in the Bill of Complaint, as soon as the acts complained of were brought to the knowledge of The Baldwin Company.

That the reason why the suit was not instituted previously was because The Baldwin Company or its officers were not aware until the testimony was taken in these cancellation proceedings that the R. S. Howard Company was committing the acts of infringement and the acts of unfair competition in trade set forth in the Bill of Complaint, inasmuch as when the R. S. Howard Company was organized by Robert S. Howard, a former salesman of D. H. Baldwin & Co., the predecessors in business of The Baldwin Company, so far as The Baldwin Company or its officers had any knowledge, all pianos manufactured for or by the R. S. Howard Company were distinguished from the "Howard" pianos manufactured by The Baldwin Company and its predecessors in business by being conspicuously marked on the fall-board and metal plate thereof with the full name "R. S. Howard Co., New York," and the said pianos have always been universally described as made and sold by the "R. S. Howard

Co., New York," and generally referred to as "R. S. Howard" or "R. S. Howard Co." pianos in all of the catalogues issued by the R. S. Howard Company and had always been so described and referred to in all of the advertisements of the R. S. Howard Company until within the last few months as "R. S. Howard" and "R. S. Howard Co." pianos and the pianos manufactured for or sold by the R. S. Howard Company have always been referred to in the various piano trade directories and piano buyers' guides as "R. S. Howard" and "R. S. Howard Co." pianos;

That the testimony recently taken in these cancellation proceedings disclosed for the first time to The Baldwin Company and its officers that after having for years acquiesced in the exclusive rights of The Baldwin Company in and to the trade-mark "Howard" and wholly without the consent of The Baldwin Company and well knowing the aforesaid rights of The Baldwin Company and since those rights were acquired, the R. S. Howard Company wilfully and unlawfully offered and sold pianos of its own manufacture marked on the fall-board with the name "R. S. Howard Co." in response to orders for "Howard" pianos and rendered to the customers making such purchases, accounts of sales, describing the pianos so sold and delivered as "Howard" pianos and has, when required by its trade, marked the name "Howard" alone upon pianos of its manufacture, thereby enabling the dealers to deceive the ultimate consumer into the mistaken belief that he is obtaining a well-known "Howard" piano manufactured and sold by The Baldwin Company and its predecessors in business.

Respondent admits that as one of its causes of action in said equity suit infringement is alleged by the R. S. Howard Company of the registered trade-marks Nos. 31,411, dated March 8, 1898, and 46,993, dated October 17, 1905, which are the trade-mark registrations involved in these proceedings, but that the jurisdiction of the Court in said equity suit is also invoked to enjoin unfair competition in trade, said suit being between citizens of different States, and to enjoin the infringement of the trade-mark and trade-name "Howard" which, it is alleged in the Bill of Complaint, now has universally a secondary meaning both to the public and in the trade as a designation of pianos manufactured by The Baldwin Company and its predecessors in business.

Respondent admits that The Baldwin Company has prayed for threefold damages to be recovered from the R. S. Howard Company on account of its infringement of said registered trade-marks, but alleges that in said Bill of Complaint it was prayed that The Baldwin Company be adjudged to be the true, lawful and sole owner and entitled to the exclusive use of the word "Howard" as applied to pianos as a trade-mark and trade-name; that the R. S. Howard Company, its officers, attorneys, agents, etc., be enjoined from directly or indirectly making or causing to be made, selling or causing to be sold or offering for sale, marking or advertising or describing either in correspondence with customers, in bills rendered or in conversation with customers, any pianos as "Howard" pianos (other than those manufactured and sold by The Baldwin Company) without clearly

indicating that said pianos are not the product of The Baldwin Company or its predecessors in business but the product of the R. S. Howard Company; also from palming or passing off or attempting to palm or pass off pianos not made or sold by The Baldwin Company as and for The Baldwin Company's pianos and from any and every violation and infringement of the rights of The Baldwin Company and all acts constituting unfair competition in trade with The Baldwin Company's business and trade.

Further answering this respondent alleges that the said suit was brought in good faith and it is its intention to prosecute same vigorously.

Upon information and belief respondent states that the R. S. Howard Company is not legally damaged or injured as contemplated by the Cancellation Clause of the Trade-Mark Act by the filing of said suit.

All of which this respondent is ready to aver, maintain and prove as the Hon. Commissioner of Patents may direct.

[The Baldwin Company Seal.]

THE BALDWIN COMPANY,
By LUCIEN WULSIN,
Treasurer.

STATE OF OHIO,
County of Hamilton, ss:

Lucien Wulsin being duly sworn deposes and says that he is the Treasurer of The Baldwin Company, the above-named respondent; that he has read the foregoing answer to the second supplemental petition for cancellation and knows the contents thereof; and that the allegations contained therein are true of his own knowledge except as to the matters therein stated to be alleged on information and belief and as to those matters he believes it to be true; that the respondent is a corporation and the reason why this verification is not made by the respondent is because of that fact; that deponent's knowledge and the grounds of his information and belief are derived from his active participation in the management of the business of The Baldwin Company as its treasurer.

LUCIEN WULSIN.

Subscribed and sworn to before me, a notary public, this 14th day of January, 1916.

[SEAL.]

GEO. W. WILSON, JR.,
Notary Public.

No. 302—Application to Cancel.

United States Patent Office.

To the Commissioner of Patents:

In the matter of trade-mark No. 31,411, registered March 8, 1898, by The Valley Gem Piano Company, of the City of Cincinnati,

County of Hamilton, State of Ohio, a corporation organized and existing under the laws of the State of Ohio, formerly, and upon information and belief now, having its principal place of business in said City of Cincinnati, the undersigned, R. S. Howard Company, a corporation duly organized and now existing under the laws of the State of New York, having its principal place of business at 35 West 42nd Street, in the City of New York, State of New York, deems itself injured by said registration and it hereby applies for the cancellation thereof.

The grounds for cancellation are as follows:

That applicant, said R. S. Howard Company, is the owner and entitled to the exclusive use of "Howard," as a trade-mark for pianos; that the above named The Valley Gem Piano Company, nor any other person, firm, corporation, or association, has the right to use said trade-mark, or any mark of which the word "Howard" is a principal or substantial feature or part, as a trade-mark for pianos.

That in the year 1889, and prior thereto, one Robert S. Howard was engaged in the City of New York, State of New York, in the sale of pianos manufactured for him, and in the year 1889 the said Howard adopted "Howard" as his trade-mark for the pianos manufactured for him and sold by him; that the said Howard continued to have manufactured and continued to sell pianos and to mark the same with said trade-mark from the time of the adoption of said trade-mark, as aforesaid, continuously until and up to the time said Howard sold, assigned and transferred said trade-mark, together with his said business of manufacturing and selling pianos, to the above named R. S. Howard Company; that said Robert S. Howard sold, assigned and transferred said trade-mark, together and as a part of his said business, to said R. S. Howard Company in the year 1902; that the said R. S. Howard Company has continued the said business of said Robert S. Howard and has continued to manufacture and to sell pianos, and has continued to mark pianos manufactured and sold by it with said trade-mark continuously from the time of said transfer and assignment of said business and trade-mark to it up to the present time, and is still continuing so to do; that the pianos marked with the said trade-mark and with the marks "Howard & Co.," "R. S. Howard & Co.," and "R. S. Howard Co.," of which the word "Howard" is the principal, substantial and dominant feature, now are and for many years past and long prior to the year 1898, have been known, described and called for as "Howard" pianos, and the word "Howard" used in connection with the marking, advertisement and sale of pianos now is, and for many years past and long prior to the year 1898, has been, generally recognized by the trade and public as indicating and designating pianos manufactured, as aforesaid, and sold by applicant and his predecessor in business.

That applicant is injured by said registration sought to be cancelled, in that said mark registered March 8, 1898, No. 31,411, by said The Valley Gem Piano Company, is a simulation and colorable imitation of applicant's trade-mark and such near resemblance thereto as is calculated to deceive and mislead purchasers and thereby

deprives applicant of profits, property and rights to which it is rightfully entitled.

That the said registration No. 31,411, registered March 8, 1898, by the said The Valley Gem Piano Company, is such a simulation, imitation and near resemblance to applicant's trade-mark as to prevent the registration in the United States Patent Office of applicant's said trade-mark, to which registration applicant is lawfully entitled and would be entitled except for said unlawful registration No. 31,411, and registration No. 46,993, registered October 17, 1905, by The Baldwin Company; that applicant is making application, concurrently herewith, to cancel said registration No. 46,993; that said unlawful registrations No. 31,411 and 46,993, deprive applicant of property and rights in and to its said trade-mark to which applicant is lawfully entitled.

Wherefore, applicant hereby makes application for the cancellation of said registration No. 31,411, registered March 8, 1898, by the said The Valley Gem Piano Company.

[R. S. Howard Company Corporate Seal, 1902, N. Y.]

R. S. HOWARD COMPANY,
By ROBT. S. HOWARD,
President.

Attest:
EDWARD M. BACKUS, JR.,
Secretary.
SAMUEL S. WATSON,
Attorney for Applicant,
Office & Post Office Address,
32 Nassau Street, New York, N. Y.
ARNOLD L. DAVIS,
Of Counsel.

STATE OF NEW YORK,
County of New York, ss:

Robert S. Howard, being duly sworn, deposes and says, that he is the president of the R. S. Howard Company, the applicant herein, and he has read the foregoing application and knows the contents thereof, and that the same is true of his own knowledge except as to the matters therein stated to be alleged on information and belief, and as to those matters he believes it to be true.

That the applicant is a corporation, and the reason why this verification is not made by the applicant is because of that fact. That deponent's knowledge and the grounds for his information and belief are derived from his participation in the management of the business of applicant as its president, and deponent is the same Robert S. Howard who adopted said trade-mark and assigned and transferred it in connection with his former business to applicant, all as stated in the foregoing application.

ROBT. S. HOWARD.

Sworn to before me this 29th day of July, 1914.
[NOTARIAL SEAL.] ANSELM P. ANDERSON,
Notary Public, Kings County, No. 90.

Certificate filed in New York County, No. 39.
Register's No. Kings County 7609.
New York County 5112.
Term expires March 30, 1915.

United States Patent Office.

In re Application for Cancellation of Trade-Mark Registration No. 31,411, Dated March 8, 1898, for Cabinet Grand Pianos.

No. 302.

R. S. HOWARD COMPANY
against
THE VALLEY GEM PIANO COMPANY.

To all whom it may concern:
Be it known, that the R. S. Howard Company, the above named applicant, hereby appoints Samuel S. Watson, of 32 Nassau Street, New York City, State of New York, its attorney, with full power of substitution and revocation, to prosecute this application and to do and act for the said R. S. Howard Company in all matters and things connected therewith.

Signed at New York, in the County of New York, and State of New York, this 31st day of August, nineteen hundred and fourteen.
[CORPORATE SEAL.] ROBT. S. HOWARD,
President.

Attest:
E. M. BACKUS, JR.,
Secretary.

In the United States Patent Office.

Before the Examiner of Interferences.

In re Cancellation No. 302.

R. S. HOWARD COMPANY, Petitioner,
vs.
THE VALLEY GEM PIANO COMPANY, Respondent.

Answer.

To the Honorable Commissioner of Patents:
The answer of The Howard Piano Company, formerly The Valley Gem Piano Company, its name having been changed in 1912, to

shown by the certificate attached hereto, referred to hereinafter as the respondent, to the application for cancellation of a trade-mark registration No. 31,411, dated March 8th, 1898, consisting of the word "Howard" for pianos, filed by R. S. Howard Company, hereinafter called the petitioner, in the above entitled cause.

The respondent, The Howard Piano Company, a corporation duly created, organized and existing under and by virtue of the laws of the State of Ohio, located and doing business at 142 West Fourth Street, in the City of Cincinnati, State of Ohio, formerly The Valley Gem Piano Company, its name having been changed in 1912 as shown by the certificate hereinbefore referred to, now and at all times saving and reserving unto istelf any and all manner of benefit and advantage of exception which may be had or taken to the manifold errors, uncertainties, ambiguities, insufficiencies and other imperfections in the petitioner's said application for cancellation contained, nevertheless, in answer unto the same or to so much and such parts thereof as this respondent is advised it is material or necessary for it to make answer to, answering says:

1. That The Baldwin Company, a corporation duly created, organized and existing under and by virtue of the laws of the State of Ohio, located and doing business at 142 West Fourth Street, in the City of Cincinnati, State of Ohio, is the owner of the trade-mark registered in the U. S. Patent Office on March 8th, 1898, Certificate of Registration No. 31,411, consisting of the word "Howard" for pianos, by virtue of a general conveyance on or about the 6th day of December, 1901, from The Valley Gem Piano Company to The Baldwin Company of all the business, good-will, trade-marks and other property of The Valley Gem Piano Company, but no entry was made in the Patent Office at the time of this transfer.

2. That it has no knowledge or information other than from said petition for cancellation as to the corporation R. S. Howard Company, or whether or not it was duly organized and now exists under the laws of the State of New York, or whether or not it has its principal place of business at 35 West Forty-Second Street, in the City of New York, State of New York, and cannot admit or deny the allegations of said petition relative thereto, and insists that the petitioner make strict proof thereof.

3. This respondent, further answering, denies that the petitioner, R. S. Howard Company, is the owner and entitled to the exclusive use or any right to use the word "Howard" as a trade-mark for pianos and alleges that The Baldwin Company is the owner and entitled to the exclusive use of "Howard" as a trade-mark for pianos and denies that the petitioner, R. S. Howard Company, or any other person, firm, corporation or association, except The Baldwin Company has the right to use the word "Howard" as a trade-mark for pianos, denying each and every allegation to the contrary contained in said petition for cancellation.

4. Further answering, this respondent says that it has no knowledge or information other than said petition for cancellation as to

the business of Robert S. Howard in the year 1889, and prior thereto, or whether or not at that time he was engaged in the City of New York, State of New York, in the sale of pianos manufactured for him or whether or not in the year 1889, the said Howard adopted "Howard" as his trade-mark for the pianos manufactured for him and sold by him, and therefore calls for strict proof of said allegations. This respondent, however, denies that the said Howard continued to have manufactured and continued to sell pianos and to mark the same with the said trade-mark from the time of the alleged adoption of said trade-mark continuously until and up to the time of the alleged sale by Howard and transfer of said trade-mark together with his alleged business of manufacturing and selling pianos, to the petitioner, R. S. Howard Company, denies that the said Robert S. Howard owned the trade-mark "Howard" at the time of the alleged sale; denies that the said Robert S. Howard had any business or good-will in the use of the trade-mark "Howard" which might or could have been assigned by him to the said R. S. Howard Company in the year 1902, but as to whether or not the said R. S. Howard Company has continuously, since 1902, manufactured and sold pianos, and has continuously marked the pianos manufactured and sold by it with the said trade-mark from the time of said alleged transfer and pretended assignment of said alleged business and trade-mark up to the present time, and is still continuing so to do, this respondent has no information sufficient to form a belief, and therefore calls for strict proof of said allegations; but this respondent denies that the pianos marked with said alleged trade-mark and with the marks "Howard & Co.," "R. S. Howard & Co.," and "R. S. Howard Co." are now or for many years past, or prior to the year 1898, have been known, described and called for as "Howard" pianos; denies that the word "Howard," used in connection with the marking, advertisement and sale of pianos, now is or for many years past or prior to the year 1898, has been generally recognized by the trade and public as indicating and designating pianos manufactured by Robert S. Howard or by R. S. Howard Company, the petitioner.

5. This respondent, further answering, denies that the petitioner, R. S. Howard Company, has been injured by the registration sought to be cancelled; denies that the petitioner, R. S. Howard Company, is the owner and entitled to the use of any trade-mark of which the said mark registered March 8th, 1898, No. 31,411, by The Valley Gem Piano Company, now owned by The Baldwin Company, is a simulation and colorable imitation; denies that any trade-mark of which R. S. Howard Company is the owner and entitled to the exclusive use, bears such near resemblance to said trade-mark as to be calculated to deceive or mislead purchasers; and denies that the petitioner, R. S. Howard Company has been deprived of any profits, property and rights to which it is rightfully entitled on account of the ownership and use by The Baldwin Company of its said trade-mark No. 31,411, dated March 8th, 1898.

6. Further answering, this respondent denies that the petitioner, R. S. Howard Company, is lawfully entitled to the ownership, use

or registration of any trade-mark which is a simulation and colorable imitation of said trade-mark registered October 17th, 1905, No. 46,993, by The Baldwin Company, or said trade-mark registered March 8th, 1898, No. 31,411 by The Valley Gem Piano Company, now owned by The Baldwin Company, or lawfully entitled to the registration in the U. S. Patent Office of any trade-mark identical or substantially identical with the said registered marks owned and in use by The Baldwin Company and appropriated to merchandise of the same descriptive properties, or which so nearly resembles said registered trade-marks as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.

7. Upon information and belief, this respondent alleges that neither Robert S. Howard, nor his alleged successor in business, R. S. Howard Company, the petitioner, have ever used the word "Howard" as a trade-mark for pianos, but have only used the names "R. S. Howard," "Howard & Co.," "R. S. Howard & Co.," and "R. S. Howard Co.," merely to inform the public that the pianos were made by or for Robert S. Howard or R. S. Howard Company, and that the petitioner for cancellation has failed to show such an interest in the trade-mark "Howard" as entitles it to be heard in this cause.

8. Further answering, this respondent alleges that in or about the year 1896 or 1897, The Valley Gem Piano Company, began to manufacture a high grade cheap piano, and desiring to identify and distinguish its said pianos and to differentiate the same from all other pianos by whomsoever made or sold and to give to its pianos a well-defined individuality, did on or about the 15th day of December, 1896, and in advance of all others, devise, originate, appropriate, adopt, apply and use as a trade-mark for the said pianos manufactured and sold by it, the word "Howard" printed in distinctive ornamental type, resembling Old English, the capital "H" at the beginning of the word being of peculiar ornamental design having a depending tail from the upper end of the left vertical bar and from the lower end of the right vertical bar and having vertical lines crossing the cross-bar of the "H," all of the letters having pointed lateral projections in the centers of all vertical bars, which word was accompanied by the initials "V. G. P. Co." of the Valley Gem Piano Company, in the form of a monogram; that in order to secure unto itself all and singular the advantages, privileges, rights and security afforded by the Trade-mark Act then in existence, The Valley Gem Piano Company on the 15th day of November, 1897, filed in the office of the Commissioner of Patents in the U. S. Patent Office an application for the registration of said trade-mark and after due proceedings had in the Patent Office, a Certificate of Registration was duly issued to The Valley Gem Piano Company on March 8th, 1898, No. 31,411; that during the year 1896 or 1897 Lucien Wulsin, president of The Valley Gem Piano Company and a member of the firm of D. H. Baldwin & Company, selling agents for the Valley Gem Piano Company, made a verbal agreement with Robert S. Howard, who was then in the employ of J. & C. Fischer, to sell, on commission for D. H. Baldwin & Company, the said "Howard" pianos manu-

factured by The Valley Gem Piano Company and branded with the trade-mark "Howard" as aforesaid, but within a few months, the business having increased, other salesmen of D. H. Baldwin & Company, were employed with the knowledge of Robert S. Howard, to sell pianos of The Valley Gem Piano Company, branded with the said trade-mark "Howard," and the said Robert S. Howard did not in any way participate in the profits accruing from the sales of said pianos, nor did he receive or claim any commission upon said sales; that subsequently on or about the 9th day of January, 1899, an agreement was entered into between D. H. Baldwin & Company, on the one part, and Robert S. Howard on the other, for the sale of a full line of pianos and organs, including pianos manufactured by The Valley Gem Piano Company, bearing the said trade-mark "Howard," in which contract the price at which the said "Howard" pianos were sold was fixed by D. H. Baldwin & Company, and at the same time, with the full knowledge of Robert S. Howard and without any objection being raised by him, other salesmen of D. H. Baldwin & Company continued to sell pianos branded by The Valley Gem Piano Company with the trade-mark "Howard," as hereinbefore set forth, and bills for all of said pianos were rendered by D. H. Baldwin & Company, the selling agents for The Valley Gem Piano Company, and the said Robert S. Howard did not in any way participate in the profits accruing from the sales of any pianos bearing the name "Howard," except those sold by him in accordance with the memorandum of agreement, dated January 9th, 1899.

9. That from the time The Valley Gem Piano Company began on December 15th, 1896, to manufacture pianos branded with the trade-mark "Howard" as aforesaid, until the fall of 1904, or even after April 1st, 1902, when said contract, dated January 9th, 1899, was terminated by mutual consent, no claim whatsoever to the proprietorship or rights in the trade-mark "Howard" was ever made by Robert S. Howard; said pianos became known to the public by the trade-mark "Howard" solely through the manufacture of The Valley Gem Piano Company which was continued until said company was succeeded by The Baldwin Company as hereinafter set forth, and the said trade-mark indicated the manufacture of said The Valley Gem Piano Company to the trade and never at any time meant the manufacture of Robert S. Howard, nor derived any warranty from the said Howard, nor did the said Robert S. Howard make any claim to said trade-mark in any manner whatsoever until the fall of 1904, when a letter was written by him to D. H. Baldwin & Company, the said letter having been personally delivered by an attorney in Cincinnati to D. H. Baldwin & Company, and a reply thereto was made on November 4th, 1904, in which L. D. Sargent, Secretary of The Ellington Piano Company, which was then making "Howard" pianos for The Baldwin Company, the said The Baldwin Company being the owner of the trade-mark "Howard" for pianos, by virtue of an assignment thereof including the business and good-will from The Valley Gem Piano Company, expressed surprise that Robert S. Howard claimed any rights in said trade-mark inasmuch as for

nearly seven years, with the actual knowledge of said Robert S. Howard, the word "Howard" with the initials "V. G. P. Co." had been registered in the Patent Office of the United States and later in Canada, as the property of The Valley Gem Piano Company, and further that during the entire seven years, the said Robert S. Howard had never asserted any rights in the name "Howard" as a trade-mark or that he had any interest therein or claimed any right to prevent The Valley Gem Piano Company from using it, and moreover the said Robert S. Howard was fully aware that The Valley Gem Piano Company and its successor, The Baldwin Company, has expended large sums of money in advertising the said pianos under the trade-mark "Howard" and that the said Howard had accepted commissions derived from the sale of the said "Howard" pianos manufactured by The Valley Gem Piano Company under its registered trade-mark.

10. That subsequently, on or about the 21st day of January, 1905, a suit was instituted in the Supreme Court of New York County by R. S. Howard Company against The Baldwin Company and The Valley Gem Piano Company, praying that the defendants and each of them be restrained and enjoined from the use of the said name "Howard" as a trade name or trade-mark, either alone or combined with any other word or words, letter or letters, in any manner, which suit was dismissed by the said R. S. Howard Company on or about the 2nd day of March, 1905; that subsequently on June 1st, 1905, two other suits praying the same relief, were instituted in the Supreme Court of New York County by R. S. Howard Company, one against The Baldwin Company and the other against Lucien Wulsin and George W. Armstrong who were the members of the firm of D. H. Baldwin & Company, both of which suits were dismissed by R. S. Howard Company on or about the 6th day of November, 1905, and no other action has been taken by the said Robert S. Howard or R. S. Howard Company by suit or otherwise to prevent The Baldwin Company, the successor in business of The Valley Gem Piano Company, from using the word "Howard" as a trade-mark for pianos from the time that the said two suits were dismissed on or about the 6th day of November, 1905, until August 6th, 1914, when the present petition for cancellation was filed in the U. S. Patent Office; and Robert S. Howard and R. S. Howard Company have therefore acquiesced in The Valley Gem Piano Company and The Baldwin Company, its successor in business, building up their trade under the trade-mark "Howard" from December 15th, 1896, to October 6th, 1904, or for a period of about eight years, without objection, and since said suits were dismissed on November 6th, 1905, for a period of nine years more, The Baldwin Company has continued to build up its rights in the said trade-mark "Howard" for pianos, before Robert S. Howard or R. S. Howard Company again broke their silence by asserting an exclusive right by filing this petition for cancellation, and under these facts it is contended that it would be inequitable to arrest at this stage The Baldwin Company's trade, and therefore the petition for cancellation should be dismissed.

11. Further answering, this respondent says that the trade-mark "Howard" for pianos has been continuously used by The Valley Gem Piano Company and its successor in business, The Baldwin Company, in interstate and foreign commerce, from the 15th day of December, 1896, down to and including the present time, said trade-mark having been duly assigned, transferred and conveyed by The Valley Gem Piano Company to The Baldwin Company on the 6th day of December, 1901, by a general conveyance of all the business of The Valley Gem Piano Company to The Baldwin Company, including said registered trade-mark No. 31,411, dated March 8th, 1898, together with the business and good-will of the business in connection with which same is used, and that The Baldwin Company is now the exclusive owner of said trade-mark and the good-will and business in connection with which the same has been used since the 15th day of December, 1896.

Wherefore, this respondent submits that the said application for cancellation filed by R. S. Howard Company ought not to be sustained, but without admitting that any other matter contained in said application for cancellation material to be answered unto and not herein already sufficiently answered, is true of its own knowledge, information and belief, submits that R. S. Howard Company is not entitled to any relief whatsoever against this respondent, and prays that the said application for cancellation be dismissed, and the said petition be denied.

All of which this respondent is ready to aver, maintain and prove as the Honorable Commissioner of Patents may direct.

THE HOWARD PIANO COMPANY,
By G. W. ARMSTRONG, Jr.,
President.

Attest:
FRANK A. McGEE, [SEAL.]
Secretary.
STEUART & STEUART,
Attorneys for Respondent.

Dated at Cincinnati, Ohio, this 22nd day of September, 1914.

STATE OF OHIO,
County of Hamilton, ss:

George W. Armstrong, Jr., being duly sworn, deposes and says that he is President of The Howard Piano Company, formerly The Valley Gem Piano Company, its name having been changed in 1912 as shown by the certificate attached, the respondent named in the foregoing answer; that he has read the said answer by him subscribed, and knows the contents thereof, and that the same is true of his own knowledge except as to the matters therein stated to be alleged on information and belief, and as to those matters, he believes it to be true.

That the respondent is a corporation and the reason why this verification is not made by the respondent is because of that fact. That deponent's knowledge and the grounds for his information and belief are derived from his participation in the management of the business of The Baldwin Company as its president, secretary of The Valley Gem Piano Company, a member of the firm of D. H. Baldwin & Company, and President of The Howard Piano Company.

G. W. ARMSTRONG, Jr.

Subscribed and sworn to before me, a Notary Public, this 22nd day of September, 1914.

[SEAL.]

PAUL J. HENGGE,
Notary Public, Hamilton County, Ohio.

My commission expires March 5th, 1917.

No. 302—Supplemental Application.

In the United States Patent Office.

Before the Examiner of Interferences.

In re Cancellation No. 302.

R. S. HOWARD COMPANY

against

THE VALLEY GEM PIANO COMPANY (The Howard Piano Company Substituted) and THE BALDWIN COMPANY.

To the Honorable Commissioner of Patents:

Now comes the above-named applicant and says:

That on or about August 6th, 1914, the R. S. Howard Company, the above-named applicant, filed its application in the United States Patent Office to cancel trade-mark Registration No. 31,411, which was designated by the Patent Office as Cancellation Proceeding No. 302; that applicant refers to said original application and prays that it may be considered and made a part hereof as if set forth at length herein.

Applicant, upon information and belief, and by way of supplement to said original application, further alleges the following, to wit:

That the alleged mark registered March 8th, 1898, by said The Valley Gem Piano Company, Registration No. 31,411, was never used by said The Valley Gem Piano Company as a trade-mark for pianos in commerce between the United States and foreign nations or Indian tribes prior to the 8th day of November, 1897, which was the date of the verification of the declaration forming a part of the application to register said mark by said The Valley Gem Piano Company, or prior to November 15th, 1897, which was the date said

application to register said mark by said The Valley Gem Piano Company was filed in the United States Patent Office, nor at any other time.

That the mark registered by said The Valley Gem Piano Company in the United States Patent Office, March 8th, 1898, Registration No. 31,411, has long since been abandoned by said The Valley Gem Piano Company and by each and all of its said successors in interest thereto.

That applicant further alleges that said alleged trade-mark involved in these cancellation proceedings, registered March 8th, 1898, by said The Valley Gem Piano Company, No. 31,411, is not such a mark as was properly or legally registrable under the Trade-mark laws of the United States in force at said date, inasmuch as its principal and dominating feature is the word "Howard" which is the name of an individual and also a geographical name.

That by order of the Commissioner of Patents, duly entered herein, permission has been granted to file the foregoing as a supplement to the original application herein to cancel said trade-mark Registration No. 31,411.

Wherefore, applicant hereby makes and files this, its Supplemental Application, for the cancellation of said trade-mark registration No. 31,411, registered March 8th, 1898, by The Valley Gem Piano Company.

R. S. HOWARD COMPANY.
ROBT. S. HOWARD,
President.

STATE OF NEW YORK,
County of New York,
Southern District of New York, ss:

On this twenty-fifth day of October, 1915, before me, a Notary Public in and for the County of New York, State of New York, personally appeared Robert S. Howard, to me personally known, who, being by me duly sworn, deposes and says that he is the President and General Manager of the R. S. Howard Company, the applicant herein; that he has read the foregoing Supplemental Application for cancellation and knows the contents thereof, and that the same is true of his own knowledge, except as to the matters therein stated on information and belief, and as to those matters he believes it to be true.

That the applicant is a corporation, and the reason why this verification is not made by the applicant is because of that fact; that deponent's knowledge and the grounds for his information and belief are derived from his participation in the active management of the business of applicant as its President and General Manager, and from information imparted to deponent by applicant's attorney in these proceedings.

ROBT. S. HOWARD.

Subscribed and sworn to before me this twenty-fifth day of October, 1915.

[NOTARY'S SEAL.] JOSEPH F. MEADE,
Notary Public, 13, Bronx County.

Cert. filed in N. Y. County.

SAMUEL S. WATSON,
Attorney for Applicant, Office & Post Office Address, 32 Nassau Street, New York, N. Y.

In the United States Patent Office.

Before the Examiner of Interferences.

In re Cancellation No. 302.

R. S. HOWARD COMPANY

vs.

THE VALLEY GEM PIANO COMPANY (The Howard Piano Company Substituted) and THE BALDWIN COMPANY.

Answer to the Supplemental Petition for Cancellation.

To the Hon. Commissioner of Patents:

The answer of The Valley Gem Piano Company, (The Howard Piano Company, substituted) and The Baldwin Company, hereinafter called the respondents, to the supplemental petition for cancellation filed herein by the R. S. Howard Company, hereinafter called the petitioner in the above entitled cause.

The respondents deny each and every allegation in said supplemental petition for cancellation contained and specifically replying to so much and such parts thereof as they are advised is material and necessary for them to make answer to, allege that The Valley Gem Piano Company, on December 15, 1896, and in advance of all others, adopted and used in interstate and foreign commerce, the trademark "Howard" for pianos with the full knowledge and acquiescence of Robert S. Howard, the alleged predecessor in business of the R. S. Howard Company, who was at that time selling pianos on commission for D. H. Baldwin and Company, a firm composed of D. H. Baldwin, Lucien Wulsin, A. A. Van Buren, Clarence Wulsin and George W. Armstrong, Jr., which partners incorporated and owned all the capital stock of The Valley Gem Piano Company and also incorporated and owned all of the capital stock of The Ellington Piano Company, at whose plant, in a department set aside for that purpose, the "Howard" pianos were manufactured by The Valley Gem Piano Company and sold to D. H. Baldwin & Co., who in turn sold same through their various branches and salesrooms throughout the United States and in foreign countries; and that from December 15, 1896, to the present time, The Valley Gem Piano Company and

its successor in business, The Baldwin Company, to whom said trade-mark, together with the business and good-will of the business, was duly assigned as set forth in the original answer, have continuously used said trade-mark "Howard" for pianos in commerce among the several States of the United States and between the United States and foreign nations down to the present time by having same prominently appear upon the fall-board of said pianos, on the piano plates and on the piano boxes in which the pianos were and are shipped; that The Baldwin Company is still using the trade-mark "Howard" in the manner aforesaid which has always served and still serves to indicate the origin and ownership of pianos manufactured and sold by The Baldwin Company and its predecessors in business and to distinguish same from the pianos manufactured or sold by all other piano manufacturers and dealers.

That The Valley Gem Piano Company was entitled to the lawful use of the name "Howard" as a trade-mark for pianos at the date of its application for registration thereof; that said trade-mark "Howard" was and is used purely in an arbitrary sense and never had any geographical significance; that said lawful trade-mark was and has been since December 15, 1896, continuously used by The Valley Gem Piano Company and its successor in business, The Baldwin Company, in interstate and foreign commerce as hereinbefore recited and as fully set forth in the original answer which is prayed to be taken as a part hereof and has never been abandoned; that said trade-mark "Howard" was not at the time of said registration merely the name of the applicant nor identical with a registered and known trade-mark owned by another and appropriated to the same class of merchandise nor did said trade-mark so nearly resemble some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers, and the Commissioner of Patents duly decided the lawfulness of respondent's claim to the said trade-mark by the registration thereof in the United States Patent Office on March 8, 1898, Certificate of Registration No. 31,411, which registration was effected during the term of employment of Robert S. Howard by D. H. Baldwin & Co. and with his full knowledge and acquiescence.

That the R. S. Howard Company is estopped to deny the validity of the trade-mark in issue inasmuch as its original petition for cancellation was limited to the issue of priority of adoption and use and the R. S. Howard Company claimed the right to register the trade-mark "Howard" but for the registrations of the respondents.

That the respondents are informed and believe and therefore allege that the R. S. Howard Company cannot change the cause of action, which has been limited to the question of priority of adoption and use, by filing only a few days before the expiration of the time to take rebuttal testimony, a supplemental petition containing allegations to the effect that the trade-mark registered by The Valley Gem Piano Company was not properly or legally registrable at the time the registration was secured and which are contrary to the intent of the original pleadings which, in effect, admitted the registrability of the mark.

Wherefore, the respondents submit that the supplemental petition for cancellation filed by the R. S. Howard Company ought not to be sustained but without admitting that any other matter contained in said supplemental application for cancellation material to be answered unto and not herein already sufficiently answered is true of their own knowledge, information and belief, submit that the R. S. Howard Company is not entitled to any relief whatsoever against these respondents and pray that the said supplemental petition for cancellation be denied.

All of which these respondents are ready to aver, maintain and prove as the Hon. Commissioner of Patents may direct.

THE VALLEY GEM PIANO COMPANY
(THE HOWARD PIANO COMPANY SUBSTITUTED) AND
THE BALDWIN COMPANY,
By JOHN E. CROSS,
Their Attorney.

STATE OF OHIO,
County of Hamilton, ss:

Frank A. McGee, being duly sworn, deposes and says that he is the assistant treasurer of The Baldwin Company and an officer of The Howard Piano Company, formerly The Valley Gem Piano Company, its name having been changed as shown by the certificate attached to the original answer; that he has read the foregoing answer to the supplemental petition for cancellation and knows the contents thereof; and that the allegations contained therein are true of his own knowledge except as to the matters therein stated to be alleged on information and belief and as to those matters he believes it to be true; that the respondents are corporations and the reason why this verification is not made by the respondents is because of that fact; that deponent's knowledge and the grounds of his information and belief are derived from his active participation in the management of the business of The Baldwin Company as its assistant treasurer and as an officer of The Howard Piano Company.

FRANK A. McGEE.

Subscribed and sworn to before me a notary public this 20th day of November, 1915.

[SEAL.]

GEO. W. WILSON,
Notary Public.

In the United States Patent Office.

Before the Examiner of Interferences.

Cancellation No. 302.

In re R. S. HOWARD COMPANY

vs.

THE VALLEY GEM PIANO COMPANY (The Howard Piano Company Substituted) and THE BALDWIN COMPANY.

Answer to the Second Supplemental Petition for Cancellation.

To the Hon. Commissioner of Patents:

The answer of The Valley Gem Piano Company (The Howard Piano Company, substituted) and The Baldwin Company, hereinafter called the respondents, to the second supplemental petition for cancellation filed herein by the R. S. Howard Company, hereinafter called the petitioner, in the above entitled cause:

These respondents refer to their answer to the original petition for cancellation and to their answer to the supplemental petition for cancellation and pray that said answers may be considered and made a part hereof as if set forth at length herein.

These respondents admit that on or about November 29, 1915, The Baldwin Company (Registrant herein), filed a suit in equity against the R. S. Howard Company (Petitioner herein), in the United States District Court for the Southern District of New York and that subpœna in said equity suit was served upon the R. S. Howard Company on or about November 29, 1915.

These respondents allege that the suit referred to was promptly brought in the United States Court within the jurisdiction where the defendant has its principal place of business and is committing the acts of infringement and unfair competition referred to in the Bill of Complaint, as soon as the acts complained of were brought to the knowledge of The Baldwin Company.

That the reason why the suit was not instituted previously was because The Baldwin Company or its officers were not aware until the testimony was taken in these cancellation proceedings that the R. S. Howard Company was committing the acts of infringement and the acts of unfair competition in trade set forth in the Bill of Complaint, inasmuch as when the R. S. Howard Company was organized by Robert S. Howard, a former salesman of D. H. Baldwin & Co., the predecessors in business of The Baldwin Company, so far as The Baldwin Company or its officers had any knowledge, all pianos manufactured for or by the R. S. Howard Company were distinguished from the "Howard" pianos manufactured by The Baldwin Company and its predecessors in business by being conspicuously marked on the fall-board and metal plate thereof with the full name "R. S. Howard Co., New York," and the said pianos have

always been universally described as made and sold by the "R. S. Howard Co., New York," and generally referred to as "R. S. Howard" or "R. S. Howard Co." pianos in all of the catalogs issued by the R. S. Howard Company and had always been so described and referred to in all of the advertisements of the R. S. Howard Company until within the last few months as "R. S. Howard" and "R. S. Howard Co." pianos and the pianos manufactured for or sold by the R. S. Howard Company have always been referred to in the various piano trade directories and piano buyers' guides as "R. S. Howard" and "R. S. Howard Co." pianos;

That the testimony recently taken in these cancellation proceedings disclosed for the first time to The Baldwin Company and its officers that after having for years acquiesced in the exclusive rights of The Baldwin Company in and to the trade-mark "Howard" and wholly without the consent of The Baldwin Company and well knowing the aforesaid rights of The Baldwin Company and since those rights were acquired, the R. S. Howard Company wilfully and unlawfully offered and sold pianos of its own manufacture marked on the fall-board with the name "R. S. Howard Co." in response to orders for "Howard" pianos and rendered to the customers making such purchases accounts of sales, describing the pianos so sold and delivered as "Howard" pianos and has, when required by its trade, marked the name "Howard" alone upon pianos of its manufacture, thereby enabling the dealers to deceive the ultimate consumer into the mistaken belief that he is obtaining a well-known "Howard" piano manufactured and sold by The Baldwin Company and its predecessors in business.

Respondents admit that as one of their causes of action in said equity suit infringement is alleged by the R. S. Howard Company of the registered trade-marks Nos. 31,411, dated March 8, 1898, and 46,993, dated October 17, 1905, which are the trade-mark registrations involved in these proceedings, but that the jurisdiction of the Court in said equity suit is also invoked to enjoin unfair competition in trade, said suit being between citizens of different States, and to enjoin the infringement of the trade-mark and trade-name "Howard" which, it is alleged in the Bill of Complaint, now has universally a secondary meaning both to the public and in the trade as a designation of pianos manufactured by The Baldwin Company and its predecessors in business.

Respondents admit that The Baldwin Company has prayed for threefold damages to be recovered from the R. S. Howard Company on account of its infringement of said registered trade-marks, but alleges that in said Bill of Complaint it was prayed that The Baldwin Company be adjudged to be the true, lawful and sole owner and entitled to the exclusive use of the word "Howard" as applied to pianos as a trade-mark and trade-name; that the R. S. Howard Company, its officers, attorneys, agents, etc., be enjoined from directly or indirectly making or causing to be made, selling or causing to be sold or offering for sale, marking or advertising or describing either in correspondence with customers, in bills rendered or in conversation with customers, any pianos as "Howard" pianos (other than those manufactured and sold by The Baldwin Company) without clearly

indicating that said pianos are not the product of The Baldwin Company or its predecessors in business but the product of the R. S. Howard Company; also from palming or passing off or attempting to palm or pass off pianos not made or sold by The Baldwin Company as and for The Baldwin Company's pianos and from any and every violation and infringement of the rights of The Baldwin Company and all acts constituting unfair competition in trade with The Baldwin Company's business and trade.

Further answering, these respondents allege that the said suit was brought in good faith and it is their intention to prosecute same vigorously.

Upon information and belief respondents state that the R. S. Howard Company is not legally damaged or injured as contemplated by the Cancellation Clause of the Trade-Mark Act by the filing of said suit.

All of which these respondents are ready to aver, maintain and prove as the Hon. Commissioner of Patents may direct.

THE VALLEY GEM PIANO COMPANY,
(THE HOWARD PIANO COMPANY SUBSTITUTED) AND
THE BALDWIN COMPANY,
By FRANK A. McGEE,
Secretary of The Howard Piano Company and
Assistant Treasurer of The Baldwin Company.

[The Howard Piano Company Seal.]

[The Baldwin Company Seal.]

STATE OF OHIO,
County of Hamilton, ss:

Frank A. McGee, being duly sworn, deposes and says that he is the Secretary of The Howard Piano Company, formerly The Valley Gem Piano Company, its name having been changed as shown by the certificate attached to the original answer; and Assistant Treasurer of The Baldwin Company; that he has read the foregoing answer to the second supplemental petition for cancellation and knows the contents thereof; and that the allegations contained therein are true of his own knowledge except as to the matters therein stated to be alleged on information and belief and as to those matters he believes it to be true; that the respondents are corporations and the reason why this verification is not made by the respondents is because of that fact; that deponent's knowledge and the grounds of his information and belief are derived from his active participation in the management of the business of The Baldwin Company as its Assistant Treasurer and as Secretary of The Howard Piano Company.

FRANK A. McGEE.

Subscribed and sworn to before me, a notary public, this 15th day of January, 1916.

[SEAL.]

PAUL HENGGE,
Notary Public, Hamilton County, Ohio.

My commission expires March 5th, 1917.

PORTION OF TRANSCRIPT OF RECORD.

THE BALDWIN COMPANY, Appellant,

vs.

R. S. HOWARD COMPANY.

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY Substituted) and THE BALDWIN COMPANY, Appellants,

vs.

R. S. HOWARD COMPANY.

ON PETITION FOR ALLOWANCE OF APPEAL FROM THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

2578 Paper No. 240.

Final Hearing: October 9, 1916. I. A. W.

In the United States Patent Office.

Cancellation No. 301.

R. S. HOWARD COMPANY

v.

THE BALDWIN COMPANY.

Pianos.

Registration No. 46,993. Issued Oct. 17, 1905.

Mr. Samuel S. Watson for R. S. Howard Company.
Messrs. Steuart & Steuart and Mr. John E. Cross for The Baldwin Company.

This is a petition by the R. S. Howard Company to cancel trade-mark registration No. 46,993 issued to The Baldwin Company October 17, 1905.

In another proceeding (cancellation No. 302) the R. S. Howard Company seeks to cancel trade-mark registration No. 31,411, issued to the Valley Gem Piano Company, March 8, 1898, which registration is also now owned by The Baldwin Company.

The two proceedings are so closely related, and the matters to be decided are so nearly identical, that only one record has been compiled, and the cases have been submitted and tried as one. Only one opinion will therefore be prepared, and the whole situation as it applies to both proceedings will be discussed therein.

The earlier registration (No. 31,411) was issued under the act of 1881, and is for the word "Howard," together with the letters "V G P

2579 Co" arranged in monogram, the lettering being Old English. Registration No. 46,993 was issued under the act of 1905 and is for the word "Howard" alone arranged in substantially the same type as the earlier registration. Both marks are for pianos.

After these petitions for cancellation were filed suit was brought by The Baldwin Company in the District Court of the United States for the Southern District of New York against the R. S. Howard Company, the petitioner herein, based upon the identical registrations the cancellation of which is sought in these proceedings. The suit was sustained and the court held the complainant, The Baldwin Company, entitled to the use of the word "Howard" alone on the fall-boards of pianos (The Baldwin Company v. R. S. Howard Company, 233 F. R., 439). This decision has since been sustained by the United States Circuit Court of Appeals for the Second Circuit (not yet in the Federal Reporter). It has thus been decided that The Baldwin Company is entitled to use "Howard" (*simpliciter*) while use by the R. S. Howard Company is limited to certain distinguishing characteristics such as "R. S. Howard," "Robert S. Howard," "R. S. Howard Company," or some similar phraseology clearly distinguishing from the use allowed by The Baldwin Company. By reason of the decision in the suit it is contended on behalf of The Baldwin Company that the question of the right of the R. S. Howard Company to cancel these registrations is *res adjudicata*, and that the petitions should therefore be dismissed.

While the rights of the parties with respect to use of the word "Howard" have been settled, it does not necessarily follow that the right to cancel has been determined. In fact, both the trial court and the appellate court specifically passed over the question as one unnecessary for them to decide. Judge Ward, however, one of the judges constituting the appellate court, in a concurring decision, expressed himself as clearly of the opinion that the court should go further and decide the question of the validity of the registrations. It may therefore be regarded as definitely determined by the Circuit Court of Appeals of the Second Circuit that The Baldwin Company, the registrant and defendant herein, is entitled to use the word "Howard" (*simpliciter*) upon the fall-boards of pianos, whereas the R. S. Howard Company, the petitioner herein, is restricted to the use of "R. S. Howard," "Robert S. Howard," or "R. S. Howard Company," etc. This decision is final and binding upon the parties. The exact rights of the parties as to their use of the name "Howard" are therefore now settled and determined. It is not necessary, therefore, for me to study and review the voluminous record with a view to reaching a conclusion upon this point. The matter is *res adjudicata* as between the parties.

A right, question or fact distinctly put in issue and directly determined by a court of competent jurisdiction as a ground of recovery, cannot be disputed in a subsequent suit between the same parties or their privies; and even if the second suit is for a different cause of action, the right, question or fact once so determined, must, as between the same parties or their privies, be taken as conclusively

2580 established as long as the judgment in the first suit remains unmodified.

(Southern Pacific R. R. Co. v. United States, 168 U. S., 1, p. 48.)

If the R. S. Howard Company is not entitled to use "Howard" broadly, such company is not damaged by the registration unless for some reason not considered by the court.

Among the grounds set up for cancellation it is alleged that "Howard is merely a common surname not distinctively written, and is also a geographical name, and therefore unregistrable as a trade-mark. But if it is settled that the R. S. Howard Company is not entitled to use the name "Howard," this company cannot be heard to urge such matters. It has no interest in the mark, and is in the same position as one of the general public (McIlhenny's Son v. New Iberia Extract of Tobasco Pepper Co., 133 O. G., 995; 30 App. D. C., 337; The Hump Hairpin Co. v. The De Long Hook & Eye Co., 190 O. G., 1032; 39 App. D. C., 484; Standard Brewing Company v. Interborough Brewing Co., 222 O. G., 728; 44 App. D. C., 193). The examiner is not called upon therefore to decide these matters.

It is also urged that the registration should be canceled because the name "Howard" is the essential part of the petitioner's name. But the Court of Appeals of the Second Circuit in the decision above referred to has definitely held that the registrant had used "Howard" upon its pianos long prior to the time the R. S. Howard Company began business, and that such use was with the knowledge and consent of R. S. Howard personally. The cases referred to in petitioner's brief do not go so far as to justify cancellation under such circumstances. The rule is that a party may not register as a trade-mark a word which is at the time of adoption the essential part of the name of another (The Asbestone Co. v. The Philip Carey Manufacturing Co., 200 O. G., 857; 41 App. D. C., 507); but a party cannot adopt as a part of its name the trade-mark of another, and then claim any special rights as against the trade-mark owner. While the petitioner herein claims superior rights to the name "Howard," the court in the equity suit has held otherwise.

Another ground set up as a basis for cancellation of registration No. 46,993 is that such registration is being used as a basis for securing registrations in certain foreign countries. This question was not passed upon by the court and apparently was not presented in such a way as to require consideration. Therefore, notwithstanding the fact that the petitioner is limited to the use of "R. S. Howard," "Robert S. Howard," "R. S. Howard Company," etc., the mark might nevertheless be canceled should it be shown that the registration is used to secure rights abroad which work injustice to the petitioner when the petitioner marks its goods as required by the court. In other words, if it appears that importation by the R. S. Howard Company into foreign countries of pianos marked "R. S. Howard," "Robert S. Howard," "R. S. Howard Company," etc., has been prevented, or adversely affected, by reason of

2581 The Baldwin Company's registration in such country or countries of the name "Howard" (*simpliciter*), it is believed that the petitioner would be damaged within the terms of the statute, and the registration would be canceled.

The burden of proving such injury is, however, upon the R. S. Howard Company, and the evidence which has been introduced upon this point is far from being conclusive. The Baldwin Company admits that certain registrations of the word "Howard" have been secured in various foreign states. The evidence is to the effect that the R. S. Howard Company had been doing a large piano business in certain of these countries and particularly in Cuba. It is asserted that one of this company's agents subsequently started in business for himself and secured from the United States pianos manufactured by The Baldwin Company and marked "Howard." Thereafter The Baldwin Company secured registration of the name "Howard" in Cuba, and thus prevented the R. S. Howard Company from selling pianos there. There is also testimony by an expert, on Barker, with respect to the trade-mark conditions in Latin-American countries. He states (Q. 4) that in certain of the countries prior registration in the United States is a prerequisite for citizens of the United States to secure registration in such countries, and that in certain of these countries it is a criminal offense to infringe registered trade-marks. This witness admits, however, (X Q. 40) that the mere registration of "Howard" (*simpliciter*) by The Baldwin Company ought not in certain of these states at least to prevent the sale of goods by the petitioner when marked with its full name "R. S. Howard," "Robert S. Howard," "R. S. Howard Company," etc., but makes the comment that it is not always easy in these states to actually obtain those rights which the laws are intended to secure.

Thus while the petitioner's evidence tends to convey the idea that the registration of The Baldwin Company of the word "Howard" in Cuba and elsewhere is operating to the injury of the company, the evidence fails to show how the goods which it ships or has attempted to ship into these countries were in fact marked. It is not asserted that goods marked "R. S. Howard," "Robert S. Howard," or "R. S. Howard Company," etc., have been held up and importation prevented by reason of The Baldwin Company's registration. If the goods were marked "Howard" alone and the right of entry refused, it could not be held that the petitioner was damaged, because it has no right to use the name "Howard" (*simpliciter*).

The burden of proving the right to cancel is upon the R. S. Howard Company. It has been definitely decided that said company cannot use "Howard" alone. In order to effect cancellation it must therefore show that it has in some manner been injured or is liable to be injured by The Baldwin Company's registration of "Howard" when it itself has been marking its goods as the court has held it must mark them; that is, with its full name "R. S. Howard," "Robert S. Howard," or "R. S. Howard Company," etc. This the petitioner has failed to do.

The petition is dismissed, and it is hereby recommended that

2582 registration No. 46,993, issued October 17, 1905, to The Baldwin Company, should not be canceled.

Limit of appeal: July 20, 1917.

H. E. STAUFFER,
Examiner of Interferences.

June 30, 1917.

Paper No. 176.

Final Hearing October 9, 1916. I. A. W.

In the United States Patent Office.

Cancellation No. 302.

R. S. HOWARD COMPANY

v.

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY Substituted) and THE BALDWIN COMPANY.

Pianos.

Registration No. 31,411. Issued March 8, 1898.

Mr. Samuel S. Watson for R. S. Howard Company.
Messrs. Stewart & Stewart and Mr. John E. Cross for The Valley Gem Piano Company.

This is a petition by the R. S. Howard Company to cancel trade-mark registration No. 31,411 issued to The Valley Gem Piano Company March 8, 1898, and now owned by The Baldwin Company.

In another proceeding (cancellation No. 301) the R. S. Howard Company seeks to cancel trade-mark registration No. 46,993, issued to The Baldwin Company October 17, 1905. The two proceedings are closely related, and have been submitted upon a single record. The grounds for cancellation of registration No. 46,993 are substantially identical with those urged as a basis for the cancellation of No. 31,411. With respect to No. 46,993 there is, however, one ground pleaded which is not set up as a basis for the cancellation of No. 31,411, namely, that the same has been used as a basis for securing registration abroad; No. 31,411 has not been so used. All the grounds for the cancellation of No. 31,411 have therefore been discussed and considered at length in the opinion this day made in companion cancellation No. 301. There is no necessity for a review or restatement herein of the rulings made in the other case. What has been said there applied with equal force to every ground for cancellation urged herein. And reference is made to the decision in the companion case for a full understanding of the reasons for the conclusions reached herein. The rights of the parties have been adjudicated by the decisions of the District Court of the United States for the Southern District of New York and the United States Circuit

2583 Court of Appeals for the Second Circuit. The Baldwin Company is entitled to use the name "Howard" (*simpliciter*), while use by the petitioner is limited to "R. S. Howard," "Robert S. Howard," "R. S. Howard Company," or some similar expression. The petitioner is therefore not interested in the cancellation of the name "Howard" alone unless for some reason, not considered by the courts. No such reason has been shown.

The petition is dismissed, and it is recommended that registration No. 31,411, issued to The Valley Gem Piano Company and now owned by The Baldwin Company, be not canceled.

Limit of appeal: July 20, 1917.

H. E. STAUFFER,
Examiner of Interferences.

June 30, 1917.

Docket Clerk,
Jul- 17, 1917,
U. S. Patent Office.

Case.
Intf. No. 302, Paper No. 178.

Doc.

$15, Rec'd Jul- 17, 1917. D. C. C., U. S. Pat. Office.

United States Patent Office.

Before the Commissioner of Patents.

Cancellation No. 302.

R. S. HOWARD COMPANY, Petitioner,

against

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY Substituted) and THE BALDWIN COMPANY, Respondents.

To the Commissioner of Patents:

R. S. Howard Company hereby appeals to the Commissioner of Patents, in person, from the decision of the Examiner of Interferences dated June 30th, 1917, dismissing the petition of R. S. Howard Company to cancel Trade-Mark Registration No. 31,411, issued March 8th, 1898, to The Valley Gem Piano Company, and recommending that said Trade-Mark Registration be not canceled.

The following are assigned as reasons for appeal:

1. The Examiner of Interferences erred in holding that the R. S. Howard Company is not damaged by the Registration sought to be canceled.

2. The Examiner of Interferences erred in holding that the suit brought by The Baldwin Company (Registrant) in the District Court of the United States, for the Southern District of New York, against

2584 the R. S. Howard Company (Petitioner herein) was based upon the registration hereby sought to be canceled in these proceedings.

3. The Examiner of Interferences erred in holding that the decisions of the Federal Courts of the Second Circuit, aforesaid, were *res adjudicata* in these proceedings of any rights of the parties hereto to use the name "Howard" as a mark for pianos, or *res adjudicata* of any rights of the parties in this proceeding.

4. The Examiner of Interferences erred in not sustaining the petition of the R. S. Howard Company and recommending to be canceled the registration sought to be canceled, on the grounds that:

(A) The Baldwin Company (or its predecessors in business) were not the first to adopt or use the name "Howard" as a mark or brand for pianos, but that petitioner's predecessor in business, Robert S. Howard, was the first to adopt and use the name "Howard" as a mark and brand for pianos.

(B) The petitioner and its said predecessor in business had continuously used said name "Howard" as a mark and brand for pianos since its first adoption and use by petitioner in *1889*, which was long prior to the time (1896) when The Baldwin Company claims its predecessors first adopted and used said mark.

(C) Registrant of the mark sought to be canceled (Registration No. 31,411) had never used said mark prior to its application to register the same, OR AT ANY TIME.

(D) Registrant of the mark sought to be canceled (Registration No. 31,411), prior to its application to register same, had never used said mark in commerce between the United States and foreign nations or Indian tribes.

(E) The principal and essential feature of the mark sought to be canceled (Registration No. 31,411) is the name "Howard," an individual or proper name, a common surname, and also a common geographical term, which was not registrable under the Trade-Mark Act in force at the time of its registration.

5. The Examiner of Interferences erred in not holding that The Baldwin Company did not and could not obtain any right to use the name "Howard" as a mark and brand for pianos, or any right, title or interest in or to the name "Howard" as a mark or brand for pianos, from or through The Valley Gem Piano Company.

6. The Examiner of Interferences erred in not holding that, under the positive, voluminous, corroborated, uncontradicted and unimpeached testimony, the R. S. Howard Company is entitled, as against The Baldwin Company, to the exclusive use of the name "Howard" as a mark, brand and designation for pianos, and that the decisions of the Federal Courts for the Second Circuit are contrary to the evidence and unsupported by any evidence whatsoever.

7. The Examiner of Interferences erred in not holding that the decisions of the Circuit Court of Appeals for the Second Circuit is based *not* upon prior adoption and continuous use by The Baldwin Company and its predecessors of the name "Howard" to designate pianos, but upon the "acquiescence" and "knowledge" of Robert S. Howard.

In order that the foregoing reasons of appeal may be and appear [illegible] the R. S. Howard Company presents same to the Honora-

2585 ble Commissioner of Patents and prays that such disposition be made thereof as is in accordance with justice, the laws and statutes of the United States and the rules and practice of the Patent Office in such cases made and provided.

Oral hearing is requested between October 15th and October 31st, 1917.

All of which is respectfully submitted.

Dated, New York City, July 16th, 1917.

SAMUEL S. WATSON,
Attorney for R. S. Howard Company,
No. 2 Wall Street, New York City, N. Y.

Docket Clerk,
Jul- 17, 1917,
U. S. Patent Office.

$15 Rec'd Jul- 17, 1917. D. C. C., U. S. Pat. Office.

Canc. No. 301, Paper No. 241.

D. O. C.

United States Patent Office.

Before the Commissioner of Patents.

Cancellation No. 301.

R. S. HOWARD COMPANY, Petitioner,

against

THE BALDWIN COMPANY, Registrant.

To the Honorable Commissioner of Patents:

R. S. Howard Company hereby appeals to the Commissioner of Patents, in person, from the decision of the Examiner of Interferences dated June 30th, 1917, dismissing the petition of the R. S. Howard Company to cancel Trade-Mark Registration No. 46,993, issued October 17th, 1905, to The Baldwin Company, and recommending that said Trade-Mark Registration be not canceled.

The following are assigned as reasons for appeal:

1. The Examiner of Interferences erred in holding that the R. S. Howard Company is not damaged by the Registration sought to be canceled.

2. The Examiner of Interferences erred in holding that the suit brought by The Baldwin Company (Registrant) in the District Court of the United States, for the Southern District of New York, against the R. S. Howard Company (Petitioner herein) was based upon the registration hereby sought to be canceled in these proceedings.

2586 3. The Examiner of Interferences erred in holding that the decisions of the Federal Courts of the Second Circuit, aforesaid, were *res-adjudicata* in these proceedings of any rights of the parties hereto to use the name "Howard" as a mark for pianos, or *res adjudicata* of any rights of the parties in this proceeding.

4. The Examiner of Interferences erred in holding that the evidence fails to show how the goods which petitioner shipped into foreign countries were marked.

5. The Examiner of Interferences erred in not sustaining the petition of the R. S. Howard Company and recommending to be canceled the registration sought to be canceled, on the ground that:

(A) The Baldwin Company (or its precedessors in business) were not the first to adopt or use the name "Howard" as a mark or brand for pianos, but that petitioner's predecessor in business, Robert S. Howard, was the first to adopt and use the name "Howard" as a mark and brand for pianos.

(B) The petitioner and its said predecessor in business had continuously used said name "Howard" as a mark and brand for pianos since its first adoption and use by petitioner in *1889*, which was long prior to the time (1896) when The Baldwin Company claims its predecessors first adopted and used said mark.

(C) The mark sought to be canceled (registration No. 46,993) consists merely of the name "Howard", an individual name, a common surname, and also a common geographical term, not written, printed, impressed or woven in some particular or distinctive manner, or in association with the portrait of the individual, and not registrable.

(D) The statement and declaration forming a part of the application to register the mark sought to be canceled was false, in that:

(*a*) The mark had not been used in the business of Registrant and its predecessors in business since December, 1896;

(*b*) Registrant (or its predecessors in business) had never made statutory use of the mark prior to its registration;

(*c*) The name "Howard" was never, at any time, used by Registrant (or its predecessors in business), written, printed, impressed or woven in a particular or distinctive manner.

6. The Examiner of Interferences erred in not holding that The Baldwin Company did not and could not obtain any right to use the name "Howard" as a mark and brand for pianos, or any right, title or interest in or to the name "Howard" as a mark or brand for pianos, from or through The Valley Gem Piano Company.

7. The Examiner of Interferences erred in not holding that, under the positive, voluminous, corroborative, uncontradicted and unimpeached testimony, the R. S. Howard Company is entitled, as against the Baldwin Company, to the exclusive use of the name "Howard" as a mark, brand and designation for pianos, and that the decisions of the Federal Courts for the Second Circuit are contrary to the evidence and unsupported by any evidence whatsoever.

8. The Examiner of Interferences erred in not holding that the decision of the Circuit Court of Appeals for the Second Circuit is

2587 based *not* upon prior adoption and continuous use by The Baldwin Company and its predecessors of the name "Howard" to designate pianos, but upon the "acquiescence" and "knowledge" of Robert S. Howard.

In order that the foregoing reasons of appeal may be and appear of record, the R. S. Howard Company presents same to the Honorable Commissioner of Patents and prays that such disposition be made thereof as is in accordance with justice, the laws and statutes of the United States and the rules and practices of the Patent Office in such cases made and provided.

Oral hearing is requested between October 15th and October 31st, 1917.

All of which is respectfully submitted.

Dated, New York City, July 16th, 1917.

SAMUEL S. WATSON,
Attorney for R. S. Howard Company,
No. 2 Wall Street, New York City, N. Y.

Canc.
Intf. No. 301, Paper No. 248.
Recorded Vol. 125. Page 410.

Hearing, Oct. 22, 1917. J. R. S.

In the United States Patent Office.

Cancellation Proceeding No. 301.

R. S. HOWARD COMPANY

vs.

THE BALDWIN COMPANY.

Appeal from Examiner of Interferences.

Trade-Mark of The Baldwin Company, Registered October 17, 1905, No. 46,993.

Mr. Samuel S. Watson for the R. S. Howard Company.

Messrs. Steuart & Steuart and Mr. John E. Cross for The Baldwin Company.

The R. S. Howard Company has appealed from the decision of the examiner of interferences dismissing a petition to cancel trade-mark registration No. 46,993, issued to The Baldwin Company October 17, 1905.

In another proceeding (Cancellation No. 302) the R. S. Howard Company sought to cancel trade-mark registration No. 31,411, issued to the Valley Gem Piano Company March 8, 1898, which registration is owned by The Baldwin Company.

2588 The two proceedings are closely related. Only one record has been presented and the cases have been submitted and argued as one.

Registration No. 31,411, which was issued under the Act of 1881 is for the word "Howard" in old English letters, together with the letters "V G P Co." arranged in a monogram. Registration No. 46,993, which was issued under the Act of 1905, is for the word "Howard" alone, appearing in substantially the same type as that word appears in the earlier registration. Both registrations cover the use of the marks on pianos.

After these petitions for cancellation were filed suit was brought by The Baldwin Company in the Southern District of New York against the R. S. Howard Company, based upon these same registrations and also upon its common law rights. In addition to the other relief sought the plaintiff asked the prosecution of the cancellation proceedings be restrained. The R. S. Howard Company in a cross bill asked that the registrations be held invalid.

The court denied the request for the prohibition of the prosecution of the cancellation proceedings, declined to pass upon the validity of the registrations, but held that The Baldwin Company was entitled to use the word "Howard" alone on pianos, and that the R. S. Howard Company was not entitled to use the word "Howard" also, but only the words "R. S. Howard Company," or the words "Robert S. Howard Company." The decision was affirmed on appeal, one of the judges in a concurring opinion holding that the registrations should both be declared invalid.

The examiner of interferences held that if the R. S. Howard Company is not entitled to use the word "Howard" alone, it was not damaged by the registrations unless for some reason not considered by the court. He considered the question whether the registrations were invalid by reason of the fact that "Howard" was the essential part of the petitioner's name, but held that a party could not adopt as a part of its name the trade-mark of another and then claim any special rights as against that party. He also considered the question whether the R. S. Howard Company was damaged by the use of Registration No. 46,993 by The Baldwin Company as a basis for securing registration in certain foreign countries, and held that the R. S. Howard Company had not established any such damage.

In the decision of the District Court the relation of the parties is set out at length. It appears that R. S. Howard was a piano salesman and was connected with various piano companies; that for several years he was connected with The Baldwin Company, and in 1902 organized the R. S. Howard Company and has been connected therewith ever since.

The decision in the suit determined fully the rights between these parties so far as the use of the name "Howard" is concerned. The R. S. Howard Company cannot use the word "Howard" alone, or prevent the use of the word "Howard" alone by The Baldwin Company, and The Baldwin Company cannot prevent the use by the R. S. Howard Company of the words "R. S. Howard Company," or "Robert S. Howard Company."

2589 It is well settled by a long line of decisions of the Court of Appeals of the District of Columbia that a party cannot sustain a cancellation proceeding unless he can establish that he is damaged by the registration of the mark. The rights of the parties to the use of the mark in this country having been fully determined by the court it is not seen how the rights of the R. S. Howard Company are in any way affected by the registration. No suit could be sustained against the R. S. Howard Company for any use of the words "R. S. Howard Company," or "Robert S. Howard Company," and it has no right to the use of the word "Howard" alone.

So far as the question of foreign registrations is concerned, there is no testimony that the R. S. Howard Company has in any way been interfered with in its trade in foreign countries where the pianos were marked with the name of the company, and they have under the court decree no right to mark them otherwise. One of the witnesses testified that the trade of the agent of the R. S. Howard Company in Cuba would have been interfered with had the registration of the name "Howard" in Cuba been effected by The Baldwin Company, but it does not appear whether that testimony was based upon the fact that at one time R. S. Howard had marked pianos with the word "Howard" alone or not.

The witness Barber testified that the registration of the word "Howard" in certain South American countries might put an undue burden upon the R. S. Howard Company to sustain its right to sell pianos marked with the name of the company since it would be difficult to establish that the marks were not substantially the same.

As pointed out by the examiner of interferences, however, the burden is upon the R. S. Howard Company to establish the injury and if goods marked with the name of the company had been held up or the importation prevented, it was encumbent upon the company to show it, which has not been done.

It may be noted, as appears from the record and as stated in the decisions of both courts that the earlier registration was obtained with the full knowledge of R. S. Howard; that he made no objection to its registration and he made no objection to the use of the word "Howard" by The Baldwin Company for several years after he left its employ. It is further to be noted that at one time a suit was brought in the courts of New York by R. S. Howard to prevent the use of the word "Howard" by The Baldwin Company, but this suit was withdrawn and The Baldwin Company continued to use the word "Howard" for a number of years thereafter and built up a large trade without any objection on the part of R. S. Howard or the R. S. Howard Company until the cancellation proceeding was brought in 1914.

Attention is called in the brief to the following statement of the Commissioner rendered on a petition:

It is urged that the R. S. Howard Company has not shown the injury required by the statute. But if the mark is not registrable, I think any one who is legitimately using the name "Howard"
2590 on pianos is injured by the registration sufficiently to warrant cancellation proceedings.

That decision was rendered before the decision in the suit and expressly states that the person who would be injured by the improper registration is one who was "legitimately" using the name "Howard" on pianos. But the court proceedings determines that the R. S. Howard Company has no right to use the word "Howard."

It is urged that the name "Howard" and the name "R. S. Howard Company," or "Robert S. Howard Company," are substantially the same, and therefore there would be likelihood of confusion. The best evidence, however, on this point is the fact that although The Baldwin Company has continuously used the word "Howard" since a time prior to the organization of the R. S. Howard Company and the R. S. Howard Company has been in business since 1902, yet there is on the record no proof of any confusion.

It must be held, therefore, that the petition for cancellation was properly dismissed.

The decision of the examiner of interferences is affirmed.

R. F. WHITEHEAD,
First Assistant Commissioner.

February 1, 1918.

Recorded, Vol. 125, Page 421.

Canc.
Intf. No. 302, Paper No. 184.

Hearing Oct. 22, 1917. J. R. S.

In the United States Patent Office.

Cancellation Proceeding No. 302.

R. S. HOWARD COMPANY

vs.

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY Substituted) and THE BALDWIN COMPANY.

Appeal from Examiner of Interferences.

Trade-Mark of The Valley Gem Piano Company. Registered March 8, 1898. No. 31,411.

Mr. Samuel S. Watson for the R. S. Howard Company.
Messrs. Steuart & Steuart and Mr. John E. Cross for The Valley Gem Piano Company.

The R. S. Howard Company has appealed from a decision of the examiner of interferences dismissing its petition to cancel trade-mark

2591 registration No. 31,411, issued to The Valley Gem Piano Company, which registration is owned by The Baldwin Company.

The mark consists of the word "Howard" in old English letters, together with the letters "V G P Co" arranged in a monogram, as used on pianos.

For the reasons fully pointed out in a decision this day rendered in Cancellation Proceedings No. 301, involving the same parties, it is held that the petition for cancellation was properly dismissed.

The decision of the examiner of interferences is affirmed.

R. F. WHITEHEAD,
First Assistant Commissioner.

February 1, 1918.

Docket Clerk,
Mar. 5, 1918,
U. S. Patent Office.

Mail Room,
Mar. 5, 1918,
U. S. Patent Office.

Cane.
Intf. No. 301 & 302, Paper No. 250.

United States Patent Office.

Before the Commissioner of Patents.

Trade-Mark Cancellation No. 301.

R. S. HOWARD COMPANY, Applicant,

against

THE BALDWIN COMPANY, Registrant.

Trade-Mark Application No. 302.

R. S. HOWARD COMPANY, Applicant,

against

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY, Substituted) and THE BALDWIN COMPANY, Registrants.

Now comes the R. S. Howard Company, by Samuel S. Watson, its Attorney, and gives Notice to the Commissioner of Patents of its appeal to the Court of Appeals of the District of Columbia from the decisions of the said Commissioner rendered on or about the first day of February, 1918, denying Petitioner's application to cancel Trade-Mark Registration No. 46,993, registered by The Baldwin Company October 17, 1905, and Trade-Mark Registration No. 31,411, registered by The Valley Gem Piano Company March 8, 1898, in the above entitled proceedings, and assigns as its reasons of appeal the following:

1. The Commissioner of Patents erred in holding that the R. S.

2592 Howard Company is not damaged by the said Registrations sought to be cancelled:

(*a*) By reason of The Baldwin Company (who claims to be the owner of both said Trade-Mark Registrations) sending to customers of the R. S. Howard Company threatening and intimidating letters claiming rights under said "duly registered" trade-marks, "and will take all necessary steps to protect our rights against infringement."

(*b*) By suing the R. S. Howard Company for infringement of both said registered trade-marks and claiming threefold damages for such alleged infringement under the Trade-Mark Registration Acts of Congress.

(*c*) "R. S. Howard Co." and "Howard" are substantially and deceptively similar, and damage and injury will not only *inevitably* result but will be presumed to result from their concurrent use on the same class of goods; Applicant has been adjudged entitled to use the corporate and trade-name "R. S. Howard Co." and damage will be presumed to result to it from the improper registration of "Howard."

(*d*) "Howard" being a personal name, its improper or improvident registration will be presumed to damage any person or concern entitled to use the name "Howard" in any form as its trade or business name in the same line of business; pianos marked "Howard," or with any prefix or suffix, or with any variant of "Howard," have always been and always will be commonly known and spoken of as "Howard" pianos.

(*e*) Because the registration of the name "Howard" is *prima facie* evidence of *exclusive* ownership, as a *valid trade-mark*, and, as such, *prima facie* entitles the owner to the *exclusive* use of the name "Howard" as a mark for pianos, i. e., "Howard" in any form, whether used *simpliciter*, or with prefixes or suffixes; if a valid trade-mark, the use of "R. S. Howard Co." or "R. S. Howard Company" on pianos would be *prima facie* infringements.

(*f*) The word "Howard" is the dominant and distinguishing feature of Applicant's corporate name, and the proofs show that the registrants did not make trade-mark use of the name "Howard" until 1912.

(*g*) By registering in a number of foreign countries, in which the R. S. Howard Company has a long established business, the name "Howard" as a trade-mark for pianos, such foreign registrations being based on the United States Registration, said name "Howard" being the dominant part of Applicant's corporate and trade-name and marked on its goods, which name Applicant has been adjudged entitled to use.

2. The Commissioner of Patents erred in holding that Applicant had failed to show sufficient interest in the subject-matter to entitle it to maintain these cancelation proceedings, and in not holding that the probability or "likelihood of confusion" is sufficient.

3. The Commissioner of Patents erred in not holding that in Cancellation proceedings where the mark is a non-technical mark,

2593 such as a personal name, the questions of first use, abandonment and acquiescence are immaterial.

4. The Commissioner of Patents erred in holding that the decisions of the Federal Courts of the Second Circuit, aforesaid, were *res adjudicata* of any rights of the parties in this proceeding.

5. The Commissioner of Patents erred in holding that the evidence fails to show how the goods which petitioner shipped into foreign countries were marked.

6. The Commissioner of Patents erred in not sustaining the petition of the R. S. Howard Company and cancelling Trade-Mark Registration No. 31,411, registered March 8, 1898, by The Valley Gem Piano Company, sought to be canceled, on the grounds that:

(A) Registrant of the mark sought to be canceled (Registration No. 31,411) had never used said mark prior to its application to register the same, or at any time.

(B) Registrant of the mark sought to be canceled (Registration No. 31,411), prior to its application to register same, had never used said mark in commerce between the United States and foreign nations or Indian tribes.

(C) The principal and essential feature of the mark sought to be canceled (Registration No. 31,411) is the name "Howard," an individual or proper name, a common surname, and also a common geographical term, which was not registrable under the Trade-Mark Act in force at the time of its registration.

(D) The petitioner and its said predecessor in business had continuously used said name "Howard" as a mark and brand for pianos since its first adoption and use by petitioner in *1889*, which was long prior to the time (1896) when The Baldwin Company claims its predecessors first adopted and used said mark.

(E) The Baldwin Company (or its predecessors in business) were not the first to adopt or use the name "Howard" as a mark or brand for pianos, but that petitioner's predecessor in business, Robert S. Howard, was the first to adopt and use the name "Howard" as a mark and brand for pianos.

7. The Commissioner of Patents erred in not sustaining the petition of the R. S. Howard Company and cancelling Trade-Mark Registration No. 46,993, registered October 17, 1905, by The Baldwin Company, sought to be canceled, on the grounds that:

(A) The mark sought to be canceled (registration No. 46,993) consists merely of the name "Howard," an individual name, a common surname, and also a common geographical term, not written, printed, impressed or woven in some particular or distinctive manner, or in association with the portrait of the individual, and not registrable.

(B) The statement and declaration forming a part of the application to register the mark sought to be canceled was false, in that:

(*a*) The mark had not been used in the business of Registrant and its predecessors in business since December, 1896;

(*b*) Registrant (or its predecessors in business) had never made statutory use of the mark prior to its registration;

2594 (c) The name "Howard" was never, at any time, used by Registrant (or its predecessors in business), written, printed, impressed or woven in a particular or distinctive manner.

(C) The Baldwin Company (or its predecessors in business) were not the first to adopt or use the name "Howard" as a mark or brand for pianos, but that petitioner's predecessor in business, Robert S. Howard, was the first to adopt and use the name "Howard" as a mark and brand for pianos.

(D) The petitioner and its said predecessor in business had continuously used said name "Howard" as a mark and brand for pianos since its first adoption and use by petitioner in *1889*, which was long prior to the time (1896) when The Baldwin Company claims its predecessors first adopted and used said mark.

8. The Commissioner of Patents erred in not holding that The Baldwin Company did not, and could not, obtain any right to use the name "Howard" as a mark and brand for pianos, or any right, title or interest in or to the name "Howard" as a mark or brand for pianos, from or through The Valley Gem Piano Company.

9. The Commissioner of Patents erred in affirming the decisions of the Examiner of Interferences.

The Commissioner of Patents is hereby requested to furnish to the R. S. Howard Company a certified transcript of the record and proceedings relating to said Opposition Proceedings Nos. 301 and 302, pursuant to and in accordance with the stipulation of Counsel for the respective parties hereto, which stipulation is filed with the Commissioner of Patents concurrently herewith.

Dated, March 4th, 1918.

Respectfully submitted,

R. S. HOWARD COMPANY,
By SAMUEL S. WATSON,
Its Attorney.

Mail Room,
Mar. 5, 1918,
U. S. Patent Office.

Docket Clerk,
Mar. 5, 1918,
U. S. Patent Office.

Canc.
Intf. No. 301 & 302, Paper No. 251.

United States Patent Office.

Trade-Mark Cancellation Proceeding No. 301.

R. S. HOWARD COMPANY, Petitioner,
against
THE BALDWIN COMPANY, Registrant.

Stipulation.

It is hereby stipulated and agreed by and between Counsel for the respective parties to the above entitled proceeding, that this proceed-

2595 ing be consolidated with Trade-mark Cancellation Proceeding No. 302, entitled R. S. Howard Company vs. The Valley Gem Piano Company (The Howard Piano Company, substituted), and The Baldwin Company; that the records in the two said proceedings be consolidated and one record certified for both said proceedings; that both said proceedings be submitted to and determined by the Court of Appeals of the District of Columbia upon a single record which shall be the same for both said proceedings.

It is further hereby stipulated by and between Counsel for the respective parties to both said above mentioned proceedings that the record to be certified by the Patent Office and submitted to the Court of Appeals of the District of Columbia upon the Appeal by the R. S. Howard Company from the decisions of the Commissioner of Patents rendered on or about February 1st, 1918, to the Court of Appeals of the District of Columbia, shall consist of the following and the following only:

The printed testimony of both parties;

The physical exhibits of both parties;

Applicant's Exhibit No. 120 (of which thirty printed copies were filed by the Applicant in the Patent Office;

The File Wrapper and Contents of Trade-Mark Registration No. 31,411, registered March 8, 1898, by The Valley Gem Piano Company, one of the Trade-Mark Registrations sought to be canceled.

File Wrapper and Contents of Trade-Mark Registration No. 46,993, registered October 17, 1905, by The Baldwin Company, one of the Trade-Mark Registrations sought to be canceled;

Applicant's Exhibit No. 64;

Applicant's Exhibit No. 65;

Registrants' Exhibit No. 39;

Registrants' Exhibit No. 40;

Registrants' Exhibit No. 41;

Registrants' Exhibit No. 42;

Registrants' Exhibit No. 24;

Registrants' Exhibit No. 25;

Motion papers of Motion made by R. S. Howard Company filed May 29, 1916, to introduce certain additional evidence;

Motion papers of Motion made by The Baldwin Company filed June 1st, 1916, to introduce certain additional evidence;

The decision of the Examiner of Interferences on said motions, dated June 23, 1916;

Motion papers of Motion made by The Baldwin Company filed on or about February 14, 1916, to take testimony under Rule 158 in Foreign countries;

The decision of the Examiner of Interferences dated March 2nd, 1916, on the last above mentioned Motion;

The decision of the Commissioner of Patents, dated March 18, 1916, on the Appeal from the decision of the Examiner of Interferences dated March 2nd, 1916, on the last above mentioned Motion (his decision being identical in both proceedings;

The communication filed February 4th, 1916, on behalf of the

R. S. Howard Company, referring to and explaining the terms used in its Second Supplemental Petition;

2596 The Bill of Complaint of The Baldwin Company in the Equity suit in the United States District Court for the Southern District of New York, entitled The Baldwin Company vs. R. S. Howard Company;

The Answer and Counterclaim of the R. S. Howard Company in said Equity suit;

The Reply of The Baldwin Company to said Counterclaim in said Equity suit;

The Opinion of the United States District Court in said Equity suit;

The Opinion of the United States Circuit Court of Appeals for the Second Circuit in said Equity suit;

The Final Decree in said Equity suit;

The Permanent Injunction in said Equity suit;

The Motion papers of Motion and Petition made by R. S. Howard Company, filed on or about July 1st, 1916, to amend its Application to cancel Trade-Mark Registration No. 46,993, registered October 17, 1905, by The Baldwin Company;

The decision of the Examiner of Interferences, dated July 15, 1916, denying said last mentioned Motion;

The decision of the Commissioner of Patents, dated July 22nd, 1916, affirming said last mentioned decision of the Examiner of Interferences;

The decisions of the Examiner of Interferences, dated June 30, 1917, denying Applicant's Applications to cancel in both proceedings.

The decision of the Commissioner of Patents, dated February 1st, 1918, affirming the decision of the Examiner of Interferences last mentioned, and denying Applicant's Applications to cancel said Trade-Mark Registrations in both proceedings.

Dated, February 26, 1918.

SAMUEL S. WATSON,
Attorney for R. S. Howard Company.
JOHN E. CROSS,
Attorney for The Baldwin Company et al.

2597 *Addition to Record per Stipulation of Counsel.*

Transcript of Record.

Court of Appeals, District of Columbia, October Term, 1918.

Patent Appeal Docket, No. 1201.

R. S. HOWARD COMPANY, Appellant,

vs.

THE BALDWIN COMPANY.

and

No. 1202.

R. S. HOWARD COMPANY, Appellant,

vs.

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY Substituted) and THE BALDWIN COMPANY.

Appeal from the Commissioner of Patents.

Cancellation Nos. 46,993 & 31,411.

Filed April 19, 1918.

In the Court of Appeals of the District of Columbia.

Patent Office Appeals Nos. 1201 and 1202.

R. S. HOWARD COMPANY, Appellant,

against

THE BALDWIN COMPANY, Appellee.

R. S. HOWARD COMPANY, Appellant,

against

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY Substituted) and THE BALDWIN COMPANY, Appellees.

Stipulation.

It is hereby stipulated and agreed by and between Counsel for the respective parties to the above entitled proceedings, the Honorable Court of Appeals of the District of Columbia consenting, that the following papers, which were enumerated in the original Stipu-

2598 lation as a part of the record on Appeal but which were inadvertently omitted by the Patent Office from the record which that Office furnished and certified, be added to the certified record filed herein and made a part thereof, to-wit:

The communication filed February 1st, 1916, on behalf of the R. S. Howard Company, referring to and explaining the terms used in its Second Supplemental Petition;

The Bill of Complaint of The Baldwin Company in the Equity suit in the United States District Court for the Southern District of New York, entitled The Baldwin Company vs. R. S. Howard Company;

The Answer and Counterclaim of the R. S. Howard Company in said Equity suit;

The Reply of The Baldwin Company to said Counterclaim in said Equity suit;

The Opinion of the United States District Court in said Equity suit;

The Opinion of the United States Circuit Court of Appeals for the Second Circuit in said Equity suit;

The Final Decree in said Equity suit;

The Permanent Injunction in said Equity suit.

Dated, April 18th, 1918.

SAMUEL J. WATSON,
Attorney for R. S. Howard Company.
JOHN E. CROSS,
Attorney for The Baldwin Company et al.

[Endorsed:] In the Court of Appeals of the District of Columbia. Patent Office Appeals Nos. 1201 and 1202. R. S. Howard Company, Appellant, against The Baldwin Company, Appellee. R. S. Howard Company, Appellant, against The Valley Gem Piano Company (The Howard Piano Company, Substituted), and The Baldwin Company, Appellees. Stipulation to add to Record. Court of Appeals, District of Columbia. Filed Apr. 19, 1918. Henry W. Hodges, Clerk.

2—390.

UNITED STATES OF AMERICA,
DEPARTMENT OF THE INTERIOR,
UNITED STATE PATENT OFFICE

To all to whom these presents shall come, Greeting:

This is to certify that the annexed is a true copy from the Records of this Office of Certain Papers, in the matter of Cancellation Proceeding, Number 301, R. S. Howard Company vs. The Baldwin Company, Trade-Mark for Pianos; and Cancellation Proceeding Number 302, R. S. Howard Company vs. The Valley Gem Piano Company, (The Howard Piano Company, Substituted) and The Baldwin Company, Trade-Mark for Pianos; said papers being enu-

2599 merated in the stipulation forming part of the above named record furnished March 30, 1918, but were inadvertently omitted.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the City of Washington, this 17th day of April, in the year of our Lord one thousand nine hundred and eighteen and of the Independence of the United States of America the one hundred and forty-second.

[Seal Patent Office, United States of America.]

F. W. H. CLAY,
Acting Commissioner of Patents.

"EXHIBIT A."

UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, Alexander Gilchrist, Jr., Clerk of the District Court of the United States for the Southern District of New York, do hereby Certify that the Writings annexed to this Certificate have been compared by me with their originals on file and remaining of record in my office; that they are correct transcripts therefrom and of the whole of the said originals.

In testimony whereof I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, this ninth day of December in the year of our Lord one thousand nine hundred and fifteen, and of the Independence of the said United States the one hundred and fortieth.

(Revenue Stamp.)

[SEAL.] ALEX. GILCHRIST, JR., *Clerk.*

Mail Room,
Dec. 20, 1915.
U. S. Patent Office.

Copy.

In the District — of the United States, Southern District of New York.

In Equity. 13—75.

THE BALDWIN COMPANY, Plaintiff,

vs.

R. S. HOWARD COMPANY, Defendant.

To the Judges of the District Court of the United States of the Southern District of New York:

The Baldwin Company, an Ohio corporation, a citizen of the State of Ohio, brings this, its Bill of Complaint, against the R. S.

2600 Howard Company which is a New York corporation, a citizen of the State of New York, and thereupon your orator complains and says:

I. That it is a corporation duly created, organized and existing under the laws of the State of Ohio, having its principal place of business in the City of Cincinnati, State of Ohio, and within the meaning of the statute in that behalf is a citizen and resident of the State of Ohio; that the defendant, R. S. Howard Company, is a corporation, incorporated by and organized under the laws of the State of New York, having its principal place of business at New York City, and within the meaning of the statute in that behalf, is a citizen and resident of the State of New York and of the Southern District thereof; that the jurisdiction of this Court is invoked to enjoin the infringement and cancellation by the defendant of your orator's trade-mark which has been registered and re-registered in the United States Patent Office, pursuant to the Trade-Mark Acts of 1881 and 1905 and amendments thereto, also to enjoin unfair competition in trade, this being a suit between citizens of different states and the amount in controversy herein exceeding the sum or value of three thousand ($3,000.00) dollars exclusive of interest and costs.

II. That in or about the year 1862, D. H. Baldwin, now deceased, established and founded in the City of Cincinnati, State of Ohio, the business now carried on by your orator of manufacturing and selling pianos, organs and other musical instruments, subsequently associating with him Lucien Wulsin, A. A. Van Buren, Clarence Wulsin and George W. Armstrong Jr. with whom a co-partnership was founded which traded under the name and style of D. H. Baldwin & Co., that for the purpose of manufacturing the pianos and organs sold by them, D. H. Baldwin, Lucien Wulsin, A. A. Van Buren, Clarence Wulsin and George W. Armstrong Jr., members of the firm of D. H. Baldwin & Co., organized, during the years 1891, 1892 and 1893, the Hamilton Organ Company under the laws of the State of Illinois and The Baldwin Piano Company, The Ellington Piano Company and The Valley Gem Piano Company under the laws of the State of Ohio, the five members of the firm of D. H. Baldwin & Co. being the only stockholders and directors of such manufacturing corporations; that all the product of these manufacturing corporations was sold either at wholesale or retail by the firm of D. H. Baldwin & Co. at Cincinnati, Ohio and through their branch offices and salesrooms, as it had been found desirable to keep the manufacturing part of the business separate and distinct from the selling division, which separate division is still maintained by your orator.

III. That in or about the year 1896 The Valley Gem Piano Company, under the instructions and direction of the members of the firm of D. H. Baldwin & Co. began to manufacture, at the plant of The Ellington Piano Company in Cincinnati, Ohio, in a department set aside for that purpose, high grade medium priced or commercial pianos and on or about the 15th day of December, 1896, and in advance of all others, devised, originated, appropriated

2601 adopted, applied and used as a trade-mark for its said pianos, manufactured and sold by it, the name "Howard"; that the trade-mark "Howard" was at that time and has been continuously since its adoption, conspicuously marked upon the fall-board of said pianos (the fall-board being the front of the pianos or that part of the instrument whereon is usually placed the name by which the instrument is known), also cast in the metal plate on the inside of the pianos to which the strings are attached, and stencilled upon the piano boxes in which the pianos were and are shipped, said trade-mark being thus applied or affixed both upon the pianos sold in interstate commerce in this country and the pianos which were exported to and sold in foreign countries; that the trade-mark "Howard" became at once and has continued to be of great value as designating pianos the product of the business established and founded by D. H. Baldwin as aforesaid; and that from December 15, 1896 to the present time your orator and its predecessors in business have continuously employed this trade-mark in connection with the sale of pianos, and your orator is still using the same whereby the trade-mark "Howard" has always served and still serves to indicate the origin and ownership of pianos manufactured and sold by your orator and its predecessors in business and to distinguish same from the pianos manufactured or sold by all other piano manufacturers and dealers.

IV. That at the time of the adoption of the trade-mark "Howard" by The Valley Gem Piano Company, as aforesaid, no other person, firm or corporation engaged in the business of manufacturing, selling or dealing in pianos was using the word "Howard" as a trade-mark, trade-name or designation for the purpose of distinguishing their pianos from those of other manufacturers or dealers and that The Valley Gem Piano Company had the legal right to appropriate and use the name "Howard" as a trade-mark for pianos and your orator as its successor in business has the exclusive right to use the name "Howard" as its lawful trade-mark for pianos manufactured and sold by it.

V. That on the 8th day of March, 1898, under the Act of Congress then in force relating to the registration of trade-marks, The Valley Gem Piano Company caused the trade-mark "Howard" to be duly registered in the Patent Office of the United States, and that subsequently on the 17th day of October, 1905, under the existing Act of Congress relating to the registration of trade-marks, your orator as the successor in business of The Valley Gem Piano Company caused said trade-mark to be re-registered in the Patent Office of the United States as by the Certificates of said Registrations No. 31,411 and No. 46,993, respectively, or copies thereof duly certified by the Commissioner of Patents here in Court to be produced, will more fully and at large appear.

VI. That on the 24th day of February, 1898 your orator, The Baldwin Company, was organized as a corporation under the laws of the State of Ohio with a capital stock of $10,000.00; that in December, 1901 your orator's capital stock was increased from $10,000.00 to $1,250,000.00 consisting of $1,000,000.00 in

common stock and $250,000.00 in preferred stock with the
2602 right to issue $550,000.00 additional preferred stock; that in June, 1903 the additional preferred stock of $550,000.00 was authorized and issued; and that in December, 1912 its common stock was raised to $2,000,000.00 while its preferred stock remained the same, to-wit: $800,000.00 so that its common and preferred stock now aggregates $2,800,000.00; that its business has assumed immense proportions, and it has established and maintained offices and salesrooms in Cincinnati, New York, Chicago, St. Louis, Denver, San Francisco, Indianapolis and Louisville and that its factories located in Cincinnati and Chicago are among the largest, finest and best equipped in the world; that in December, 1901, immediately after the capital stock of your orator was increased from $10,000.00 to $1,250,000.00 the firm of D. H. Baldwin & Co. and the manufacturing corporations, the Hamilton Organ Company, The Baldwin Piano Company, The Ellington Piano Company and The Valley Gem Piano Company assigned, transferred and conveyed unto your orator, The Baldwin Company, the plaintiff herein, all the good-will, and tangible and intangible assets of the business previously owned and carried on by said co-partnership and manufacturing corporations including all rights, trade-marks, trade-names, etc. together with the trade-mark "Howard" and the business and good-will of the business in connection with which the same is used and in every sense your orator has been and is by virtue of said assignment the owner of all the trade-marks, trade-names, good-will and business of the firm of D. H. Baldwin & Co. and of the manufacturing corporations, the Hamilton Organ Company, The Baldwin Piano Company, The Ellington Piano Company and The Valley Gem Piano Company; that subsequent to said assignment under the direction and at the request of the Board of Directors of your orator, Lucien Wulsin and George W. Armstrong Jr. entered into a new partnership agreement under the firm name and style of D. H. Baldwin & Co., which agreement was also signed and sealed with the corporate seal of your orator, specifically agreeing to pay over to your orator all profits realized from conducting their business and thereafter, under such arrangement, the selling division of your orator's business was carried on by the firm of D. H. Baldwin & Co. until on or about December 1, 1907 at which time Lucien Wulsin and George W. Armstrong Jr. duly assigned the entire assets of the business and good-will of the new firm of D. H. Baldwin Co. including all its branches and agencies wherever situate and all real estate owned by that firm to your orator and the selling division of your orator's business was subsequently carried on by your orator The Baldwin Company, until January 1, 1914 at which time The Baldwin piano Company which was one of the manufacturing units and whose capital stock had been increased from $60,000.00 to $500,000.00 all of which stock with the exception of the qualifying director's shares are owned by your orator, began to conduct the selling division of the business of your orator. The Baldwin Company and since that date the various selling divisions of your orator,

2603 The Baldwin Company, have been conducted by The Baldwin Piano Company.

VII. That from the year 1901 all the property real, personal and mixed and wheresoever situate of the firm, D. H. Baldwin & Company, and the manufacturing corporations, the Hamilton Organ Company, The Baldwin Piano Company, The Ellington Piano Company and The Valley Gem Piano Company including all real estate belonging to said firm and manufacturing corporations acquired by them in the course of their business of manufacturing and selling pianos and other musical instruments and all their stock of goods and other property, bills receivable, debts and collections of all kinds together with their good-will, trade-marks and trade-names and all other rights as to their property and all of the shares of the capital stock of the manufacturing corporations, the Hamilton Organ Company, The Baldwin Piano Company, The Ellington Piano Company and The Valley Gem Piano Company, have continued to be owned by The Baldwin Company with the exception of one qualifying director's share for each director in each of said corporations; that the pianos bearing the trade-mark "Howard" now manufactured and sold by your orator and previously made and sold by its predecessor in business, have for many years enjoyed a high reputation in the markets of the United States and other parts of the world extending throughout the states of the Union and in many foreign countries and the fame and merit of the pianos known as "Howard" pianos is undiminished; and that on account of the care, skill, faithfulness and diligence bestowed by your orator and its predecessors in business continuously since the 15th day of December, 1896 upon the pianos so manufactured and sold and by reason of the superior quality of your orator's product and the diligent efforts of your orator in the premises there has been established and now exists in the United States and foreign countries a very large and profitable business in the manufacture and sale of said pianos which business is now carried on by your orator and has been the source of great profit to your orator and will continue to be a source of great profit to your orator but for the infringement of your orator's rights and unfair competition by the defendant as hereinafter stated.

IX. That your orator and its predecessors in business have invested and expended large sums of money for the purpose of introducing the pianos bearing the trade-mark "Howard" as aforesaid and making the manufacture and sale thereof profitable; that the trade-mark "Howard" has been of great benefit and advantage to your orator, the trade and the public for the purpose of indicating the origin and ownership of the pianos so manufactured and sold by your orator and its predecessors in business; that the gross sales of said pianos during the past four or five years have aggregated more than $1,000,000.00 annually; that there are now many thousands of "Howard" pianos the product of your orator and its predecessors in business in use in this and foreign countries and that these pianos are and always have been marked upon the fall-board and upon the metal plate and upon the

2604 piano boxes with the name "Howard" and that each of these pianos is a continuing advertisement of the "Howard" pianos heretofore manufactured and sold by your orator's predecessors in business and now manufactured and sold by your orator and that because of the conduct of the business as set forth in this Bill of Complaint the name "Howard" now has universally a secondary meaning both to the public and in the trade as a designation of a piano of the product and kind aforesaid.

X. That your orator has been diligent at all times in asserting and preserving its rights in the trade-mark "Howard," and the public and the trade have generally acquiesced in and acknowledged the aforesaid rights of your orator and have come to recognize and know the said pianos by the trade-mark "Howard"; that Robert S. Howard, President and General Manager of the R. S. Howard Company, the defendant, has, on behalf of himself and the R. S. Howard Company which he organized acquiesced in the exclusive rights of your orator in the trade-mark "Howard" in that he was employed between 1896 and 1902, or for a period of more than five years, as one of the salesmen of D. H. Baldwin & Co., your orator's predecessor in business, to sell on salary and commission the entire line of pianos by the firm of D. H. Baldwin & Co. including the "Howard" pianos manufactured by the Valley Gem Piano Company, in accordance with and agreement quite usual in your orator's business, during which time Robert S. Howard did not in any way participate in or claim any right to the profits accruing from the sales of said pianos bearing the trade-mark "Howard" but was only paid a salary and commission for those sold by him and he thereby specifically acquiesced in and acknowledged the aforesaid rights of your orator; that the registration in the United States Patent Office hereinbefore referred to, of the trade-mark "Howard" for pianos by The Valley Gem Piano Company, was effected during Robert S. Howard's said employment with his full knowledge and acquiescence; that the pianos manufactured for or by the R. S. Howard Company have always been described as made and sold by "R. S. Howard Co. New York" and referred to as "R. S. Howard" or "R. S. Howard Co." pianos in all the catalogues of the defendant and have been so described and referred to in all of the defendant's advertisements until within the last few months; that the pianos manufactured for or sold by the defendant have always been referred to in the various piano trade directories and buyers' guides as "R. S. Howard" and "R. S. Howard Co." pianos; that so far as your orator was aware prior to taking testimony in the Patent Office cancellation proceedings hereinafter referred to, all the pianos manufactured and sold by the R. S. Howard Company bore the full name "R. S. Howard Co. New York" on the fall-board and metal plate thereof; that the R. S. Howard Company also specifically acquiesced in your orator's rights by dismissing in 1905 certain suits which it instituted in that year in the Supreme Court of New York County against your orator and its predecessors in business to enjoin and restrain your orator and its predecessors in business from

2605 the use of the name "Howard" as a trade-name or trade-mark for pianos either alone or combined with any other word or words, letter or letters, in any manner; and that after the dismissal of said suit no further claim was made by either Robert S. Howard or the R. S. Howard Company, to any proprietary rights in the name "Howard" as a trade-mark for a period of over nine years during which time the defendant R. S. Howard Company acquiesced in your orator's efforts in building up an enormous trade for its "Howard" pianos without any objection.

XI. Your orator further shows unto your Honors that the defendant, R. S. Howard Company, which is engaged in the Southern District of New York in the business of manufacturing and selling commercial or medium priced pianos similar to those manufactured and sold by your orator but not of your orator's manufacture and well knowing your orator's rights in the premises and since your orator's rights were acquired, filed on or about the 6th day of August, 1914 two petitions in the United States Patent Office for the cancellation of said registered trade-marks Nos. 31,411 and 46,993, in which the R. S. Howard Company claimed priority of adoption and use of the name "Howard" as a trade-mark for pianos and alleged in effect its own right to registration upon the cancellation of your orator's registered trade-marks; that the testimony recently taken in these cancellation proceedings disclosed for the first time to your orator and therefore your orator alleges that after having for years acquiesced in your orator's exclusive rights and wholly without your orator's consent and in violation of your orator's rights aforesaid, wrongfully contriving and seeking to avail itself of the benefit of your orator's trade-mark "Howard" to profit by the reputation of your orator's pianos and to deceive the public into purchasing pianos manufactured and sold by the defendant as and for pianos manufactured and sold by your orator, the defendant, R. S. Howard Company, is using in interstate and foreign commerce your orator's trade-mark "Howard" upon pianos manufactured for *for* sold by the defendant by applying the name "Howard" alone on the fall-board of said pianos, without qualification or explanation; that the defendant is also wilfully and unlawfully offering and selling in the Southern District of New York and shipping in commerce among the several States of the United States and between the United States and foreign countries, pianos of its own manufacture, marked on the fall-board with the name "R. S. Howard Co." in response to orders for "Howard" pianos and rendering to its customers making such purchases accounts of sales describing the pianos so sold and delivered as "Howard" pianos thereby enabling the dealers to deceive the ultimate consumer into the mistaken belief that he is obtaining a "Howard" piano manufactured and sold by your orator; that the defendant has within the last few months advertised its pianos as "Howard" pianos whereas the defendant had always previously advertised its pianos as "R. S. Howard" or "R. S. Howard Co." pianos; that the defendant threatens to continue to make use of your orator's trade-mark "Howard" in

2606 marking its pianos and in connection with the advertisement and sale of pianos not of your orator's manufacture in disregard and in violation of your orator's exclusive rights by it long enjoyed as hereinbefore set forth; and that your orator is informed and believes and therefore avers that the defendant is selling or enabling its dealers to sell to the ultimate consumer in the United States and in foreign countries large numbers of pianos manufactured for or by the defendant as and for "Howard" pianos manufactured and sold by your orator and unless restrained by an order of this Court the defendant will continue its said fraudulent practices to your orator's irreparable injury, great loss and the deception of the public.

XII. That in said cancellation proceedings now pending in the United States Patent Office, the Commissioner of Patents, on the 6th day of November, 1915, sustained a decision of the Examiner of Interferences permitting the R. S. Howard Company to file supplemental petitions for cancellation containing allegations contrary to the intent of the original pleadings which alleged that applicant for cancellation would register but for the existence of your orator's registrations and the issue had therefore been confined to priority of adoption and use; whereas the supplemental pleadings allege that the trade-marks Nos. 31,411 and 46,993, were not properly or legally registrable at the time registration was secured, claiming the word "Howard" was a proper name not distinctively displayed and also a geographical term, thereby changing the cause of action, after the testimony, limited to the question of priority of adoption and use had been concluded on behalf of both parties and only a few days had been left for taking rebuttal testimony; that your orator has been engaged for many years, as aforesaid, in shipping and selling its "Howard" pianos to practically all the civilized countries of the world in many of which countries it has caused its trade-mark to be registered; that in some foreign countries in which your orator's trade-mark is registered, although title is based upon registration and not upon priority of adoption and use as in this country, it is necessary to first register the trade-mark in applicant's home country and to furnish a certified copy thereof before registration will be permitted; that the laws of some of such foreign countries provide that trade-marks which are registered therein shall cease to be protected upon the cancellation or expiration of the corresponding trade-mark in the applicant's home country; and that if the R. S. Howard Company is allowed to cancel your orator's registered trade-marks the fact of such cancellations will be undoubtedly used for improper advertising purposes and your orator's trade-marks will cease to be protected in many foreign countries to your orator's irreparable injury.

XIII. And your orator further shows unto your Honors that the acts of the defendant hereinbefore recited, in falsely and fraudulently using the name "Howard" alone upon the fall-board of its pianos, in advertising matter, upon invoices and in correspondence, without qualification or explanation, and in seeking the cancellation of your orator's registered trade-marks, constitute an unfair and fraudulent competition in business and is inequitable

2607 and unlawful and in plain violation of your orator's rights; and that the said actions of the defendant necessarily have the effect of causing the sale and substitution of the defendant's pianos as and for your orator's pianos to the great injury of your orator and the deception, misleading and injury of the public.

XIV. That your orator cannot with certainty state the exact amount of profits realized by the defendant from the sale of pianos so improperly marked billed and advertised, but prays that the defendant may make full and true disclosure as to the same and may be decreed to account therefor in full and otherwise to respond in damages as may appear to be equitable.

To the end therefore that your orator may obtain relief in the premises in this Honorable Court where it alone can obtain adequate relief it humbly prays:

1. That the R. S. Howard Company, defendant to this Bill of Complaint, may be made to answer each and every allegation therein contained, but not under oath, answer under oath being especially waived, and as fully and directly as if interrogated on each allegation in this, your orator's bill.

2. That your orator may be adjudged to be the true, lawful and sole owner and entitled to the exclusive use of the word "Howard" as applied to pianos as a trade-mark and trade-name and also of said registered trade-marks No. 31,411, dated March 8, 1898 and No. 46,993, dated October 17, 1905.

3. That said defendant, its officers, attorneys, agents, servants, clerks, employees, workmen and confederates and all persons claiming or holding through or under them and all in privity with them and each and every of them may be perpetually restrained and enjoined by an order of this Honorable Court as follows:

(*a*) From directly or indirectly making or causing to be made, selling or causing to be sold, or offering for sale, marking or advertising or describing either in correspondence with customers, in bills rendered or in conversation with customers, any pianos as "Howard" pianos (other than those manufactured and sold by your orator) without clearly indicating that said pianos are not the product of your orator or its predecessors, but the product of the defendant.

(*b*) From palming or passing off or attempting to palm or pass off pianos not made or sold by your orator as and for your orator's pianos and from any and every violation and infringement of your orator's rights in the premises hereinbefore referred to or defined and in any and all acts constituting unfair competition in trade with your orator's business and trade.

(*c*) From prosecuting or causing to be prosecuted in the United States Patent Office the pending applications or any other applications for the cancellation of your orator's trade-mark "Howard" for pianos, Certificates of Registration No. 31,411, dated March 8, 1898, and No. 46,993, dated October 17, 1905.

4. That a restraining order and preliminary injunction may be issued without delay, duly restraining the said defendant, its officers, attorneys, agents, servants, clerks, employees, workmen, and confederates, and all persons claiming or holding through or under

2608 them, and all in privity with them, enjoining them, and each and every of them, in like manner as prayed in the next preceding paragraph, numbered and designated "3."

5. That the said defendant may be compelled to render before a master of this Court a full true, perfect and clear account of all profits realized by the defendant by the wrongful use of the word "Howard" and may be decreed to pay unto your orator the full amount of such profits, and in addition to the profits to be accounted for by the defendant as aforesaid, may it please the Court to assess as damages sustained by your orator, a sum equal to three times the amount of such profits as in the discretion of the Court it may deem meet and proper, according to the circumstances of the case; and that your orator recover of the defendant the full amount of such profits and damages, as well as the costs of this case.

6. That your orator may have such other and further relief in the premises to which in equity it is entitled as the same shall appear to be just and equitable, and that it may have such relief the same as if it were here and now made the subject of a specific prayer.

7. And finally to the end that equity may be done and the relief herein prayed for, and all other relief that it may be righteous in the premises to grant, may be awarded your orator, may it please your Honors such relief fully to grant, and to award against the defendant a writ of subpœna ad respondendum of the United States of America, issuing out of and under the seal of this Honorable Court commanding the defendant on a day certain therein to be named, and under a certain penalty to be and appear in this Honorable Court, then and there to answer all and singular the premises, and to stand, perform and abide such further order, direction and decree as may be made against it.

And your orator, as in duty bound, will ever pray, etc.

THE BALDWIN COMPANY,
By GEORGE W. ARMSTRONG, JR.,
President.

WETMORE & JENNER.
Solicitors for Plaintiff.
LAWRENCE MAXWELL,
EDMUND WETMORE,
JOHN E. CROSS,
Of Counsel for Plaintiff.

STATE OF LOUISIANA,
Parish
[*County*]* *of Orleans, ss:*

George W. Armstrong Jr. being duly sworn deposes and says that he is the President of The Baldwin Company, the plaintiff named in the foregoing Bill of Complaint; that he has read said Bill of Complaint and knows the contents thereof and that the same is true of

[*Words and figures enclosed in brackets erased in copy.]

2609 his own knowledge except as to matters therein stated to be alleged on information and belief and as to those matters he believes it to be true;

That the plaintiff is a corporation and the reason why this verification is not made by the plaintiff is because of that fact; that deponent's knowledge and the grounds of his information and belief are derived from his active participation in the business of the plaintiff and its predecessors in business since the year 1873 and from information imparted to deponent by the plaintiff's attorney in the cancellation proceedings pending in the United States Patent Office.

GEORGE W. ARMSTRONG, Jr.

Subscribed and sworn to before me, a notary public this 22nd day of November, 1915.

W. W. YOUNG,
Notary Public.

[SEAL.]

My commission expires at my death.

Docket Clerk,
Feb. 1, 1916,
U. S. Patent Office.

Can. 301—183.

In the United States Patent Office.

Before the Examiner of Interferences

Cancellation No. 301.

R. S. HOWARD COMPANY

against

THE BALDWIN COMPANY.

Cancellation No. 302.

R. S. HOWARD COMPANY

against

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY Substituted) and THE BALDWIN COMPANY.

To the Honorable Commissioner of Patents:

Now comes the R. S. Howard Company, by Samuel S. Watson, its Attorney, and respectfully represents, in opposition and reply to the Motions made by the respondents herein under Rule 158 to take

testimony in foreign countries, which Motions are noticed for hearing on February 1st, 1916, as follows:

1. That the testimony sought to be adduced under and in accordance with the Paragraphs marked "(a)", "(b)", and "(d)", on Page 7 of said motion papers is entirely immaterial and irrelevant to any issue in these proceedings.

2. That the testimony sought to be adduced under and in accordance with Paragraph marked "(c)" on Page 7 of said motion papers is entirely incompetent, immaterial and and irrelevant to any issue in these proceedings.

3. That if it be held that the testimony sought to be adduced under and in accordance with Paragraphs marked "(a)", "(b)", and "(d)" on Page 7 of said motion papers, is material and relevant, then the R. S. Howard Company, subject to the objection that such testimony is immaterial and irrelevant, hereby offers to stipulate and admit for the purposes of these proceedings only, as follows:

"(a) That the mere registration in their respective countries of the trade-mark 'Howard' for pianos, although based on certified copy of the same mark as registered in this country, would not prevent the R. S. Howard Company from selling its pianos bearing its name 'R. S. Howard Co.' in such foreign countries.

"(b) That on account of the registration referred to, the R. S. Howard Company, its agents or dealers, would not be rendered liable to criminal prosecution by the sale in Brazil, Panama and Colombia of pianos bearing the name 'R. S. Howard Co.', nor would the said pianos be liable to be confiscated under the laws of such countries."

4. That as to the subject matter set out in Paragraph marked "(c)" on Page 7 of said motion papers, it is respectfully submitted that this is not proper subject matter for testimony, expert or otherwise, inasmuch as it is a question or conclusion of law which the tribunals before whom these proceedings come will determine for themselves.

5. That it is hereby stipulated and admitted by the R. S. Howard Company, in the supplemental application filed herein October 26th, 1915, (in Cancellation Proceeding No. 301—Paper No. 131), as follows:

That in line 10, page 2, of said supplemental application the words "its said name and trade-mark 'Howard'" were intended to mean, and hereby limited to the meaning, as follows: "its said name 'Howard' and its said trade-mark 'Howard'".

That in line 20, page 2, of said supplemental application the words "its name and its trade-name and trade-mark 'Howard'" were intended to mean, and hereby limited to the meaning as follows: "its name 'Howard' and its trade-name 'Howard' and trade-mark 'Howard'".

That in line 26, page 2, of said supplemental application the words "its said name, trade-name and trade-mark" were intended to mean and hereby limited to the meaning as follows: "its said name 'Howard', trade-name 'Howard' and trade-mark 'Howard'".

2611 Wherefore, in view of the foregoing, the R. S. Howard Company respectfully submits that said Motions should, in all respects, be denied.

Respectfully submitted,

R. S. HOWARD COMPANY,
By SAMUEL S. WATSON,
Its Attorney.

Dated February 1st, 1916.

Mail Room,
Jun- 1, 1916,
U. S. Patent Office.

Docket Clerk,
Jun- 3, 1916,
U. S. Patent Office.

REGISTRANTS' EXHIBIT E.

Copy.

In the District Court of the United States, Southern District of New York.

In Equity. 13-75.

THE BALDWIN COMPANY, Plaintiff,

against

R. S. HOWARD COMPANY, Defendant.

Answer.

To the Judges of the District Court of the United States for the Southern District of New York:

The Answer of the R. S. Howard Company, the above named defendant, to the Bill of Complaint filed against it by The Baldwin Company, the above named plaintiff, in the above entitled cause.

The defendant, R. S. Howard Company, a corporation duly created, organized and now existing under and by virtue of the laws of the State of New York, located and doing business in the City, County and State of New York, now and at all times hereafter, saving and reserving unto itself any and all manner of benefit and advantage of exception which may be had or taken to the manifold errors, uncertainties, ambiguities, insufficiencies and other imperfections in the plaintiff's Bill of Complaint contained, nevertheless, in answer unto the same or to so much and such parts thereof as this defendant is advised is material or necessary for it to make answer to, answering says:

1. Defendant admits that it is a corporation duly created, organized and now existing under the laws of the State of New York, and that its principal place of business is in the City of New York, State of New York, within the Southern District

2612 of New York, and defendant says that it was duly created and organized as a corporation, as aforesaid, on or about April 2nd and 3rd, 1902, and ever since has existed as a corporation under the laws of the State of New York, and continuously since its organization has had and maintained its principal place of business in said City of New York.

Defendant further says that it is informed and believes that The Baldwin Company, the plaintiff herein, is a corporation created, organized and now existing under the laws of the State of Ohio, and that plaintiff has its principal place of business in the City of Cincinnati, in the State of Ohio, as alleged in paragraph marked I of the Complaint herein.

II. Defendant does not know, and it is without knowledge or information sufficient to form a belief, as to the truth, or otherwise, of the allegations contained in paragraph marked II of the Bill of Complaint herein, and insists that the plaintiff make strict proof thereof.

III. Defendant denies each and every allegation contained in paragraph marked III of the Bill of Complaint herein, except that defendant admits that the plaintiff is now selling, and for some time past has been selling, pianos marked with the name "Howard" which are not and were not of defendant's manufacture.

IV. Defendant denies each and every allegation contained in paragraph marked IV of the Bill of Complaint herein.

V. Defendant denies each and every allegation contained in paragraph marked V of the Bill of Complaint herein, except that defendant admits that on the 8th day of March, 1898, under the Act of Congress then in force relating to the registration of trade-marks, The Valley Gem Piano Company registered a trade-mark for pianos in the United States Patent Office, Registration Certificate No. 31,411, which contained, among other essential and principal features, the name "Howard," and defendant also admits that subsequently on the 17th day of October, 1905, under the then existing Act of Congress relating to the registration of trade-marks, plaintiff registered in the United States Patent Office the name "Howard" as a trade-mark for pianos, Registration Certificate No. 46,993.

VI. Defendant, further answering, alleges that both of said registrations, Registration Certificate No. 31,411 and No. 46,993, were made without due authority of law; that the name "Howard" was and is a common surname and a common individual personal name, and a common geographical term, and was not properly or legally registrable under the Acts of Congress relating to the registration of trade-marks in force at the times, respectively, when said registrations were made; that under the Act of Congress in force on the 8th day of March, 1898, at the time said registration was made by The Valley Gem Piano Company, Registration Certificate No. 31,411, a surname, individual name, or name of a person, or a geographical name or term, was not properly or legally registrable; that under the Act of Congress relating to the Registration of trade-marks in force on the 17th day of October, 1905, at the time said

2613 trade-mark was registered by The Baldwin Company, Registration Certificate No. 46,993, no mark which consisted merely in the name of an individual, or a surname, not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or which was merely a geographical name or term, could be properly or legally registered, unless and except such mark had been in actual and exclusive use as a trade-mark of the applicant, or its predecessors from whom it derived title, in commerce with foreign nations, or among the several states, or with Indian tribes, for ten years next preceding the passage of the Act of Congress relating to the registration of trade-marks, approved February 20, 1905; that said mark, registered by The Baldwin Company on the 17th day of October, 1905, Registration No. 46,993, had not been in actual or exclusive use as a trade-mark of The Baldwin Company, or its predecessors from whom it derived title, for ten years next preceding the passage of the Act of Congress relating to the registration of trade-marks, approved February 20, 1905; that said mark registered October 17, 1905, as aforesaid, was and is merely a geographical name or term; that said mark registered October 17, 1905, as aforesaid, was and is merely the name of an individual, and a common surname, not printed, written impressed or woven in some particular or distinctive manner or used in association with a portrait of the individual; that both of said marks, Registration Certificate No. 31,411 and No. 46,993, were improperly and illegally registered, and said registrations were and are of no force or effect.

VII. Defendant does not know, and it is without knowledge or information sufficient to form a belief as to the truth, or otherwise, of the allegations contained in paragraph marked VI of the Bill of Complaint as to the date of the organization of The Baldwin Company, the amount of its capital stock, the kind and character of such stock, the amount authorized and issued, the increases, if any, of said stock, the present aggregate amount of said stock, the location and character of its alleged factories, or the amount of business it does, or the offices and salesrooms maintained by it, and cannot admit or deny the allegations contained in paragraph marked VI of the Bill of Complaint herein relative thereto, and insists that the plaintiff make strict proof thereof insofar as such allegations are material.

Defendant also does not know, and it is without knowledge or information sufficient to form a belief as to the truth, or otherwise, of the allegations contained in paragraph marked VI of the Bill of Complaint herein as to the assignment, transfer or conveyance of any property, assets or good-will of the said firm of D. H. Baldwin & Co., the Hamilton Organ Company, The Baldwin Piano Company, The Ellington Piano Company, and The Valley Gem Piano Company, or either or any of them, and cannot admit or deny the allegations of the Bill of Complaint herein relative thereto, and insists that the plaintiff make strict proof thereof insofar as such allegations are material.

Defendant denies that the said firm of D. H. Baldwin & Co., or

2614 the Hamilton Organ Company, or The Baldwin Piano Company, or The Ellington Piano Company, or The Valley Gem Piano Company, or either or any of them had, in December, 1901, or at any other time, any trade-mark rights, or rights of any kind, to the name "Howard" which they did or could transfer, assign or convey to the plaintiff.

Defendant further denies that said firm of D. H. Baldwin & Co., the Hamilton Organ Company, The Baldwin Piano Company, The Ellington Piano Company, or The Valley Gem Piano Company, or either or any of them, did, or could, in December 1901, or at any other time, convey any trade-mark rights, or rights of any kind, in or to the name "Howard" to the plaintiff.

Defendant further denies that the plaintiff now has, or at any other time had, any right whatsoever to the name "Howard" as a trade-mark, trade-name or mark for pianos.

VIII. Defendant does not know, and it is without knowledge or information sufficient to form a belief as to the truth, or otherwise, of the allegations contained in paragraph marked VII of the Bill of Complaint herein, and insists that plaintiff make strict proof thereof insofar as the same may be material, except that defendant denies that at any time it has carried on, or committed any act or acts of unfair trade competition whatsoever against the plaintiff.

IX. Defendant alleges that it does not know, and that it is without knowledge or information sufficient to form a belief as to the truth, or otherwise, of the allegations contained in paragraph marked IX of the Bill of Complaint herein, and insists that plaintiff make strict proof thereof insofar as the same may be relevant or material, except that defendant denies that the name "Howard" as applied to pianos indicates or designates or distinguishes pianos of plaintiff's manufacture or selection, or that the name "Howard" as applied to pianos now has, or at any time had, any secondary meaning, either to the public or in the trade, as designating or indicating pianos of plaintiff's manufacture or selection, but on the contrary defendant alleges that the name "Howard" placed on pianos, or used in connection with the sale of pianos, means, indicates and designates, both to the public and to the trade, pianos of defendant's manufacture, and serves to distinguish pianos of defendant's manufacture from those of all other manufacturers and dealers, and that such has been the fact for many years last past, until now the name "Howard" has attained in the piano business a secondary meaning, and has become the designation and the distinguishing mark of pianos of defendant's manufacture, both to the public and to the trade.

X. Defendant, further answering, denies that the plaintiff has any rights whatever in or to the name "Howard" as a mark, trade-mark or trade-name for pianos; defendant denies that either the defendant or the public, or the trade, have at any time or in any manner, acquiesced in and acknowledged any rights whatever in the plaintiff to the name "Howard" as a mark, trade-mark or trade-name for pianos; defendant denies that Robert S. Howard, the President and General Manager of the R. S. Howard Company, has, either on behalf of himself or on behalf of the R. S. Howard Company, at any time, or in any manner, acquiesced in, or acknowledged, any exclusive or

2615 proprietary rights in the plaintiff to the name "Howard" as a mark, trade-mark or a trade-name for pianos, but, on the contrary, defendant alleges that it has notified plaintiff several times of defendant's exclusive and proprietary rights to the name "Howard" as the distinguishing mark of pianos of defendant's manufacture, and defendant has on said several occasions called upon and notified plaintiff to cease the use of the name "Howard" on, or in connection with the manufacture or sale of, pianos which were not of defendant's manufacture; and defendant further alleges that it first called upon and notified plaintiff to cease the use of the name "Howard," as aforesaid, soon after the defendant was organized, as aforesaid, and that defendant has since repeated said notifications on several occasions.

Further answering, defendant says, that beginning in the year 1889 and continuing to, and including, the year 1896, said Robert S. Howard arranged with Thomas F. Scanlan and the New England Piano Company, piano manufacturers of Boston, Massachusetts, to make pianos for his customers and trade to be marked "Howard," same to be made in accordance with his suggestions and of materials and in a style indicated by him, which pianos were sold by said Robert S. Howard to his customers and to the trade generally throughout the United States and Canada from the year 1889 to and including the year 1896; that in the year 1896, said Thomas F. Scanlan and the New England Piano Company became financially embarrassed and unable to supply said pianos as required by said Robert S. Howard for his customers and trade; that thereupon, and in the latter part of the year 1896, said Robert S. Howard arranged with said firm of D. H. Baldwin & Co. for the manufacture of pianos for him, same to be marked "Howard" and to be made in accordance with his suggestions and in a manner and style indicated by him, and to supply the same to him and upon his orders to his trade at a fixed price and upon terms mutually agreed upon; that said Robert S. Howard sold said pianos so supplied to his customers and trade, guaranteeing the payment of the purchase price thereof to said D. H. Baldwin & Co.; that said arrangement between said Robert S. Howard and said firm of D. H. Baldwin & Co. continued from the year 1896 to and until on or about the first day of January, 1899; that after the first day of January, 1899, and until the thirty-first day of March, 1902, said Robert S. Howard continued, as before, to sell pianos marked "Howard" to his customers and trade, obtained, as before, from said firm of D. H. Baldwin & Co., and made, as before, in accordance with his suggestions and of materials and in a manner and style indicated by him, and during said last mentioned period was a general travelling representative for said firm of D. H. Baldwin & Co., engaged in selling their entire line of pianos to the wholesale trade; that said business between said Robert S. Howard and the said firm of D. H. Baldwin & Co., between the first day of January, 1899, and the 31st day of March, 1902, was carried on upon a salary and profit-sharing basis.

Defendant denies that the registrations in the United States Patent Office, heretofore referred to, of the name "Howard" were effected with the knowledge and acquiescence of said Robert S. Howard, but,

2616 on the contrary, defendant alleges that the same were effected wholly without his knowledge or consent or acquiescence, and that he was entirely ignorant of such registrations, and of the applications to register the same, until long after the same had been made;

Defendant admits that the pianos manufactured for and by the defendant are, and have been, sometimes described as made and sold by "R. S. Howard Co., New York," and are and have been, sometimes referred to as "R. S. Howard" and "R. S. Howard Co." pianos, but defendant denies that the pianos manufactured for or by the R. S. Howard Company have always been described as made by the "R. S. Howard Co. New York," or referred to as "R. S. Howard" or "R. S. Howard Co." pianos, but, on the contrary, defendant alleges that it is the general custom and practice, and has been such general custom and practice since the defendant corporation was organized, for the trade and public generally to designate and describe pianos made for or by the R. S. Howard Company as "Howard" pianos; defendant denies each and every allegation contained in paragraph marked X of the Bill of Complaint herein, which has not been expressly admitted heretofore in this paragraph marked "X" of this answer.

XI. Defendant admits that it is engaged in the Southern District of New York in the business of manufacturing and selling pianos, and has been so engaged continuously since the month of April in the year 1902; defendant admits that on or about the 6th day of August, 1914, it filed two petitions in the United States Patent Office for the cancellation of the two said trade-mark registrations, No. 31,411 and No. 46,993, and that said cancellation proceedings are now pending undetermined; defendant admits that it claimed in said petitions for cancellation priority of adoption and use of the name "Howard" as a trade-mark and trade-name for pianos; defendant admits that it is applying the name "Howard" and "R. S. Howard Co." to pianos of its manufacture by marking the same on the fall-board of said pianos; defendant admits that it is using the name "Howard" as a trade-mark and trade-name for pianos of its manufacture by marking on the fall-board of pianos of its manufacture the name "Howard" alone without qualification or explanation, except the addition of the words "New York," and is offering to sell, and is selling, pianos of its manufacture so marked within the Southern District of New York, and selling and shipping the same in commerce among the several states of the United States and between the United States and foreign countries; defendant admits that it is offering to sell, and is selling, pianos of its manufacture marked with the name "R. S. Howard Co." on the fall-board of its pianos in response to orders for "Howard" pianos of its manufacture, and sending to its customers, making such purchases, accounts of sales describing the pianos of its manufacture so sold and delivered as "Howard" pianos; defendant admits that it advertises, and has advertised, pianos of its manufacture as "Howard" pianos, as "R. S. Howard" pianos, and as "R. S. Howard Co." pianos; defendant admits that it intends to continue to use the name "Howard" in marking, and in connection with the advertisement and sale of, pianos of its manufacture.

2617 Defendant denies each and every allegation contained in paragraph marked XI of the Bill of Complaint herein, except those allegations which have not been expressly admitted heretofore in this paragraph marked "XI" of this answer.

XII. Defendant admits that in the said cancellation proceedings now pending in the United States Patent Office to cancel said trade-mark registrations No. 31,411 and 46,993, the Commissioner of Patents, on the sixth day of November, 1915, sustained a prior decision of the Examiner of Interferences of the United States Patent Office which permitted the R. S. Howard Company to file supplemental petitions for cancellation in said cancellation proceedings: defendant admits that in said supplemental applications to cancel said trade-mark registrations defendant alleged, among other things, that the mark registered by The Valley Gem Piano Company, under and by said trade-mark registration No. 31,411, and the mark registered by The Baldwin Company, under and by said trade-mark registration No. 46,993, were not marks properly or legally registrable at the time said registrations were secured; defendant also admits that the defendant alleged and claimed, among other things, in said cancellation proceedings, that the word "Howard" was and is a proper name, and merely the name of an individual, not written, printed, impressed, or woven in some particular or distinctive manner, and was and is a geographical term, and that it had not been in actual or exclusive use as a trade-mark of the applicants, or their predecessors from whom applicants derived title, for ten years next preceding the passage of the Act of Congress relating to registration of trade-marks, approved February 20th, 1905; defendant also admits that defendant also alleged and claimed in said supplemental applications to cancel said mark registered by The Valley Gem Piano Company, said trade-mark registration No. 31,411, that said The Valley Gem Piano Company had never made statutory use of said mark prior to its registration and that said mark had been abandoned; defendant also admits that since said cancellation proceedings were begun the plaintiff has registered the name "Howard" as a trade mark for pianos in some foreign countries; defendant admits that in some of said foreign countries in which plaintiff has registered the name "Howard" as a trade-mark for pianos since said cancellation proceedings were begun, plaintiff's right to such registration is based upon prior registration in the United States, and that without a certified copy of such registration in the United States, registration in several of said foreign countries could not have been secured; defendant also admits that the laws of some foreign countries provide that trade-marks registered therein shall cease to be protected on the expiration or cancellation of the registration of the corresponding trade-mark in applicant's home country.

Defendant denies each and every other allegation contained in paragraph marked XII of the Bill of Complaint herein except such as are expressly admitted herein in paragraph marked "XII" of this answer.

XIII. Defendant denies each and every allegation contained in paragraph marked XIII of the Bill of Complaint herein.

XIV. Defendant, further answering, alleges that continuously

2618 since about the year 1877 said Robert S. Howard has been engaged in the piano business and in selling pianos; that in the year 1889 said Robert S. Howard was engaged in the City of New York, State of New York, in the sale of pianos including pianos manufactured according to his suggestions and in a manner and style indicated by him; that in the year 1889, and in advance of all others, the said Robert S. Howard adopted, applied to pianos, and used "Howard" as his trade-name and trade-mark for pianos sold by him which were manufactured in accordance with his suggestions and in a manner and style indicated by him; that the said Robert S. Howard, beginning in the year 1889, continued to sell, throughout the United States and Canada, pianos which were made according to his suggestions, as aforesaid, and which were marked with his said trade-name and trade-mark "Howard," continuously until and up to the time said Robert S. Howard sold, assigned, and transferred said trade-name and trade-mark together with his said business and good-will of manufacturing and selling pianos, to this defendant; that said Robert S. Howard, beginning in the year 1889, sold pianos, throughout the United States, which were manufactured in accordance with his suggestions and in a manner and style indicated by him and which he caused to be marked "R. S. Howard & Co.," continuously from and including the year 1889, up to and including the year 1896; that said Robert S. Howard, beginning in the year 1893, sold pianos, throughout the United States, which were manufactured in accordance with his suggestions and in a manner and style indicated by him, and which he caused to be marked "Howard & Co." continuously from and including the year 1893 up to and including the year 1896; that said Robert S. Howard sold, assigned and transferred his entire business and good-will of manufacturing and selling pianos, together with all his said trade-names and trade-marks, including his said trade-name and trade-mark "Howard," to this defendant at the time of the incorporation and organization of this defendant which was on or about the third day of April, in the year 1902; that defendant has continued the said business of the said Robert S. Howard, and has continued to manufacture and to sell pianos, and has continued to mark pianos manufactured and sold by it with said trade-name and trade-mark "Howard," continuously from the time of said transfer and assignment of said business and trade-mark to it by said Robert S. Howard in the month of April, 1902, up to the present time, and is still continuing so to do; that upon the incorporation and organization of this defendant in April, 1902, the said Robert S. Howard became the President, General Manager and chief executive head of the defendant corporation, and now is, and ever since its organization has been, its President, General Manager and chief executive head; that this defendant, beginning in the year 1902, also marked pianos made and sold by it with the name "R. S. Howard Co.," and defendant has sold pianos so made and marked, throughout the United States and foreign countries, continuously from and including the year 1902 up to the present time; that the pianos marked with the said trade-name and trade-mark "Howard," and the pianos marked "R. S. Howard & Co.," "Howard & Co., and

2619 "R. S. Howard Co." now are, and for many years past, and continuously since the year 1889, have been known, described, designated, and called for as "Howard" pianos; that "Howard" used in connection with the manufacture and sale of pianos now is, and since the year 1889 has been, recognized by the trade—and public generally as indicating and designating pianos manufactured, as aforesaid, and sold by this defendant and said Robert S. Howard, its predecessor in business, and has served to indicate and distinguish such pianos from the pianos of all other piano manufacturers and dealers.

For a counterclaim against the plaintiff, the defendant realleges each and all of the allegations contained in Paragraphs marked I and XIV of this answer, and further alleges:

XV. That the name "Howard" placed on pianos, or used in connection with the manufacture or sale of pianos, has attained in the piano business a secondary meaning, and has become the designation and distinguishing mark and name of pianos of defendant's manufacture, both to the public and to the trade.

XVI. That defendant is informed and believes, and therefore alleges, that since said cancellation proceedings in the United States Patent Office, hereinbefore referred to, were begun by this defendant to cancel said trade-mark registrations No. 31,411 and No. 46,993, the plaintiff has secured registration of the name "Howard" as a trade-mark for pianos in several foreign countries, and that applications to register the name "Howard" by plaintiff are now pending in several other foreign countries; that several of said applications to register the name "Howard" as a trade-mark for pianos in foreign countries, as aforesaid, are based on one or both of said registrations in the United States Patent Office, to-wit: No. 31,411 and No. 46,993; that without such registration in the United States Patent Office and the submission of a certified copy of said registration, as a part of the application to register in several of said foreign countries in which plaintiff has registered or applied for registration of the name "Howard" as aforesaid, registration could not be obtained; that the effect of the registration of the name "Howard" as a trade-mark for pianos in foreign countries by plaintiff, as aforesaid, is to prevent this defendant from selling pianos bearing its said trade-name and trade-mark "Howard" in such foreign countries; that in certain foreign countries in which plaintiff has registered and has applied to register the name "Howard" as a trade-mark for pianos, as aforesaid, any person selling pianos bearing marks similar to, or resemblances of, registered trade-marks for pianos, renders such persons liable to fine and criminal prosecution and such pianos to confiscation; that defendant is engaged in shipping and selling pianos of its manufacture which bear its said trade-name and trade-mark "Howard" to practically all of the civilized countries of the world, and has been so engaged continuously for many years last past, and the registration by plaintiff of the said name "Howard" as a trade-mark for pianos in such foreign countries, as aforesaid, prevents, and will continue to prevent, this defendant from selling its pianos bearing its said trade-name and

2620 trade-mark "Howard" in such foreign countries, to the irreparable injury and damage of this defendant.

XVII. That on account of the skill and diligence exercised by this defendant and its predecessor in business in the selection of pianos, materials and methods of manufacture, this defendant's business has continuously increased from year to year, and such business has been established, extended and now exists throughout the United States and in most of the foreign countries of the world; that this defendant and its predecessor in business have invested and expended large sums of money for the purpose of introducing the pianos bearing its said trade-name and trade-mark "Howard," in establishing its business in said pianos, and in making it profitable; that such business is now carried on on a large and profitable scale by this defendant and is, and has been, a source of great profit to this defendant, and will continue to be a source of great profit to this defendant except for the violation and infringement of this defendant's rights by the plaintiff herein, and except for the unfair competition in business carried on by the plaintiff as against the defendant, as hereinbefore and hereinafter set forth.

XVIII. That plaintiff, in violation of defendant's rights in the premises, is selling pianos marked with the name "Howard" which are not of the defendant's manufacture, and is willfully, unlawfully and fraudulently offering to sell, and selling, such pianos in several of the states of the United States and in some foreign countries, thereby deceiving the public and enabling dealers to deceive the purchasing public into the mistaken belief that such pianos are "Howard" pianos of defendant's manufacture, and defendant alleges, upon information and belief, that the plaintiff is selling and enabling dealers, to whom it has sold pianos, to sell pianos marked with the name "Howard" in large numbers throughout the United States and in foreign countries as and for pianos of defendant's manufacture; that said acts and doing of plaintiff are, and have been, to the irreparable injury of, and great damage and loss to this defendant, and to the deception of the public; that the plaintiff threatens to continue such willful, unlawful and fraudulent practices unless restrained by an order of this court.

XIX. That defendant further shows unto your Honors that the acts of the plaintiff, hereinbefore recited, in falsely and fraudulently, willfully and unlawfully using the name "Howard" in marketing, advertising, and in connection with the sale of pianos not of defendant's manufacture, constitutes an unfair and fraudulent competition in business and is inequitable and unlawful and in plain violation of this defendant's rights, and that the said actions of the plaintiff necessarily have the effect of causing the sale of, and substitution of, plaintiff's pianos as and for pianos of defendant's manufacture, to the great injury, damage and loss to this defendant, and the deception of, and injury to, the public, and that the plaintiff is deriving large profits from such unfair and fraudulent competition in business and such unlawful and fraudulent practices; that this defendant cannot, with certainty, state the

2621 exact amount of profits realized by defendant from the sale of pianos so improperly marked, advertised and sold, but prays that the plaintiff may make full and true disclosure as to the same, and that the plaintiff may be decreed to account therefor in full, and otherwise to respond in damages as may appear to be equitable.

XX. Upon information and belief, defendant alleges that on, and for some time prior to the 12th day of October, in the year nineteen hundred and twelve, the plaintiff was the owner of all the shares of the capital stock except directors' qualifying shares of said The Valley Gem Piano Company, a corporation created and organized under the laws of the State of Ohio; that on the 12th day of October, in the year nineteen hundred and twelve, by unanimous action of its stockholders in meeting assembled, it was unanimously voted to change the corporate name of said The Valley Gem Piano Company to "The Howard Piano Company," and the President and Secretary of said The Valley Gem Piano Company were instructed and directed to take such action as was required by the laws of the State of Ohio, to the end that the corporate name of said The Valley Gem Piano Company should be changed to "The Howard Piano Company"; that pursuant to said resolution, the President and Secretary of said The Valley Gem Piano Company did, on or about the 15th day of October, in the year nineteen hundred and twelve, file in the office of the Secretary of State of the State of Ohio, a duly executed certificate of amendment to the Articles of Incorporation of said The Valley Gem Piano Company, changing its corporate name to "The Howard Piano Company," and that by reason of said action, and pursuant to the then existing laws of the State of Ohio, the corporate name of said The Valley Gem Piano Company was changed to "The Howard Piano Company," and that from and after the 15th day of October, in the year nineteen hundred and twelve, said The Valley Gem Piano Company became, and has since remained, "The Howard Piano Company"; that the corporate name "The Howard Piano Company" is a simulation of and near resemblance to, and colorable imitation of, the corporate name of the defendant herein; that the Howard Piano Company has, since the 15th day of October, in the year nineteen hundred and twelve, been engaged in the piano business; that said corporate name, and the use of said name "The Howard Piano Company," in the piano business, tends to create confusion and deception in, and has and does create confusion and deception among, the trade and public generally; that the object and purpose of the change of the corporate name of said The Valley Gem Piano Company to "The Howard Piano Company" was to deceive and confuse the public and enable the plaintiff to infringe upon the rights of this defendant, and to sell and pass off pianos made or sold by or through said The Howard Piano Company as and for pianos of this defendant's manufacture; that at the time the corporate name of said The Valley Gem Piano Company was changed to "The Howard Piano Company," one George W. Armstrong, Jr., was the President of said The Valley

2622 Gem Piano Company, and at the same time said George W. Armstrong, Jr., was an officer and director of the plaintiff herein; that said George W. Armstrong, Jr., is now the President of The Baldwin Company, the plaintiff herein, an [s]* is also at the present time the President of said "The Howard Piano Company"; that at the time the corporate name of said The Valley Gem Piano Company was changed to "The Howard Piano Company," one Levi D. Sargent was the Secretary of said The Valley Gem Piano Company, and at the same time said Levi D. Sargent was, and now is, a director of the plaintiff herein; that said Levi D. Sargent is now an officer and director of said "The Howard Piano Company"; that the plaintiff herein is still the owner of all of the shares of stock of The Howard Piano Company except directors' qualifying shares, and that such has been the fact since the 15th day of October, nineteen hundred and twelve; that the acts and doing of said "The Howard Piano Company" are entirely under the direction, control and domination of the plaintiff herein, and such has been the fact since the 15th day of October, in the year 1912.

To the end, therefore, that this defendant may obtain relief in the premises in this Honorable Court where it alone can obtain adequate relief, it humbly prays:

1. That the Baldwin Company, the plaintiff herein, be made to answer each and every allegation contained in this counterclaim, but not under oath, answer under oath being expressly and especially waived.

2. That R. S. Howard Company, this defendant, be adjudged to be the true, lawful and sole owner, and entitled to the exclusive use, of the name "Howard" as applied to pianos as a trade-name and trade-mark, and entitled to its exclusive use in any manner in connection with the marking, advertising and sale of pianos.

3. That The Baldwin Company, the plaintiff herein, its officers, agents, attorneys, servants, clerks, employees, workmen and confederates, and all persons claiming or holding through or under them and all in privity with them, and each and every one of them, be restrained and enjoined, both preliminary until final hearing and perpetually thereafter, by order, decree and writ of this Honorable Court, as follows:

(*a*) From directly or indirectly making, or causing to be made, selling, or causing to be sold, or offering for sale, marking, or advertising, or describing, either in correspondence with customers, in bills rendered, or in conversation with customers, any pianos as "Howard" pianos (other than those manufactured and sold by this defendant), or using the name "Howard" in any manner whatsoever in connection with the marking, advertisement or sale of pianos, not of this defendant's manufacture;

(*b*) From palming or passing off, or attempting to palm or pass off, pianos not made or sold by this defendant as and for this defendant's pianos, and from any and every violation

*[Words and figures enclosed in brackets erased in copy.]

2623 and infringement of this defendant's rights in the premises hereinbefore referred to or defined, and from any and all acts constituting unfair competition in trade with this defendant's business;

(*c*) From using the name "The Howard Piano Company," directly or indirectly, in connection with the manufacture or sale of pianos, and from using in the piano business any name which is such a stimulation or colorable imitation of, or near resemblance to, defendant's corporate name as would deceive, or be likely to deceive, the trade or public, or cause confusion;

(*d*) From registering, from applying to register, and from further prosecuting applications to register, in any and all foreign countries, the name "Howard" as a trade-mark for pianos based upon certified copies of said registrations No. 31,411 or No. 46,993 in the United States Patent Office.

4. That The Baldwin Company be compelled by order, decree and writ of this Honorable Court, to cancel all registrations obtained by it in foreign countries, of the name "Howard" as a trade-mark for pianos based upon certified copies of said registrations No. 31,411 or No. 46,993 in the United States Patent Office.

5. That The Baldwin Company, the plaintiff herein, be compelled to render, before a Master of this Court, a full, true, perfect and clear account of all profits realized by the plaintiff from the wrongful use of the name "Howard," and may be decreed to pay unto this defendant the full amount of such profits, and otherwise to respond in damages, as may appear to be equitable, according to the circumstances of this case, as well as all of defendant's costs, expenses and disbursements in this action.

6. That this defendant may have such other and further relief in the premises to which in equity it is entitled, as the same shall appear to be just and equitable, and that it may have such other and further relief the same as if it were here and now made the subject of a specific prayer.

7. And finally, to the end that equity may be done and the relief herein prayed for, and all other relief that it may be righteous in the premises to grant, may be awarded to this defendant, may it please your Honors such relief fully to grant, and that The Baldwin Company, the plaintiff herein, be commanded to stand, perform and abide such further orders, directions and decree as may be made against it by this Honorable Court.

And this defendant, as in duty bound, will ever pray, etc.

R. S. HOWARD COMPANY,

[CORPORATED SEAL.] By ROBT. S. HOWARD,
President.

SAMUEL S. WATSON,
Solicitor for Defendant,
Office and Post Office Address:
No. 32 Nassau Street,
New York City, N. Y.

2024 STATE OF NEW YORK,
County of New York, ss:

Robert S. Howard, being duly sworn, deposes and says, that he is the President of the R. S. Howard Company, the defendant named in the foregoing Answer; that he has read said Answer and Counterclaim and knows the contents thereof, and that the same is true of his own knowledge, except as to matters therein stated to be alleged on information and belief, and as to those matters he believes it to be true;

That the defendant is a corporation and the reason why this verification is not made by the defendant is because of that fact; that deponent's knowledge and the grounds of his information and belief, are derived from his active participation in the business of the defendant since the year 1902, and from information imparted to deponent by defendant's attorney in the Cancellation proceedings pending in the United States Patent Office, and deponent is the same Robert S. Howard who is defendant's predecessor in business, as set forth in the above answer.

ROBT. S. HOWARD.

Subscribed and sworn to before me, a Notary Public, this 7 day of January, 1916.

[SEAL.] THOMAS M. DELANEY,
Notary Public 29, City and County New York, Register Number 7069.

UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, Alexander Gilchrist, Jr., Clerk of the District Court of the United States for the Southern District of New York, do hereby certify that the Writings annexed to this Certificate have been compared by me with their originals on file and remaining of record in my office; that they are correct transcripts therefrom and of the whole of the said originals.

In Testimony Whereof I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, this 29th day of May, in the year of our Lord one thousand nine hundred and sixteen, and of the Independence of the said United States the one hundred and [thirty]* fortieth.

(Revenue Stamp.)

[SEAL.] ALEX. GILCHRIST, Jr.,
Clerk.

[*Words and figures enclosed in brackets erased in copy.]

2623 (Copy.)

Mail Room,
Jun- 1, 1916,
U. S. Patent Office.

Docket Clerk,
Jun- 1, 1916,
U. S. Patent Office.

Docket Clerk,
Jun- 3, 1916,
U. S. Patent Office.

REGISTRANTS' EXHIBIT F.

United States District Court, Southern District of New York.

In Equity. No. 13-75.

THE BALDWIN COMPANY, Plaintiff,

vs.

R. S. HOWARD COMPANY, Defendant.

Reply to Counter-Claim.

To the Judges of the District Court of the United States for the Southern District of New York:

The Reply of the Baldwin Company, the above named plaintiff, to the Counter-claim included in the Answer of the R. S. Howard Company, the above named defendant, in the above entitled cause.

First. Plaintiff denies that Robert S. Howard, beginning in the year 1889 and continuing to and including the year 1896, arranged with Thomas F. Scanlan and The New England Piano Company, piano manufacturers of Boston, Massachusetts, to make pianos for the customers and trade of Robert S. Howard to be marked "Howard"; denies that said pianos were made in accordance with suggestions and of materials and in a style indicated by Robert S. Howard; and denies that said pianos were sold by Robert S. Howard to his customers and to the trade generally throughout the United States and Canada from the year 1889 to and including the year 1895, or during any part of said time; plaintiff is without knowledge as to whether in the year 1896 said Thomas F. Scanlan and The New England Piano Company became financially embarrassed and unable to supply pianos to said Robert S. Howard.

Second. Plaintiff denies that in the latter part of the year 1896, or at any other time, said Robert S. Howard arranged with the firm of D. H. Baldwin & Company for the manufacture of pianos for him to be marked "Howard;" it denies that said pianos were to be made in accordance with his suggestions and in a manner and style indicated by him; it denies that said firm of D. H. Baldwin & Company arranged or agreed to supply said pianos to Robert S. Howard and,

2626 upon his orders, to his trade upon a fixed price and upon terms mutually agreed upon; it admits that said Robert S. Howard sold pianos marked "Howard" to customers and to the trade during his employment by said D. H. Baldwin & Company, but it denies that Robert S. Howard, at any time guaranteed the payment of the purchase price of pianos marked "Howard" to said D. H. Baldwin & Company; plaintiff admits that during his employment by said D. H. Baldwin & Company, between January 1st, 1899, and March 31st, 1902, said Robert S. Howard sold pianos marked "Howard" as part of his duties under his contract of employment with said D. H. Baldwin & Company, but it denies that said pianos were made in accordance with any suggestions of said Robert S. Howard or of materials or in a manner and style indicated by him, except he may have made some suggestions such as it was and is customary for all of the salesmen of The Baldwin Company and its predecessors D. H. Baldwin & Company to make from time to time relating to the styles of pianos offered in competition, which suggestions were or were not adopted by D. H. Baldwin & Company as it thought best; plaintiff admits that between the first day of January, 1899, and the 31st day of March, 1902, said Robert S. Howard was employed as a travelling salesman of D. H. Baldwin & Company in the territory assigned him by them and in accordance with the agreement between Robert S. Howard and D. H. Baldwin & Company, referred to in paragraph X of the bill of complaint herein.

Third. Plaintiff is without knowledge as to whether said Robert S. Howard has been engaged continuously since about the year 1877 in the business of selling pianos, but upon information and belief admits such is the case; plaintiff is without knowledge as to whether in the year 1889 said Robert S. Howard was engaged in the City and State of New York in the sale of pianos, including pianos manufactured according to his suggestions and in a manner and style indicated by him; plaintiff denies that in the year 1889, or at any other time, or in advance of all others, the said Robert S. Howard adopted, applied to pianos, and used "Howard" as his trade-mark and trade-name for pianos sold by him and manufactured in accordance with his suggestions and in a manner and style indicated by him; plaintiff denies that said Robert S. Howard, beginning in the year 1889, sold throughout the United States and Canada, or in any part of said countries, pianos made in accordance with his suggestions as aforesaid which were marked with his alleged trade-name and trade-mark "Howard," and that said sales continued until and up to the time said Robert S. Howard purported to sell, assign and transfer said alleged trade-name and trade-mark together with his alleged business and good-will of manufacturing and selling pianos to the defendant; plaintiff denies that the said Robert S. Howard owned the trade-mark "Howard" at the time of the said alleged sale of his alleged business and good-will to the defendant or at any other time, and denies that said Robert S. Howard had any business and good-will in the use of the trade-mark "Howard" for pianos, which might or could have been assigned by him to the said R. S. Howard Company; plaintiff denies that said Robert S. Howard, beginning in the

2627 year 1889, sold pianos throughout the United States or elsewhere, which pianos were manufactured in accordance with his suggestions or in a manner and style indicated by him and which he caused to be marked "R. S. Howard Co." or "R. S. Howard & Co.," continuously from and including the year 1889 up to and including the year 1896; denies that the said Robert S. Howard, beginning in the year 1893, sold pianos throughout the United States which were manufactured according to the suggestions and in a manner and style indicated by him which he caused to be marked "Howard Co." or "Howard & Co." continuously from and including the year 1893 up to and including the year 1896; denies that the said Robert S. Howard sold, assigned and transferred his so-called business and good-will of manufacturing and selling pianos together with all his alleged trade-names and trade-marks, including his alleged trade-name and trade-mark "Howard" to the R. S. Howard Company at the time of the incorporation and organization of the R. S. Howard Company on or about the 3rd day of April, 1902; denies that the said R. S. Howard Company has continuously manufactured and sold pianos marked with the trade-name and trade-mark "Howard" continuously from the time of said alleged transfer and assignment from Robert S. Howard to the R. S. Howard Company up to the present time and is still continuing so to do, except that the R. S. Howard Company, in violation of the exclusive rights of The Baldwin Company, has clandestinely and surreptitiously, without the knowledge and consent of The Baldwin Company committed the acts of infringement and unfair competition fully set forth in the Bill of Complaint herein.

Plaintiff has no knowledge as to whether or not Robert S. Howard, upon the incorporation and organization of the Robert S. Howard Company, became President, General Manager and chief executive head, and now is, and ever since said organization has been, its President, General Manager and chief executive head.

Plaintiff admits that, beginning with the year 1902, the R. S. Howard Company made and sold pianos marked with the name "R. S. Howard Co., New York," and upon information and belief admits that pianos so made and marked were sold throughout some of the States of the United States, but, upon information and belief, denies that pianos so marked have been continuously sold in foreign countries since the year 1902.

Plaintiff denies that pianos marked "R. S. Howard & Co." and "R. S. Howard Co." now are and for many years past and continuously since the year 1889 have been known, described, designated and called for as "Howard" pianos; denies that the name "Howard" used in connection with the manufacture and sale of pianos now is and since the year 1889 has been recognized by the trade and public generally as indicating and designating pianos manufactured for or sold by Robert S. Howard or manufactured and sold by the R. S. Howard Company; denies that the name "Howard" has served to indicate and distinguish the pianos manufactured by the R. S. Howard Company from the pianos of all other piano manufacturers and dealers.

2628 Fourth. Plaintiff denies that the name "Howard" placed on pianos or used in connection with the manufacture or sale of pianos has become the designation and distinguishing mark and name of pianos of defendant's manufacture either to the public or to the trade, and that said name "Howard" has acquired a secondary meaning as indicating pianos of defendant's manufacture.

Fifth. Plaintiff admits that it has secured registration of the name "Howard" as a trade-mark for pianos in a number of foreign countries; admits that applications to register the name "Howard" by the plaintiff are now pending in several other foreign countries; admits that some of the applications to register the name "Howard" as a trade-mark for pianos in foreign countries are based on United States certificate of registration No. 43,993, but denies that any of the existing registrations or pending applications to register the trade-mark "Howard" in foreign countries are based upon United States certificate of registration No. 31,411; admits that without registration of the corresponding mark in the United States Patent Office and submission of a certified copy thereof as a part of the application to register in some foreign countries in which plaintiff has registered, or applied for registration of the name "Howard" for pianos, registration could not be obtained; denies that the R. S. Howard Company has any right to sell pianos marked with the trade-name and trade-mark "Howard" either in the United States or any foreign countries; admits that in certain foreign countries in which plaintiff has registered or has applied to register the name "Howard" as a trade-mark for pianos as aforesaid, any person selling pianos bearing marks similar to or resemblances of registered trade-marks for pianos is liable to fine and criminal prosecution, but has no knowledge as to whether the laws of any foreign countries provide for the confiscation of pianos bearing names or marks similar or resembling registered trade-marks; plaintiff is without knowledge as to whether the defendant has ever sold any pianos of its manufacture bearing the trade-mark "Howard" alone without distinguishing initials in any foreith countries, but alleges that, if such pianos have been sold by the defendant, said sales thereof have been made in a clandestine manner and were an infringement of the plaintiff's said trade-mark and constitute unfair competition in trade; plaintiff does not know and is not advised how long the R. S. Howard Company has been continuously engaged, if at all, in shipping and selling its pianos to foreign countries; admits that the registration of the plaintiff's trade-mark "Howard" for pianos in foreign countries prevents the defendant from selling its pianos bearing an infringement of these registered trade-marks; but denies that the R. S. Howard Company is damaged or injured in any way by said applications and foreign registrations or prevented by these registrations from selling in these foreign countries pianos properly marked and identified as "R. S. Howard Co." pianos.

Plaintiff alleges, upon information and belief, that it or its predecessors in business were shipping pianos bearing the trade-mark "Howard" to all the foreign countries in which it has registered or

2629 made applications to register the word "Howard" as a trade-mark for pianos, long prior to the date that the R. S. Howard Company began shipping pianos to said countries; that the registration by the plaintiff of the word "Howard" as a trade-mark for pianos in foreign countries does not constitute an injury to the legitimate trade, business and good-will of the R. S. Howard Company inasmuch as the plaintiff on account of priority of use by its predecessors of the trade-mark "Howard" for pianos, in the United States and foreign countries is equitably entitled to such registrations; and that the action of the plaintiff in filing applications for registration of the trade-mark "Howard" for pianos and in registering its trade-mark "Howard" for pianos in foreign countries was not caused or induced by the pending cancellation proceedings in the United States Patent Office.

Sixth. Plaintiff is without knowledge as to whether on account of the skill and diligence of the defendant and its predecessors in business said defendant's business has continuously increased from year to year, and as to whether such business has been especially extended and now exists throughout the United States and in most of the foreign countries of the world; and it is without knowledge as to whether the defendant and its predecessors in business invested and expended large sums of money for the purpose of introducing its pianos or in establishing its business and making said business profitable; plaintiff is without knowledge as to whether defendant's said business is now carried on on a large and profitable scale, and as to whether the same is or has been a source of great profit to the defendant and will continue so to be; plaintiff denies that the defendant has any right to use the said word "Howard" either as a trade-name or trade-mark, and it denies that it has violated or infringed any of the defendant's rights in its trade-marks or trade-names or otherwise, and that it has carried on any unfair competition in business with the defendant.

Seventh. Plaintiff admits that it is selling pianos marked with the name "Howard" which pianos are not of defendant's manufacture, but it denies that said sales are in violation of any rights of the defendant, and that the said sales are in any way unlawful or fraudulent; plaintiff denies that it is in any way or manner deceiving the public, or enabling dealers to deceive the public, into the belief that the pianos sold by it bearing the word "Howard" are of the defendant's manufacture; it denies that it is selling or enabling dealers to sell its pianos marked with the name "Howard" in any place as and for pianos of defendant's manufacture, but it alleges that the name "Howard" on its pianos indicates to the dealers and to the public that said pianos are of its manufacture; it denies that it has committed any act which has resulted or will result in any injury or in any damage to the defendant; and it denies that it has in any way deceived the public or that it threatens so to do.

Eighth. Plaintiff denies that it has committed any acts which constitute an unfair and fraudulent competition in business with de-

2630 fendant; denies that any acts committed by it are inequitable and unlawful and in violation of the rights of the defendant; denies that any acts which it has committed have the effect of causing the sale of and substitution of, plaintiff's pianos as and for pianos of defendant's manufacture; denies that it has committed any act which has resulted or will result in any injury or any damage or any loss to the defendant, or the deception of and injury to the public; and denies that it has derived any profits from any unfair and fraudulent competition in business with the defendant or from any unlawful and fraudulent practices.

Ninth. Plaintiff admits that the name "The Valley Gem Piano Company" was changed to the name "The Howard Piano Company" in accordance with the laws of the State of Ohio; admits that it owned all of the shares of capital stock except directors' qualifying shares of The Valley Gem Piano Company and now owns all of the shares of the capital stock except directors' qualifying shares of The Howard Piano Company; denies that the R. S. Howard Company is injured or damaged in any way by such change; denies that there has been any confusion or conflict in trade due to any supposed similarity in the name "R. S. Howard Company" and the name "The Howard Piano Company;" denies that the said corporate name and the use of the name "The Howard Piano Company" in the piano business tends to create confusion and deception among the trade and public generally; denies that the object and purpose of the change of the corporate name of The Valley Gem Piano Company to "The Howard Piano Company" was to deceive and confuse the public and enable the plaintiff to infringe upon the rights of the defendant; denies that the plaintiff has ever sold, passed off or intends to sell or pass off pianos made by or through The Howard Piano Company as and for pianos manufactured by the R. S. Howard Company; admits that at the time the corporate name of The Valley Gem Piano Company was changed to "The Howard Piano Company," George W. Armstrong, Jr., was the President of The Valley Gem Piano Company and an officer and director of the plaintiff herein; admits that George W. Armstrong, Jr., is now the President of the plaintiff and also the President of The Howard Piano Company; admits that at the time the corporate name of The Valley Gem Piano Company was changed to "The Howard Piano Company," Levi D. Sargent was the secretary of The Valley Gem Piano Company and at the same time Levi D. Sargent was and now is a director of the plaintiff herein; admits that Levi D. Sargent is now an officer and director of The Howard Piano Company; admits that the plaintiff is still the owner of all the shares of stock of The Howard Piano Company except the directors' qualifying shares and that such has been the fact since the name of The Valley Gem Piano Company was changed to "The Howard Piano Company;" admits that The Howard Piano Company is entirely under the direction, control and domination of the plaintiff herein and has been during its corporate existence, but alleges that The Howard Piano Company is unknown to the public and its merely a name used for convenience in the plaintiff's business, that no pianos have

2631 ever been sold to the general public by The Howard Piano Company, or bearing the name of that company all of the product of the plaintiff, including the "Howard" pianos, being sold in the manner fully set forth in paragraph numbered VI of the Bill of Complaint.

Plaintiff denies each and every other allegation contained in paragraph marked XX of the counter-claim included in the defendant's answer except such as are expressly admitted herein in paragraph marked Ninth of this reply.

Tenth. Plaintiff alleges that in December 1896, its said predecessor firm, D. H. Baldwin & Company, with the knowledge and approval of Robert S. Howard, adopted the said word "Howard" as the trade-mark and trade name of pianos manufactured for and sold by it, and that said pianos bearing said trade-mark were sold in large quantities throughout the United States by said D. H. Baldwin & Company; that the said trade-mark was affixed to the pianos sold by D. H. Baldwin & Company and the plaintiff continuously since December, 1896, and acquired great value to plaintiff by reason of its association in the minds of the trade and public generally with the pianos of the plaintiff and its said predecessors, that said use and association of said trade-mark was at all times well known to said Robert S. Howard and to defendant, who acquiesced therein and permitted and allowed the plaintiff and its said predecessors to build up a large and valuable business in pianos bearing said trade-mark and trade-name "Howard;" that by reason of said acquiescence and the laches of itself and its predecessors shown as aforesaid, Defendant has forfeited all and any right, if such there may have been, which plaintiff denies, to the use of the word "Howard" as a trade-mark or trade-name for pianos, and is estopped to maintain its said counter-claim and is not entitled to an injunction or any of the relief prayed for in said counter-claim, but plaintiff alleges that, on the contrary, defendant has no right to the use of the name "Howard" as a trade-mark and trade-name for pianos and should be enjoined therefrom as set forth and prayed in the bill of complaint herein.

Wherefore the plaintiff prays that the counter-claim set up in the answer of the defendant be dismissed with costs.

THE BALDWIN COMPANY,

(Sgd.) By WETMORE & JENNER,
EDMUND WETMORE,
Solicitors for Plaintiff.

EDMUND WETMORE,
JOHN E. CROSS,
Of Counsel for Plaintiff.

2632 (Cover.)

United States District Court, Southern District of New York.

In Equity. No. 13—75.

THE BALDWIN —, Plaintiff,

vs.

R. S. HOWARD COMPANY, Defendant.

Replay to Counter-Claim.

John E. Cross & Edwin F. Samuels, Partners of the Late Firm of Steuart & Steuart, Counsellors at Law, Counsel for Plaintiff.
Wetmore & Jenner, Solicitors.

Filed —.

U. S. District Court. Filed Jan. 25, 1916. S. D. of N. Y.

—10.

K.

UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, Alexander Gilchrist, Jr., Clerk of the District Court of the United States for the Southern District of New York, do hereby Certify that the Writings annexed to this Certificate have been compared by me with their originals on file and remaining of record in my office; that they are correct transcripts therefrom and of the whole of the said originals.

In testimony whereof I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, this 29th day of May in the year of our Lord one thousand nine hundred and sixteen, and of the Independence of the said United States the one hundred and [thirty]* fortieth.

[SEAL.] ALEX. GILCHRIST, JR.,
Clerk.

(Revenue Stamp.)

[*Words and figures enclosed in brackets erased in copy.]

2633 REGISTRANT'S EXHIBIT G.

Docket Clerk,
Jun- 1, 1916,
U. S. Patent Office.

Mail Room,
Jun- 1, 1916,
U. S. Patent Office.

Docket Clerk,
Jun- 3, 1916,
U. S. Patent Office.

District Court of the United States, Southern District of New York.

Equity. 13—75.

THE BALDWIN COMPANY

vs.

R. S. HOWARD COMPANY.

Opinion.

Copy.

District Court of the United States, Southern District of New York.

Equity. 13—75.

THE BALDWIN COMPANY

vs.

R. S. HOWARD COMPANY.

Final hearing in Equity, plaintiff suing for infringement of trade-mark 31,411 registered May 8, 1898; also of trade-mark 46,993, registered October 17, 1905; also of the name "Howard" as a common law trade-mark for pianos, and for unfair competition in that the defendant uses, or threatens to use the name "Howard" in marking, and in connection with the sale of pianos, as distinguished from the name "R. S. Howard Company," "R. S. Howard Co.," or "R. S. Howard."

The registered trade-marks referred to cover the word "Howard" as applied to pianos, the earlier one in connection with certain initials indicative of the selling corporation, and the later one the same word displayed in a peculiar or distinctive manner of type.

The prayer of the bill is for the usual relief, and in addition that defendant be enjoined from further prosecuting certain cancellation proceedings now pending in the Patent Office in respect of the said two trade-marks.

The plaintiff Company is the successor in interest, title and business of the concerns (*interalios*) which registered said two trade-

2634 marks. Those concerns either made or sold (or both) pianos marked conspicuously "Howard" and known as Howard pianos. Since 1896 the plaintiff and its predecessors in title and business have pursued this trade, and the mark "Howard" has always been associated with a continuous trade which now belongs to plaintiff. The foregoing is so abundantly proven (and to a large extent undisputed) that the whole line of corporations or partnerships antecedent in business to the present plaintiff will be hereinafter spoken of as the "Baldwin Co." or the "Baldwin concern."

The defendant Company was organized in 1902 for the purpose of manufacturing and selling pianos. In it Mr. Robert S. Howard was and always has been the controlling spirit. The Company (so to speak) was made out of a piano factory in the city of New York plus the selling ability and salesman's reputation of Mr. Howard.

The defense is that the R. S. Howard Company is the successor of Mr. Howard, who was the first to adopt and use the name "Howard" as a mark for pianos in the year 1889; that he so continued until 1902, when he transferred his business, including the trademark or mark or name "Howard" to the defendant, which has continued to use that name down to the time this suit began.

Defendant therefore counterclaims and prays for affirmative relief in that it may be adjudged to be the sole owner and entitled to the exclusive use of the name "Howard" as a trade name or trademark applied to pianos, and that the plaintiff be enjoined from using that name or the name "Howard Piano Company" in connection with the manufacture and sale of pianos, and also from registering the name "Howard" as a trademark in foreign countries, and be compelled to cancel the existing registrations in the Patent Office.

Lawrence Maxwell, Edmund Wetmore, John E. Cross, and Oscar W. Jeffery, for plaintiff;
Samuel S. Watson, for defendant.

HOUGH, *D. J.*:

The cancellation proceedings above referred to were brought long before this suit, and the record herein largely consists of the evidence taken in the Patent Office by both parties. It is exceedingly voluminous, and descends into great detail. About these details there is that uncertainty, if not contradiction in non-essentials, which must always be the case when even intelligent and well-intentioned men testify regarding occurrences of many years ago.

After perusing the entire record, however, I am of opinion that as to all relevant facts (in the sense of visible or audible phenomena) there is almost no difference between the parties hereto. Contradictions exist, but they are rather in the inferences to be drawn from what was said or written than in respect of the happening of this or that event. I shall, therefore, make the findings of fact herein comparatively brief.

Mr. Robert S. Howard began his active career as a piano tuner

2635 in Ohio about 1877. He plainly developed ability far beyond the usual as a salesman, until in 1889 when he entered the employment of the New England Piano Company of Boston, I have no doubt that Mulcahy (one of the principal employees of the New England concern) testified accurately when he said that though he had never before met Mr. Howard, he had known of him for years as a piano salesman and traveller, and "we" (the New England people) "all congratulated ourselves on making the connection with him."

Nor is it doubted that Mr. Gibbs of Chicago, who has known Howard for a long time, correctly described him as a "very popular and prominent traveller and well liked by the trade."

The New England Company manufactured pianos in a Boston factory, one entrance to which was on Howard Street. There are indications that this fact had something to do with the use of the name "Howard" by that concern; but undoubtedly the principal and controlling reason for selling pianos of their make with any variant of the word "Howard" on the "fall-board" was due to the fact that Mr. Robert S. Howard wished to have it done when he became a salesman for the Company.*

The New England Piano Company's product consisted of two grades of pianos. The superior quality bore and was sold under its own name; the inferior product (consisting of about 40 per cent of the output) was given any name that any customer wished, and Mr. Howard's selection of his own name was but one instance of a common but harmless trade deception. It assisted Howard in selling pianos. The position of the purchaser is amusingly stated by Scanlon, who, when he was asked as to how a man who bought the piano knew the maker, replied, "You will have to ask that question of the fellow who sold it to him; I never attempted to explain that."

The first consignment of pianos bearing any variant of the name "Howard" went from the New England factory to the Pacific Coast in 1889, and I have no doubt from the testimony of Howard himself and from that (*Inter alios*) of Fox of Chicago, and Dierks of Pittsburgh, that Howard represented that the pianos he was selling were "made for him" by the New England Piano Company. This statement was not true. Mr. Howard did give to Scanlon and others his views as to how a piano should be regulated, both as to tone and action, and he probably also expressed opinions as to what constituted an attractive case; but it amounted to no more than what Scanlon testified to, viz: that it was always his custom with anybody that he employed to represent the concern outside, to have them go to the factory, see how the product was created, and "we were always glad to get suggestions, and always ready to try the suggestions."

The New England Company's piano that Howard sold was simply its second quality instrument, and he was a salaried employee. He did not buy the pianos, nor sell them at his own risk. Indeed Howard himself testified (in the cancellation proceeding and before this suit brought), "I never worked on a commission in my life."

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*The New England Piano Company was the trade name of one Scanlon, but it will be spoken of throughout this Opinion by its corporate sounding title.

2636 But he was paid a stipulated salary by the New England Company, which salary was not based on the number of pianos sold in any year, although he did get (apparently as a gratuity) $1,000 more than his agreed salary the first year he worked for the New England concern, and thereafter his salary was increased from year to year.

In 1894 Howard transferred his allegiance to Fischer & Company, but until 1896 or 1897, whenever he got a chance to sell a piano with the Howard mark upon it he did so and sent in the order to the New England Company. Scanlon says this ceased about 1897; it probably stopped in 1896. No other salesman except Howard sold pianos with the "Howard" mark upon them. No "royalty" was ever paid for the use of this name, but, as Howard himself testified, the sales were made "for the good of the New England Piano Company's business as a whole."

There is no doubt that from the time any variant of "Howard" was inscribed upon pianos the retail trade, the user and the public generally spoke of them as "Howard" pianos; but there is no completely satisfactory proof that the New England Company ever put out any piano bearing the word "Howard" alone. There is evidence that it was done, but after the most careful search, but one specimen of such a piano has been found in the whole United States, and I do not think that the exact date of this piano has been clearly shown. It is found that any use of the word "Howard" on the fall-board of a piano made by the New England Company was sporadic; but there were thousands sold under the title "R. S. Howard & Co.", "Howard New York," "Howard & Co., Boston," and "R. S. Howard & Co., Boston." After 1896 the New England Company completely ceased using any variant of the word "Howard"; whatever right to title they had in or to that name was abandoned.

In that year Howard entered the employment of the Baldwin concern. The arrangement was oral, and with a Mr. Wulsin, who died before suit brought. Howard says that pianos bearing his name were to be manufactured for him at an agreed price, of which he had a memorandum, and he was to be credited with the difference between that price and the price he obtained for them; *which was the same arrangement that he had had with the New England Company.* He guaranteed all the pianos and purchased outright from the Baldwin Company a good many instruments, which he either sold to dealers or consigned to them.

This testimony is untrue, because he never had any such arrangement with the New England Company, and it is utterly inconsistent with his previous oath that he never worked on a commission in his life. The account books produced by the plaintiff persuade me that until 1899 Howard did work on a commission; he did sell pianos bearing the name "Howard" with the adjuncts set forth in the first registered trade-mark; but he also sold all the other makes produced by plaintiff* if he could; and any other salesman for the plaintiff sold "Howards" if he found a market for them.

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*It is to be remembered that the word "Plaintiff" as used herein covers not only the Baldwin Company, but all its predecessors in business, and assignors of business.

2637 It is true that if Mr. Howard found a customer whom he liked and would take a risk on he guaranteed the account, but the sale was always made by the plaintiff, and the business of selling was the plaintiff's; and it was not until 1896 that the word "Howard" alone was habitually and extensively used on the fall-board of any piano.

In 1899, by written agreement, Howard became a salaried salesman for plaintiff, and within the territory allotted to him continued to do just what he had done from 1886-1899. In 1902 he resigned from plaintiff's employ, established the defendant Company, and began to put out pianos uniformly marked on the fall-board with the corporate name. I am of the opinion that there is no evidence that defendant corporation has ever put the word "Howard" alone on the fall-board of a piano; but there is no denial of the statement that beginning in or about 1913, the name "Howard" unaccompanied by any initials or addendum was placed upon the back of the piano.

The result of the foregoing is that with the exception of a few sporadic instances of which only one has (even by defendant's contention) been located the only piano labelled on its front with the word "Howard" (*simpliciter*) ever put forth in plaintiff's instrument, of which the sales have grown from about $140,000 in 1896 to upwards of a million dollars in 1914. This business is the result of the energy of the plaintiff, undoubtedly assisted from 1886-1902 by Mr. Howard for which assistance he was fully paid at rates presumably satisfactory to himself.

The foregoing findings of fact (if correct) leave the case resting upon legal principles so simple as to require but little discussion.

In and prior to 1896, if anybody had or could have a trademark in the word "Howard" or any variant thereof as applied to pianos, the New England Piano Company had it. Whatever that Company had it abandoned.

If Howard's story of the relations established by him with the Baldwin concern in 1896 were true, a good deal might be said in favor of the proposition that he had a trademark.

But not only is the statement untrue because inconsistent with other testimony of his own, and with the account books of the plaintiff (*as above shown*), but it largely consists in Howard's narration of what Mr. Wulsin said to him on his becoming a Baldwin salesman. This evidence is obviously obnoxious to Section 829 of the New York Code of Civil Procedure; but if considered such consideration renders Mr. Wulsin's report to his corporation of the circumstances of Howard's employment competent evidence.

Having regard to the probabilities of the matter and to the contradictions of Howard's testimony, I have no doubt that, as Wulsin stated, it was "clearly understood that the use of this name ("Howard") gives no rights to Mr. Howard other than his privilege to sell to dealers acceptable to us,—his compensation being price received in excess of $95 for style 7."

If Howard had no business when he entered the Baldwin employ

2638 and his agreement with plaintiff was as above found, he certainly created no business during his period of employment in the sense that must be assigned to that word in order to sustain trademark rights.

Down to 1902 Howard was not a manufacturer, a jobber or a retailer of pianos; he was a salesman, receiving (as he says) a salary only; or (as I believe) sometimes a salary and sometimes a commission, perhaps at times both; but always and all the time his relation to his employers was exactly that of a highly favored clerk who sells (for example) neckties over a counter, and being a well-dressed man himself is permitted to call one of his employer's styles of neckties by his own name.

That there can be no such thing as a transfer of a trademark in gross is too true to need citation to support it. If in 1902 Howard had no established business of his own he had no trademark.

That Mr. Howard had an established and well tested capacity to get business and make business is an entirely different thing; this he had, and this, and this alone, he contributed to the R. S. Howard Company. It seems to have turned out a valuable contribution. But because he had no business other than his own active mind and winning ways in 1902, he could not hand over to the defendant any rights even in his own name which were appurtenant to and dependent upon a business of manufacturing, buying and selling belonging to him. As above pointed out, he was not even a jobber, and never had been, and therefore the case much relied upon by defendant of Nelson vs. Winchell, 203 Mass., 75, is inapplicable.

What Howard did have in 1902 was the undeniable right to use his own name in his own business, and this he has done, and this is all he hoped to do (in my judgment) until about 1904, when we began to talk with plaintiff's New York representative about getting the control of the name "Howard." He followed up this thought in 1905 by beginning two actions in the Supreme Court of this State against plaintiff and some of its officers. The complaint in that case is instructive. It sets forth over Howard's verification that since 1889 Howard had manufactured or caused to be manufactured and sold a style of piano "created by him" which he caused to be marked with the name "Howard." That in 1897 after Howard had been manufacturing or causing to be manufactured and sold pianos bearing this name of "Howard" for upwards of eight years, he entered into an agreement with D. H. Baldwin & Co., whereby that concern "agreed to manufacture said pianos bearing the name "Howard" for said Robert S. Howard." And finally this complaint states that in consideration of this agreement he permitted Baldwin & Co. to use his name "Howard" upon pianos manufactured by them for sale in their stores.

It is further instructive to compare this verified complaint with defendant's verified application to cancel plaintiff's trademarks herein. In that application it is said that in 1889 and prior thereto Howard was engaged in New York in the sale of pianos manufac-

2639 tured for him, and in that year he adopted "Howard" as his trademark for the pianos manufactured for him and sold by him, and that he continued to have pianos so manufactured and marked continuously until the time he transferred said trademark, together with his business of manufacturing and selling pianos to the defendant herein.

The pleadings in the New York Court, in the Patent Office and in this Court when compared with the testimony appear to me to furnish a very strong confirmation of the result in matters of fact above attempted to be set forth.

This course of pleading and defendant's line of argument all rest, I think, upon the assumption that a trademark or trade-name is something that belongs to the first deviser thereof through every change of his business relations, and follows him like a Patent or a Copyright. On this point the recent decisions in *Hanover Co. vs. Metcalf*, 240 U. S. 403, is perhaps sufficient authority. My own views I have set forth at some length in *Carroll vs. M'Ilvaine*, 171 Fed. Rep., 125, aff'd 193 Fed. Rep., 82, and lately in *President Suspender Co. vs. McWilliams*, Opinion dated January 10, 1916.

The net result is that plaintiff, and plaintiff alone, is entitled to use the word "Howard" (*simpliciter*) on the fall-board of pianos, in the name of the Company that manufactures those pianos or handles them or sells them, and in advertising matter relating to pianos. Similarly the defendant and defendant alone is entitled to use "R. S. Howard" or "Robert S. Howard" in like manner. In other words their relations to the word "Howard" must remain as heretofore, and as acquiesced in by both parties until in 1914 Mr. Howard began the cancellation proceedings in the Patent Office.

I am inclined to think if this Court has the power, it is inadvisable to seek to prevent the continuance of the cancellation proceedings in the Office.

It is plain to me that the object of these proceedings is primarily to get rid of something which constitutes an obstacle to the extension into certain foreign countries (e. g. Cuba and Uruguay) of the business of the R. S. Howard Company.

I doubt whether under our law the name "Howard," being a not infrequent surname and place name, can be appropriated as a strict trademark. I have no doubt that the original registration in 1898 was made with the full knowledge and consent of Mr. Robert S. Howard. He admits the knowledge; the consent is implied from the course of business. But if he could not make a strict trademark out of his own name, I am unable to see how anybody else could do it even with his consent.

The defendant's counterclaim must be dismissed with costs, and the plaintiff given a decree with costs; but I incline to ground that decree solely on principles of unfair competition, and leave the trademark situation to take care of itself; but upon this point I am willing to hear further argument if the matter is pressed, as it was not much alluded to in argument.

C. M. HOUGH, *D. J.*

May 15, 1916.

2640 District Court of the United States, Southern District of New York.

E. 13–75.

THE BALDWIN COMPANY

vs.

G.
R. [S.]* HOWARD COMPANY.

Memorandum on Settlement of Final Decree.

Memorandum.

After reflection, I am convinced that the proper order should preserve that status of the parties to this suit which existed until the defendant began to stamp "Howard" merely on the back of its pianos and to encourage advertising (if not to advertise itself) under the name "Howard" alone.

The defendant has never used "Robert S. Howard" or "R. S. Howard" without the suffix "Company" or "Co." There is no reason why it should do it; there is no evidence that it has any right to do it,—although Mr. Howard could doubtless create that right (so far as he is concerned) at any moment.

The plaintiff has the superior right, and that superior right can best be maintained by requiring the suffix "Company" or "Co." to be used by the defendant.

I have therefore signed the decree as propounded by plaintiff.

C. M. HOUGH, *D. J.*

May 23, 1916.

UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, Alexander Gilchrist, Jr., Clerk of the District Court of the United States for the Southern District of New York, do hereby certify that the Writings annexed to this Certificate have been compared by me with their originals on file and remaining of record in my office; that they are correct transcripts therefrom and of the whole of the said originals.

In Testimony Whereof I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, this 29th day of May, in the year of our Lord one thousand nine hundred and sixteen and of the Independence of the said United States the one hundred and [thirty]* fortieth.

(Revenue Stamp.)

[SEAL.] ALEX. GILCHRIST, JR.,
Clerk.

[*Words and figures enclosed in brackets erased in copy.]

2641 REGISTRANT'S EXHIBIT H.

Mail Room,
Jun- 1, 1916,
U. S. Patent Office.

Docket Clerk,
Jun- 1, 1916,
U. S. Patent Office.

Docket Clerk,
Jun- 3, 1916,
U. S. Patent Office.

Copy.

At a Term of the United States District Court for the Southern District of New York, held at the Court Rooms thereof, in the Borough of Manhattan, City of New York, on the 23rd day of May, 1916.

Present: Honorable Charles M. Hough, Judge.

In Equity. No. 13—75.

THE BALDWIN COMPANY, Plaintiff,

vs.

R. S. HOWARD COMPANY, Defendant.

This cause came on to be heard at this term, and was argued by counsel; and thereupon, upon consideration thereof, it was

Ordered, adjudged and decreed, as follows, viz.:

First. That the name "Howard," without prefix or suffix, on pianos, or contained in advertisements or otherwise used in connection with pianos, indicates that the pianos bearing or referred to by said name, are the product of the plaintiff, The Baldwin Company, and said name "Howard" distinguishes plaintiff's pianos from the pianos of all other manufacturers; and that the plaintiff, The Baldwin Company, and its predecessors in business, have been ever since December, 1896, and The Baldwin Company now is the true, lawful and sole owner of said word "Howard" as a name for its pianos, and it alone is entitled to use the said word (simpliciter) on pianos, or in advertising matter relating thereto.

Second. That the defendant, R. S. Howard Company, has infringed upon and violated the rights of the plaintiff in its said name "Howard" by threatening to use the said word on pianos not the product of the plaintiff, and by using the same in advertisements and otherwise in connection with the sales of its said pianos, and by placing said name on the back of its pianos.

Third. That an injunction issue out of and under the seal of this court restraining and enjoining said defendant, R. S. Howard Company, its officers, agents, servants, clerks, employees and workmen, and all persons claiming or holding through or under it or in privity

2642 with it, and each and every of them, perpetually and forever, from directly or indirectly making or causing to be made, selling or causing to be sold or offering for sale pianos bearing the said word "Howard" and not the product of the plaintiff, except with the initials "R. S." or the name "Robert S." prefixed and the word "Company" affixed to said word "Howard" wherever the said word appears on said pianos or boxes or packages containing the same, and from marking or advertising or describing in any manner by said word, pianos not the product of the plaintiff except with the initials "R. S." or the name "Robert S." prefixed to said word and with the word "Company" affixed thereto in as conspicuous and prominent a manner as the word "Howard," and from marking, advertising or describing pianos manufactured or sold by it with any name or in any manner calculated or liable to confuse or deceive purchasers into the belief that said pianos are the product of the plaintiff.

Fourth. Plaintiff having waived its rights to recover any profits and damages to which it may be entitled by reason of the aforesaid infringement and violation of its rights, there will be no accounting for profits or damages by the defendant.

Fifth. That the plaintiff has the right to use the name "The Howard Piano Company" as a name for one of the corporations owned and controlled by it, and it alone is entitled to use the word "Howard" without prefix or suffix in the name of any company, firm or corporation that manufactures pianos bearing said name; and that the defendant's counter-claim be, and it hereby is, dismissed with costs.

Sixth. That the plaintiff recover costs from the defendant.

C. M. HOUGH, *D. J.*

UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, Alexander Gilchrist, Jr., Clerk of the District Court of the United States for the Southern District of New York, do hereby certify that the writings annexed to this Certificate have been compared by me with their originals on file and remaining of record in my office; that they are correct transcripts therefrom and of the whole of the said originals.

In testimony whereof I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, this 29th day of May, in the year of our Lord one thousand nine hundred and sixteen, and of the Independence of the said United States the one hundred and [thirty]* fortieth.

Revenue Stamp.

[SEAL.] ALEX. GILCHRIST, JR.,
Clerk.

*[*Words and figures enclosed in brackets erased in copy.]*

2643 REGISTRANT'S EXHIBIT I.

Mail Room,
Jun- 1, 1916,
U. S. Patent Office.

Docket Clerk,
Jun- 3, 1916,
U. S. Patent Office.

Docket Clerk,
Jun- 1, 1916,
U. S. Patent Office.

Copy.

The President of the United States to R. S. Howard Company, its officers, agents, servants, clerks, employees and workmen, and all persons claiming or holding through or under it, or in privity with it, and each and every of them, Greeting:

Whereas, it has been represented to us in our District Court of the United States for the Southern District of New York, in the Second Circuit, in a suit brought in said Court by The Baldwin Company, as plaintiff, against R. S. Howard Company, as defendant, that you, the said defendant, have infringed upon and violated the rights of the plaintiff in the word "Howard" for pianos by using and threatening to use the said word "Howard" without prefix or suffix on pianos not the product of the said plaintiff, and by using the said word in advertisements and otherwise in connection with the sales of your said pianos, and by placing said word on the back of your said pianos.

Now, therefore, we strictly restrain and enjoin you the said R. S. Howard Company, your officers, agents, servants, clerks, employees and workmen and all persons claiming or holding through or under you, or in privity with you, and each and every of them, perpetually and forever, from directly or indirectly making or causing to be made, selling or causing to be sold or offering for sale pianos bearing the said word "Howard" and not the product of the plaintiff, except with the initials "R. S." or the name "Robert S." prefixed and the word "Company" affixed to said word "Howard" wherever the said word appears on said pianos or boxes or packages containing the same, and from marking or advertising or describing in any manner by said word, pianos not the product of the plaintiff except with the initials "R. S." or the name "Robert S." prefixed to said word and with the word "Company" affixed thereto in as conspicuous and prominent a manner as the word "Howard," and from marking, advertising or describing pianos manufactured or sold by it with any name or in any manner calculated or liable to confuse or deceive purchasers into the belief that said pianos are the product of the plaintiff.

Witness the Honorable Charles M. Hough, Judge of the United States District Court for the Southern District of New York, at the Borough of Manhattan, City and State of New York, on the 24th day of May, 1916.

[SEAL.] ALEX. GILCHRIST, JR.,
Clerk.

107

2644 UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, Alexander Gilchrist, Jr., Clerk of the District Court of the United States for the Southern District of New York, do hereby certify that the writings annexed to this Certificate have been compared by me with their originals on file and remaining of record in my office; that they are correct transcripts therefrom and of the whole of the said originals.

In testimony whereof I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, this 29th day of May, in the year of our Lord one thousand nine hundred and sixteen, and of the Independence of the said United States the one hundred and [thirty]* fortieth.

Revenue Stamp.

[SEAL.] ALEX. GILCHRIST, JR.,
Clerk.

Docket Clerk,
Dec. 1, 1916,
U. S. Patent Office.

Mail Room,
Dec. 1, 1916,
U. S. Patent Office.

United States Circuit Court of Appeals for the Second Circuit.

THE BALDWIN COMPANY, Complainant-Appellee,

against

R. S. HOWARD COMPANY, Defendant-Appellant.

Before Coxe, Ward and Rogers, Circuit Judges.

On appeal from a decree of the District Court for the Southern District of New York in an action brought by the Baldwin Company against the R. S. Howard Company for unfair competition by reason of the use by the defendant of the complainant's trade-mark "Howard" upon pianos not made or sold by the complainant. The opinion of the District Court is reported in 233 Fed. Rep., 439.

Lawrence Maxwell, Edmund Wetmore, John E. Cross and Oscar W. Jeffery, for Complainant-Appellee.
Samuel S. Watson, for Defendant-Appellant.

COXE, *J.:*

This is an action in equity upon the trade-mark "Howard" as applied to pianos. The custom of the trade is to stencil the name upon the front of the pianos just above the keyboard and also upon

[*Words and figures enclosed in brackets erased in copy.]

2645 the cases in which the pianos are shipped. The question here is whether the R. S. Howard Company, the defendant, has a right to use the word "Howard" as a trade-mark in connection with sales of pianos manufactured by it. That it may use its own name, R. S. Howard Company, is not disputed, but the contention is that the complainant has a right to the use of the name "Howard" alone as applied to the fall-board of the pianos manufactured by it because of its long use and also because of the defendant's acquiescence in that use. The Baldwin Company adopted the name "Howard" alone to designate pianos sold by it in 1896 with the full knowledge of R. S. Howard and procured the trade-mark in that name with his acquiescence. It has built up a large and flourishing business in this manner, with the knowledge of R. S. Howard and it would now be most inequitable to permit him to destroy this business and reap the fruits thereof by transferring a large part thereof to himself. He has a perfect right to use his own name, R. S. Howard, in the piano business but he has not at this late day the right to appropriate the good will of the complainant's business by the use of the trade-mark "Howard," which has by long use come to mean the pianos sold by the complainant.

The name "Howard" without prefix or suffix, when used in connection with pianos, indicated that they were the product of the Baldwin Company, the complainant herein. There can be no doubt as to the wide publicity given by the complainant to the "Howard" piano and the large sales made by it under that name. In other words, it was the enterprise, energy, capital and brains of the complainant company that established and maintained the reputation of the Howard Piano and that company is entitled to have its rights protected. The facts necessary to understand the situation are fully set out in the opinion of Judge Hough and need not be repeated here.

The appellant disputes the validity of the trade-mark registrations but it is contended that the validity of these registrations is not in issue in this case, at least so far as this court is concerned. The appellee's brief contains the following:

"The appellant's brief attacks the plaintiff's right to its trade-mark registrations, but the validity of the registrations is not in issue in the case. At the final hearing below, plaintiff did not claim infringement of its registrations and confined its charge of infringement solely to its common law rights in the name "Howard," and Judge Hough at the close of his opinion said:

'I incline to ground that decree solely on principles of unfair competition, and leave the trade-mark situation to take care of itself; but upon this point I am willing to hear further argument if the matter is pressed, as it was not much alluded to in argument.'

"The matter was not pressed by either side and therefore there is no finding about it in the decree. It was evidently the opinion of the Court below that all questions concerning the validity of the registrations should be left to the Cancellation Proceedings instituted by the R. S. Howard Company in the Patent Office and now about to come to final hearing there."

2646 We are inclined to think that the court was not called upon to hear what were practically moot questions not essential to a decision and which, even if decided according to the appellant's contention, would not affect the controlling question in the least.

The decree of the District Court is affirmed.

A true copy.

[SEAL.]

WM. PARKIN,
Clerk.

Docket Clerk,
Dec. 1, 1916,
U. S. Patent Office.

Mail Room,
Dec. 1, 1916,
U. S. Patent Office.

United States Circuit Court of Appeals for the Second Circuit.

THE BALDWIN COMPANY, Complainant-Appellee,
against
R. S. HOWARD COMPANY, Defendant-Appellant.

Before COXE, WARD and ROGERS, Circuit Judges.

WARD, *Circuit Judge* (concurring):

I concur in the opinion of the court but think we should go further. The complainant set up in its bill ownership of a trade-mark for the word "Howard" registered under the Act of 1881 and of another such trade-mark registered under the Act of 1905, and prayed that it might be declared the exclusive owner of both. The defendant in its answer alleged that both these trade-marks were registered without authority of law and in its counterclaim prayed for affirmative relief, viz., that such registrations be declared invalid. This is relief we have power to grant, and I think we should do so because as to the trade-mark registered under the Act of 1881 there is no evidence that it was ever used in commerce with foreign countries or with the Indian tribes, and as for the trade-mark registered under the Act of February 20, 1905, it was a surname and not used for ten years before the passage of the act or displayed in such a particular or distinctive manner as to fall within the exception contained in Section 5 and so was not entitled to registration. The defendant duly assigned error to the decree in this respect and argued the question in its brief and at the hearing.

A true copy.

[SEAL.]

WM. PARKIN,
Clerk.

[Endorsed:] 48,452/18. 34,958/18.

Endorsed on cover: Commissioner of Patents. Patent Appeal Docket, No. 1201. R. S. Howard Company, appellant, vs. The Baldwin Company, and No. 1202. R. S. Howard Company, appellant, vs. The Valley Gem Piano Company (The Howard Piano Company, substituted) et al. Court of Appeals, District of Columbia. Filed Apr. 3, 1918. Henry W. Hodges, clerk.

2647 Thursday, January 16th, A. D. 1919.

* * * * * * *

No. 1201.

R. S. HOWARD COMPANY, Appellant,

vs.

THE BALDWIN COMPANY,

and

No. 1202.

R. S. HOWARD COMPANY, Appellant,

vs.

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY Substituted) and THE BALDWIN COMPANY.

The argument in the above entitled causes was commenced by Mr. Sam'l S. Watson, attorney for the appellant.

Friday, January 17th, A. D. 1919.

* * * * * * *

No. 1201.

R. S. HOWARD COMPANY, Appellant,

vs.

THE BALDWIN COMPANY,

and

No. 1202.

R. S. HOWARD COMPANY, Appellant,

vs.

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY Substituted) and THE BALDWIN COMPANY.

The argument in the above entitled causes was continued by Mr. Sam'l S. Watson, attorney for the appellant, and by Mr. Lawrence Maxwell, attorney for the appellees, and was concluded by Mr. J. E. Cross, attorney for the appellees.

2648 In the Court of Appeals of the District of Columbia.

Patent Appeal No. 1201.

R. S. Howard Company, Appellant,

vs.

The Baldwin Company,

and

Patent Appeal No. 1202.

R. S. Howard Company, Appellant,

vs.

The Valley Gem Piano Company (The Howard Piano Company Substituted) and The Baldwin Company.

Mr. Justice Van Orsdel delivered the opinion of the Court:

These are cancelation proceedings brought by R. S. Howard Company, a corporation, against the Baldwin Company, a corporation. One is to cancel the certificate of registration of a trade-mark consisting of the word "Howard" registered by the Baldwin Company on October 17, 1905, and the other is to cancel the certificate of registration for a trade-mark consisting of the word "Howard" in connection with the initials "V G P Co." arranged in monogram, registered by the Valley Gem Piano Company on March 8, 1898, and now owned by the Baldwin Company. Both marks were registered as trade-marks for pianos.

These cases were consolidated and heard together in the Patent Office, and will be so considered here. From the decision of the Commissioner denying the petition, the Howard Company appeals.

It appears that appellant corporation was organized in 1902, and that for a number of years prior to that R. S. Howard, the organizer of the corporation, had been an agent for the sale of pianos for the Baldwin Company. During that period, Howard sold pianos extensively throughout the country bearing the trade-mark "Howard." It appears, however, that pianos similarly marked were extensively sold by the Baldwin Company through other agencies than R. S. Howard. After its organization, the Howard Company sold
2649 pianos marked on the fall-board "R. S. Howard Company," and advertised itself extensively as manufacturers of "Howard" pianos.

This resulted in a suit by the Baldwin Company against the Howard Company for unfair competition in the United States District Court for the Southern District of New York (233 Fed., 439), resulting in a decree restraining the Howard Company from making or selling pianos bearing the word "Howard" alone, but permitting it to use the marks "R. S. Howard Company" and "Robert S. Howard

Company." The decree was affirmed by the United States Circuit Court of Appeals (238 Fed., 154).

While an attempt was made to involve the present proceeding in that case, the court refused to interfere with its course in the Patent Office. The district judge, in his opinion, said: "I am inclined to think if this court has the power, it is inadvisable to seek to prevent the continuance of the cancellation proceedings in the Office. It is plain to me that the object of these proceedings is primarily to get rid of something which constitutes an obstacle to the extension into certain foreign countries (e. g. Cuba and Uruguay) of the business of the R. S. Howard Company. I doubt whether under our law the name "Howard," being a not infrequent surname or place name, can be appropriated as a strict trade-mark. I have no doubt that the original registration in 1898 was made with the full knowledge and consent of Mr. Robert S. Howard. He admits the knowledge; the consent is implied from the course of business, but if he could not make a strict trade-mark out of his own name, I am unable to see how anybody else could do it even with his consent." The Circuit Court of Appeals, referring to the validity of the trade-mark registration, said: "The appellee's brief contains the following: * * * 'The matter was not pressed by either side and therefore there is no finding about it in the decree. It was evidently the opinion of the Court below that all questions concerning the validity of the registrations should be left to the Cancellation Proceedings instituted
2650 by the R. S. Howard Company in the Patent Office and now about to come to final hearing there.' We are inclined to think that the court was called upon to hear what were practically moot questions not essential to a decision and which, even if decided according to the appellant's contention, would not affect the controlling question in the least."

The Court decisions can be dismissed from further consideration, since they were confined solely to the question of unfair competition, a matter of no concern in this proceeding, either by way of estoppel or otherwise. We are here dealing with the validity of the registration of the marks in question, in a proceeding in which the Commissioner of Patents is vested by statute with exclusive jurisdiction. Section 13 of the Trade-Mark Act of February 20, 1905, provides "That whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The Commissioner shall refer such application to the examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the Commissioner shall cancel the registration. Appeal may be taken to the Commissioner in person from the decision of the examiner of interferences." Section 5 of the same act, as amended by the act of March 2, 1907, among other things, forbids the registration of a "mark which con-

sts merely in the name of an individual, firm, corporation, or associ-
tion, not written, printed, impressed, or woven in some particular or
distinctive manner or in association with a portrait of the individual."

Unquestionably, the Baldwin Company was the first to make a trade-mark use of the word "Howard," but in our view of the case that is of no importance. The sole question here is, Was the Bald-
2651 win Company entitled to the exclusive use of this mark on the date of its application for registration? If not, has the Howard Company been injured by the registration of the mark? The right to register the name of a person or corporation, except under conditions not present in either of these cases, is expressly forbidden. Rogers vs. International Silver Co., 34 App. D. C. 410. The mark in the Baldwin case and the dominating feature of the mark in the Valley Gem case is not only a common surname, but the name of appellant corporation, either of which is sufficient to prohibit the right of registration or to form the basis of an action for cancelation. As was said by Mr. Chief Justice Fuller in Howe Scale Co. vs. Wyckoff, Seaman & Benedict, 198 U. S., 118, 134: "But it is well settled that a personal name cannot be exclusively appropriated by any one as against others having a right to use it; and as the name 'Remington' is an ordinary family surname, it was manifestly incapable of exclusive appropriation as a valid trade-mark, and its registration as such could not in itself give it validity. Brown Chemical Co. vs. Meyer, 139 U. S., 540; Singer Manufacturing Company vs. June Manufacturing Company, 163 U. S., 169; Elgin National Watch Company vs. Illinois Watch Case Company, 179 U. S., 665."

It will be observed that the statutory prohibition relates back to the date of adoption. If it was then "incapable of exclusive appropriation," its validity may be assailed by any one possessing the right. The question of priority of use is immaterial if no right to the use ever existed. As this court said in Asbestone Co. vs. Philip Carey Mfg. Co., 41 App. D. C., 507, 509: "The statute takes from the realm of possible registration the name of an individual, firm, corporation, or association, except under conditions not existing in this case. This limitation is founded upon sound principles of public policy. 'A man's name is his own property, and he has the same right to its use and enjoyment as he has to that of any other species of property.' Brown Chemical Co. vs. Meyer, 139 U. S., 540.
2652 The same rule applies to a corporation. 'That the name of a corporation is an essential part of its being, and that the courts, independent of statutory provision, will protect the corporation in the use of its name, seems to be well settled by the authorities, and the controlling principles in such a case are those applicable to trade-marks.' Investor Pub. Co. vs. Dobinson, 72 Fed., 603. The converse is equally true. Had appellee been using the mark when appellant incorporated, it could not, by mere adoption of the name, have created an exclusive right to its use. Goodyear's India Rubber Glove Mfg. Co. vs. Goodyear Rubber Co., 128 U. S., 598."

It follows that, at the date of the adoption of the mark by both the Valley Gem and Baldwin Companies, the word "Howard" was a surname in common use, and not available to either for registra-

tion as a trade-mark. But the statute goes further, and requires that the registrant must be entitled to the use of the mark at the date of his application for registration thereof. When the Baldwin Company applied for the registration of the word "Howard," the Howard Company was in existence and a direct competitor of applicant in the piano business. Hence, the registration of its competitor's name was sought and secured in direct violation of the express terms of the statute.

But it is said that the Howard Company has not shown that it has been injured by the registration of its name. The element of damage enters into the right to challenge the registration of a technical trade-mark either in an opposition or a cancellation proceeding. In either case, the complaining party must show that he would be damaged unless the relief sought is granted. But, where the party is seeking to prevent the adoption of his name as a trade-mark or the cancelation of its registration, his action is grounded upon the invasion of a property right inhering in the name itself, and damage will be presumed. As we said in the Asbestone case, supra: "It is not the business which the statute in this particular aims to protect. It is the corporate name, and it is sufficient that possible damage may be inferred from invading the property right 2653 which the corporation possesses in its name."

Section 13 of the act of 1905 provides a remedy which applies to registrations existing at the date of its passage, as well as to registrations made subsequent to its enactment. In Black Beauty Coal Co. vs. Hamilton Coal Co., 197 O. G., 928, Commissioner Ewing said: "I see no reason why section 13 of the Trade-mark Act of 1905 should not be held to apply to trade-marks registered under the earlier act. Section 13 does not alter in any way the right of a registrant to his trade-mark, but merely provides a new remedy in case a trade-mark is registered by a party who never had or who has abandoned any right thereto. The language in section 13 is broad enough to cover registration under the earlier act, and there is no reason for limiting its plain meaning."

The same interpretation was placed upon the statute by this court in Stamatopoulos vs. Stephano Bros., 41 App. D. C., 580, where we said: "The registration of trade-marks is regulated entirely by statute. There is no such property right acquired by registration as either forbids regulation or abolition by a subsequent act of Congress. Section 13 relates entirely to procedure in the Patent Office. The act of 1881 did not provide for challenging a registration by a proceeding for cancelation. The act of 1905 for the first time furnished this speedy and sensible remedy. Being merely remedial and a matter of procedure, it was within the power of Congress to make it apply to all marks registered in the Patent Office. Intention to make it apply only to future marks is not indicated in the later act. Neither do we find anything to that effect in the saving clause in sec. 30 of the act. Provision as to cancelation did not exist in the prior acts, hence the saving clause in the later act could have no reference to that subject."

The decision of the Commissioner of Patents is reversed, and the clerk is directed to certify these proceedings as by law required.

Reversed.

2654 Monday, March 3rd, A. D. 1919.

* * * * * * * *

January Term, 1919.

No. 1201.

Cancellation No. 46,993.

R. S. Howard Company, Appellant,

vs.

The Baldwin Company,

and

No. 1202.

Cancellation No. 31,411.

R. S. Howard Company, Appellant,

vs.

The Valley Gem Piano Company (The Howard Piano Company Substituted) and The Baldwin Company.

Subject Matter: Trademark for Pianos.

Appeals from the Commissioner of Patents. These causes came on to be heard on the transcript of the record from the Commissioner of Patents and were argued by counsel. On consideration whereof, It is now here ordered and adjudged by this Court that the decisions of the said Commissioner of Patents in these causes be and the same are hereby reversed.

Per Mr. Justice VAN ORSDEL.

March 3, 1919.

2655 Court of Appeals, District of Columbia. Filed Mar. 22, 1919. Henry W. Hodges, Clerk.

In the Court of Appeals, District of Columbia.

Patent Appeal No. 1201.

R. S. HOWARD COMPANY, Appellant,

vs.

THE BALDWIN COMPANY,

and

Patent Appeal No. 1202.

R. S. HOWARD COMPANY, Appellant,

vs.

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY Substituted) and THE BALDWIN COMPANY.

Petition for Rehearing.

Lawrence Maxwell, John E. Cross, Attorneys.

2656 In the Court of Appeals, District of Columbia.

Patent Appeal No. 1201.

R. S. HOWARD COMPANY, Appellant,

vs.

THE BALDWIN COMPANY,

and

Patent Appeal No. 1202.

R. S. HOWARD COMPANY, Appellant,

vs.

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY Substituted) and THE BALDWIN COMPANY.

Petition for Rehearing.

The petition of The Baldwin Company, proprietor of Trade-mark Registrations No. 31,411, dated March 8, 1898, and No. 46,993, dated October 17, 1905, and appellee in the above entitled cause, respectfully represents to this Honorable Court:

The Court in its opinion, says:

"The sole question here is, was the Baldwin Co. entitled to the exclusive use of this mark on the date of its application for registration? If not, has the Howard Company been injured by the registration of the mark?"

It is well settled by the decisions of the Court, and recognized in the opinion, that it is unnecessary to answer the first question if the second is answered in the negative.

657 The answer which the Court has given to the second question fails to give due faith and credit as required by the Constitution and Laws of the United States to the judgment of the United States District Court for the Southern District of New York in the case of the Baldwin Company vs. R. S. Howard Company, the judgment and proceedings in which, duly certified as provided by the Act of Congress, were filed as part of the record.

This Court notices the proceedings, but dismisses them "from further consideration" as a "matter of no concern in this proceeding either by way of estoppel or otherwise," the reason assigned being that "they were confined solely to the question of unfair competition."

An inspection of the record (Vol. III, pp. 2599 to 2643) will show that the bill of complaint alleged in apt and specific terms that the predecessors of The Baldwin Company in December, 1896, adopted the word "Howard" as a trade-mark for pianos made and sold by them, put said trade-mark on all such pianos, and continuously used it as a trade-mark; that at the time of the adoption of said trade-mark no other person, firm or corporation engaged in the business of manufacturing, selling or dealing in pianos, was using the word "Howard" as a trade-mark; that the plaintiff's predecessors had the legal right to appropriate and use the name "Howard" as a trade-mark for pianos; and that the plaintiff as successor in the business had the exclusive right to use the name as its lawful trade-mark for pianos manufactured and sold by it.

The prayer of the bill was that the plaintiff be adjudged the true, lawful, and sole owner, and entitled to the exclusive use of the word "Howard," as applied to pianos as a trade-mark and trade name; that the defendant be enjoined from directly or indirectly making or causing to be made, selling or causing to be sold, or offering

658 for sale, marking, or advertising, or describing either in correspondence with customers, in bills rendered or in conversations with customers, any pianos as "Howard" pianos, other than those manufactured or sold by the plaintiff, without clearly indicating that said pianos are not the product of the plaintiff or its predecessors, but the product of the defendant.

The defendant in its answer denied the material allegations of the Bill of Complaint, set up a counter-claim asserting that it was the owner of the trade-mark "Howard," and prayed that it be adjudged to be the true, lawful, and sole owner, and entitled to the exclusive use of the name "Howard," as applied to pianos as a trade-mark and trade name; that The Baldwin Company be enjoined from using said trade-mark and trade name, and from using the name "The

Howard Piano Company," directly or indirectly in connection with the manufacture or sale of pianos.

The final decree (p. 2641) adjudges—

I. That the name "Howard" indicates that the pianos bearing or referred to by said name are the product of the plaintiff, The Baldwin Company, and the said name "Howard" distinguishes plaintiff's pianos from the pianos of all other manufacturers, and "that the plaintiff, The Baldwin Company, and its predecessors in business have been ever since December, 1896, and The Baldwin Company now is the true, lawful, and sole owner of said word "Howard" as a name for its pianos, and it alone is entitled to use said word *simpliciter* on pianos."

II. That the defendants, the R. S. Howard Company, has infringed upon and violated the rights of the plaintiff in its said name "Howard," etc.

III. That an injunction issue enjoining the R. S. Howard Company, its officers, agents, etc., from directly or indirectly making or causing to be made, selling or causing to be sold, or offering
2659 for sale, pianos bearing the said word "Howard," and not the product of the plaintiff, except with the initials R. S. or the name Robert S., prefixed, and the word Company affixed to said word "Howard" wherever the said word appears on said pianos, etc.

V. That the plaintiff has the right to use the name "The Howard Piano Company" as a name for one of the corporations owned and controlled by it, and it alone is entitled to use the word "Howard" without prefix or suffix in the name of any company, firm or corporation that manufactures pianos bearing said name.

It is further shown by the record in this Court that the foregoing decree of the district Court of the United States was affirmed by the United States Circuit Court of Appeals for the second circuit, and that the Supreme Court of the United States had denied a petition for a writ of certiorari.

It has therefore been adjudged by a final decree forever binding both parties, and entitled by the Constitution and Laws of the United States to full faith and credit in the hearing before the Commissioner and in this Court, that The Baldwin Company and its predecessors ever since December, 1896, have had the exclusive right to the use of the word "Howard" as a name for pianos, and that it alone is entitled to use said word without prefix or suffix in the name of any company, firm or corporation engaged in the piano business; and that the R. S. Howard Company, which this Court in its opinion calls the "Howard Company," is not entitled to use that name.

How can it be held in this Court that appellant has a property right in a name which by a prior decree of a Court of the United States it is perpetually enjoined from using, or that it can suffer damage in a legal sense from the use of that name by The Baldwin Company in accordance with that decree?

2660 True it is that the Federal Court in New York did not enjoin the R. S. Howard Company from prosecuting its cancellation proceedings in the Patent Office, but the Commissioner in hearing and deciding those proceedings was bound by the Constitu-

tion and Laws of the United States to give full faith and credit to the adjudication of the Court in New York. This he did, and for doing so, his decision is reversed by this Court. The rule governing the Commissioner and binding upon this Court is thus stated by the Supreme Court of the United States in Southern Pacific R. R. Co. vs. The United States, 168 U. S., 1, 48:

"A right, question or fact distinctly put in issue and directly determined by a Court of competent jurisdiction as a ground of recovery, can not be disputed in a subsequent suit between the same parties or their privies; and even if the second suit is for a different cause of action, the right, question or fact, once so determined, must, as between the same parties or their privies, be taken as conclusively established, so long as the judgment in the first suit remains unmodified."

The rule was discussed with citation of authorities at pages 23 to 27 of our printed brief, and it is well settled under the full faith and credit provision of the Constitution and Laws of the United States that the judgment of a Court of the United States having jurisdiction of the parties is conclusive as to all the *media concludendi*, and can not be impeached in any other Court even by showing that it was based on a mistake of law.

Fauntleroy vs. Lum, 210 U. S., 230.
American Express Co. vs. Mullins, 212 U. S., 311, 314.
Everett vs. Everett, 215 U. S., 203.
Embry vs. Palmer, 107 U. S., 3.

2651 Wherefore your petitioner prays this Honorable Court for a rehearing of the above entitled causes; or if a rehearing be denied that the issue of the certificate of the decision of this Court to the Commissioner be stayed for a reasonable time to enable petitioner to take an appeal to the Supreme Court of the United States or to apply for a writ of certiorari.

THE BALDWIN COMPANY,
(By) LAWRENCE MAXWELL,
JOHN E. CROSS,
Attorneys.

We hereby certify that we are counsel for the petitioner, that the petition is not interposed for delay, and that in our opinion it is well founded in law and ought to be granted.

LAWRENCE MAXWELL,
JOHN E. CROSS,
Counsel.

2662 Saturday, March 29th, A. D. 1919.

* * * * * * *

No. 1201.

R. S. HOWARD COMPANY, Appellant,

vs.

THE BALDWIN COMPANY,

and

No. 1202.

R. S. HOWARD COMPANY, Appellant,

vs.

THE VALLEY GEM PIANO CO., &c., et al.

On consideration of the petition for a rehearing in the above entitled causes or to withhold the opinion and judgment until further order, it is by the Court this day ordered that the said petition in so far as it relates to a rehearing be and the same is hereby denied, and that in so far as it relates to withholding the opinion and judgment until further order be and the same is hereby granted.

2663 Court of Appeals of the District of Columbia.

I, Henry W. Hodges, Clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing printed and typewritten pages, numbered from 1 to 2662, inclusive, constitute a true copy of the transcript of record and proceedings of said Court of Appeals, in the cases of R. S. Howard Company, Appellant, vs. The Baldwin Company, No. 1201, Patent Appeal Docket, and R. S. Howard Company, Appellant, vs. The Valley Gem Piano Company (The Howard Piano Company substituted) and The Baldwin Company, No. 1202, Patent Appeal Docket, January Term, 1919, as the same remain upon the files and records of said Court of Appeals.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals, at the City of Washington, this 8th day of April, A. D. 1919.

[Seal Court of Appeals, District of Columbia, 1893.]

HENRY W. HODGES,
Clerk of the Court of Appeals of the District of Columbia.

[Stamped:] Court of Appeals, District of Columbia. Filed Jul-7, 1919. Henry W. Hodges, Clerk.

In the Court of Appeals of the District of Columbia.

October Term, 1918.

R. S. HOWARD COMPANY, Appellant,

vs.

THE BALDWIN COMPANY, Appellee.

R. S. HOWARD COMPANY, Appellant,

vs.

THE VALLEY GEM PIANO COMPANY (The Howard Piano Company Substituted) and THE BALDWIN COMPANY, Appellees.

Patent Appeals Nos. 1201 and 1202, Consolidated.

Petition for Appeal and Assignment of Errors.

The Baldwin Company and The Valley Gem Piano Company (The Howard Piano Company, Substituted), appellees in the above entitled cases consolidated, pray an appeal to the Supreme Court of the United States from the judgment of the Court of Appeals of the District of Columbia entered March 3, 1919, and assign as error that the court erred:

1. In holding, notwithstanding the "thing adjudged" in the case of The Baldwin Company vs. R. S. Howard Company, that The Valley Gem Piano Company was not entitled to the use of the trade mark "Howard" registered by it on March 8, 1898, at the date of its application for registration thereof.

2. In holding, notwithstanding the "thing adjudged" in the said case, that The Baldwin Company was not entitled to the use of the trade mark "Howard" registered by it on October 17, 1905, at the date of its application for registration thereof.

3. In holding that the R. S. Howard Company was injured by said registrations, or either of them, or entitled to maintain said proceedings for the cancellation of said registrations, or either of them.

4. In holding that the Commissioner of Patents had power as an officer of the United States or was authorized by the Trade Mark Act of 1905, to cancel the registration No. 31,411 issued under the Trade Mark Act of 1881.

5. In failing to give the faith and credit required by the Constitution and laws of the United States to the judgment of the United States Circuit Court of Appeals for the Second Circuit, affirming the

decree of the District Court of the United States for the Southern District of New York in the case of The Baldwin Company vs. R. S. Howard Company, in which it was adjudged that The Baldwin Company and its predecessors in business have been ever since 1896, and The Baldwin Company now is, the true, lawful and sole owner of the word "Howard" as a name for its pianos, and that the R. S. Howard Company is not entitled to use said name as a mark or name for its pianos; the judgment and proceedings in which case, duly certified as provided by the Act of Congress, were filed by the defendants as a part of the record in said cancellation proceedings, and relied upon by them as a bar to said proceedings.

Your petitioners pray that their appeal may be allowed and that all proceedings under the judgment of the court be stayed pending the decision of the Supreme Court upon their giving bond to operate as a supersedeas; that the transcript of the record, or so much thereof as may be necessary to present the errors complained of, may be transmitted to the Supreme Court of the United States, and for all other relief in that behalf to which they may be entitled.

LAWRENCE MAXWELL,
JOHN E. CROSS,
Counsel.

Supreme Court of the United States.

No. —, Original, October Term, 1918.

Ex Parte: In the Matter of THE BALDWIN COMPANY and THE VALLEY GEM PIANO COMPANY, Petitioners.

On consideration of the petition for the allowance of an appeal herein,

It is now here ordered by the court that the said petition be, and the same is hereby, granted.

June 9, 1919.

A true copy.
Test:

[Seal of the Supreme Court of the United States.]

JAMES D. MAHER,
Clerk Supreme Court of the United States.

(Endorsed:) File No. —. Supreme Court of the United States. October Term, 1918. Term No. —, Original. Ex Parte: In the Matter of the Baldwin Company and the Valley Gem Piano Company, Petitioners. Order Granting Petition for Allowance of an Appeal. Filed June 9, 1919. Court of Appeals, District of Columbia. Filed July 5, 1919. Henry W. Hodges, Clerk.

Know all men by these presents, That we, The Baldwin Company and The Valley Gem Piano Company, as principal-, and Fidelity and Casualty Company of New York, as sure*ties*, are held and firmly bound unto R. S. Howard Company in the full and just sum of five hundred ($500) dollars, to be paid to the said R. S. Howard Company, its certain attorney, executors, administrators, or assigns: to which payment, well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally, by these presents. Sealed with our seals and dated this thirteenth day of June, in the year of our Lord one thousand nine hundred and nineteen.

Whereas, lately at a term of the Court of Appeals of the District of Columbia in a suit depending in said Court, between The Baldwin Company and The Valley Gem Piano Company, a decree was rendered against the said The Baldwin Company and The Valley Gem Piano Company and the said The Baldwin Company and The Valley Gem Piano Company having obtained an appeal and filed a copy thereof in the Clerk's Office of the said Court to reverse the decree in the aforesaid suit, and a citation directed to the said R. S. Howard Company citing and admonishing it to be and appear at a Supreme Court of the United States, at Washington, within 30 days from the date thereof.

Now, the condition of the above obligation is such, that if the said The Baldwin Company and The Valley Gem Piano Company shall prosecute said appeal to effect, and answer all damages and costs if they fail to make said plea good, then the above obligation to be void; else to remain in full force and virtue.

THE BALDWIN COMPANY AND
THE VALLEY GEM PIANO COMPANY, [SEAL.]
By JOHN E. CROSS,
Attorney.
THE FIDELITY AND CASUALTY CO.
OF NEW YORK, [SEAL.]
By EDGAR K. LEGG, JR.,
Attorney.

Sealed and delivered in presence of:
PORTER H. FLANTT.
W. MARVIN SMITH.

Approved by
EDWARD D. WHITE,
Chief Justice of the United States.

[Endorsed:] No. 1202. R. S. Howard Company, appellant, vs. The Valley Gem Piano Co. et al. Bond on Appeal to Supreme Court of the United States. Court of Appeals, District of Columbia. Filed July 5, 1919. Henry W. Hodges, Clerk.

SUPREME COURT OF THE UNITED STATES.
OCTOBER TERM, 1916.

No. [redacted]139

The Baldwin Company, et al., Appellants,

vs.

R. S. Howell Company.

No. [redacted]213

The Baldwin Company, Petitioner,

vs.

R. S. Howell Company.

On appeal from and certiorari to the Court of Appeals of the District of Columbia.

BRIEFS AND PETITION OF THE RESPONDENT.

Lawrence Maxwell,
John H. Dillon,
Counsel.

SUPREME COURT OF THE UNITED STATES,
OCTOBER TERM, 1919.

No. 446.

The Baldwin Company, et al., Appellants,

vs.

R. S. Howard Company.

No. 387.

The Baldwin Company, Petitioner,

vs.

R. S. Howard Company.

On appeal from and certiorari to the Court of Appeals of the District of Columbia.

MOTION AS TO THE PRINTING OF THE RECORD.

The appeal (which was allowed by the court June 9, 1919), is from a decree of the Court of Appeals of the District of Columbia reversing a decision of the Commissioner of Patents, which dismissed applications filed in his office by the R. S. Howard Company to cancel two certificates of registration of the word "Howard" as a trademark for pianos. Because of uncertainty as to the proper method of review, a peti-

tion for writ of certiorari was submitted, and consideration thereof was by the court postponed until the hearing on the merits.

The litigation was begun in August, 1914, by applications filed by R. S. Howard Company in the Patent Office to cancel two certificates of registration of the word "Howard" as a trademark for pianos, one issued in 1895, to The Baldwin Company and the other in 1898, to the Valley Gem Piano Company, predecessor of The Baldwin Company, both marks being owned by The Baldwin Company when the cancellation proceedings were begun.

While the cancellation proceedings were pending in the Patent Office, and after a great mass of testimony had been taken, The Baldwin Company (an Ohio corporation) commenced a suit in equity against the R. S. Howard Company (a New York corporation) in the District Court of the United States for the Southern District of New York, to enjoin the defendant from using the name "Howard" as a trademark for pianos. The bill of complaint set forth specifically and in detail all the facts necessary to show the lawful adoption by plaintiff in December, 1896, of the word "Howard" as a trademark for pianos, and its continued and exclusive use thereafter. Defendant filed an answer denying the material allegations of the bill, and also a counterclaim alleging that it was the lawful owner of the trademark "Howard" and praying an injunction. The plaintiff filed a reply to the counterclaim,

and in May, 1916, the court entered a final decree of injunction against the R. S. Howard Company finding specifically that "the plaintiff, The Baldwin Company, and its predecessors in business have been ever since December, 1896, and The Baldwin Company now is the true, lawful and sole owner of said word 'Howard' as a name for its pianos, and it alone is entitled to use said word (simpliciter) on pianos, or in advertising matter relating thereto;" and that "the plaintiff has the right to use the name 'The Howard Piano Company' as a name for one of the corporations owned and controlled by it, and it alone is allowed to use the word 'Howard' without prefix or suffix in the name of any company, firm or corporation that manufactures pianos bearing said name" (233 Fed. 439). The decree was affirmed on appeal by the United States Circuit Court of Appeals for the Second Circuit (238 Fed. 793), and this court refused a writ of certiorari (243 U. S. 636).

The Baldwin Company thereupon filed in the Patent Office a copy of the New York record, and on final hearing the Commissioner of Patents dismissed the cancellation proceedings on the ground that the facts upon which the asserted right of cancellation depended had been adjudicated in favor of The Baldwin Company. The R. S. Howard Company appealed to the Court of Appeals of the District of Columbia, which reversed the decision of the Commissioner of Patents upon grounds which ignored and refused to give effect to the New York adjudication. This is the error assigned and relied upon in this court.

The appellants have duly filed the following praecipe for printing the record:

> "The appellants, in pursuance of Section 9 of Rule 10, state that the point on which they intend to rely under all of the assignments of error, except the fourth (which involves only a question of law as to the construction of the Trade Mark Act of 1905), is that the Court of Appeals of the District of Columbia did not give due effect to the judgment of the United States Circuit Court of Appeals for the Second Circuit, affirming the decree of the District Court of the United States for the Southern District of New York in the case of The Baldwin Company vs. R. S. Howard Company, and that the following are the parts of the record which they think necessary for consideration thereof:"

The parts of the record designated in the praecipe include the proceedings in the Patent Office, except the testimony filed therein prior to the New York adjudication, and the proceedings in the Court of Appeals of the District of Columbia. The omitted testimony, which covers more than 2,500 printed pages, is "not necessary to the consideration of the questions to be reviewed." Moreover it was all before the United States courts in New York, and its effect is concluded by the judgment in that case. The cost of printing the record, if said testimony is omitted, will not exceed $200. The clerk has notified counsel for appellants that counsel for appellee has filed with him, under

Section 9 of Rule 10, a "designation that the whole record be printed," and that the clerk's fees thereunder will amount to $4,155.

The appellants omitted said testimony, not only in their praecipe for printing under Rule 10, but also in their praecipe for transcript of the record filed in the lower court in pursuance of Rule 8; whereupon appellee filed a praecipe requiring the entire record to be sent up, and there is now on file in this court two copies of the entire record, one filed in No. 446 and the other in No. 387, and there are available for the use of the court and counsel nine copies of the entire record as filed in the Court of Appeals of the District of Columbia, including said testimony, printed and indexed, bound in three volumns, containing 2,648 pages. There are also on file thirty copies, certified by the Clerk of the Court of Appeals of the District of Columbia, duly indexed and printed by Judd & Detweiler, of the part of the record designated by appellants. It omits said testimony and is comprised in eighty pages. It is the document which was submitted to the court on our petition for the allowance of an appeal.

It is respectfully submitted under the circumstances that appellants and petitioner should be relieved from Section 9 of Rule 10 as to the printing of the entire record, on the understanding that they will furnish to the clerk, for the use if desired of court and counsel at the hearing, nine copies of the entire printed

record as filed in the Court of Appeals of the District of Columbia (including the testimony) certified by the clerk of that court, bound in three convenient volumns and indexed; thereby avoiding, as suggested in Texas & Pacific Ry. Co., et al. vs. Leatherwood, decided June 9, 1919, "much useless expense" and relieving "both court and counsel" of "the burden of examining much that is irrelevant." Appellants and petitioner accordingly pray for such order in that behalf as the court may deem just and proper.

Respectfully submitted,

Lawrence Maxwell,

John E. Cross,

Counsel.

OCT 24 1919
JAMES D. MAHER

SUPREME COURT OF THE UNITED STATES

October Term, 1919.

No. [redacted]139

THE BALDWIN COMPANY, et al.,

Appellants,

against

R. S. HOWARD COMPANY,

Appellee.

No. [redacted]113

THE BALDWIN COMPANY,

Petitioner,

against

R. S. HOWARD COMPANY,

On Appeal from and Certiorari to the Court of Appeals of the District of Columbia.

Respondent's Memorandum on Motion as to Printing of the Record.

[redacted]

Counsel for R. S. Howard Company.

Supreme Court of the United States

OCTOBER TERM, 1919.

THE BALDWIN COMPANY, *et al.*, Appellants, against R. S. HOWARD COMPANY, Appellee.	No. 446.
THE BALDWIN COMPANY, Petitioner, against R. S. HOWARD COMPANY.	No. 387.

On Appeal From and Certiorari to the Court of Appeals of the District of Columbia.

Respondent's Memorandum on Motion as to Printing of Record.

R. S. Howard Company, appellee-respondent, is desirous of avoiding all unnecessary expense in printing the record, and is desirous of co-operating in avoiding such expense as far as is possible without prejudicing its rights and interest, and is willing to, and does, join in this motion to dispense with the re-

printing of the entire record before the Court of Appeals, provided that this Court will consent that the nine copies of the entire record as filed in the Court of Appeals of the District of Columbia (stated by the petitioner herein as now available for the use of this Court) may be accepted by this Court as a sufficient number of copies of the record for the hearing of these appeals.

By joining in this motion, the respondent does not wish it to be understood that it acquiesces in petitioner's statements contained in the motion papers respecting the issues involved on these appeals; on the contrary, respondent respectfully submits that petitioner's statements in the motion papers are not correct or fair statements, either as to the issues involved on these appeals or as to the character and scope of the decisions of the several tribunals mentioned in the motion papers.

Respectfully submitted,

R. S,. HOWARD COMPANY.
By SAMUEL S. WATSON,
Counsel.

SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1917

No. [redacted]118

The Baldwin Company, Petitioner,
vs.
R. H. Howard Company.

Petition For a Writ of Certiorari to the Court of Appeals of the District of Columbia.

[redacted]
Petitioner.
[redacted]
Counsel for The Baldwin Company.

SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1918.

No. .....

The Baldwin Company, Petitioner,

vs.

R. S. Howard Company.

Petition For a Writ of Certiorari to the Court of Appeals of the District of Columbia.

To the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, The Baldwin Company, prays for a writ of certiorari to review the judgment of the Court of Appeals of the District of Columbia, entered March 3, 1919, in consolidated case entitled on the docket of said court: R. S. Howard Company, appellant, vs. The Baldwin Company (Patent Appeal No. 1201), and R. S. Howard Company, appellant, vs. The Valley Gem Piano Company (The Howard Piano Company substituted) and The Baldwin Company (Patent Appeal No. 1201).

The principal ground relied upon for the allowance of the writ is that the Court of Appeals of the District of Columbia did not give full faith and credit to a

prior judgment of the United States Circuit Court of Appeals for the Second Circuit, affirming a decree of the District Court of the United States for the Southern District of New York in a case in which your petitioner was plaintiff and R. S. Howard Company was defendant.

Summary Statement of the Case.

The litigation was begun in August, 1914, by cancellation proceedings brought by R. S. Howard Company, in the Patent Office, to cancel two certificates of registration of a trade mark, consisting of the word "Howard," one issued on October 17, 1905, to your petitioner, The Baldwin Company, and the other, on March 8, 1898, to The Valley Gem Piano Company, and now owned by your petitioner. Both marks were registered as trade marks for pianos.

While the cancellation proceedings were pending in the Patent Office, your petitioner (an Ohio corporation) commenced a suit in equity against the R. S. Howard Company (a New York corporation) in the District Court of the United States for the Southern District of New York, which is aptly designated by the United States Circuit Court of Appeals for the Second Circuit in its statement of the case (238 Fed. 154) as "an action brought by the Baldwin Company against the R. S. Howard Company for unfair competition by reason of the use by the defendant of the complainant's trade mark 'Howard' upon pianos not made or sold by the complainant."

The bill of complaint set forth, specifically and in detail, all the facts necessary to show the lawful adoption, in December, 1896, of the word "Howard" as a trade mark for pianos and its continuous and exclusive use thereafter by the plaintiff, as a trade mark placed upon pianos made and sold by it, to indicate that they were the product of the plaintiff. The defendant filed an answer denying the material allegations of the bill and a counter-claim alleging that it was the lawful owner of the trade mark "Howard" and praying an injunction against the plaintiff, including an injunction against the use of the name "The Howard Piano Company" as the corporate name of a subsidiary company organized by the plaintiff. The plaintiff filed a reply to the counter-claim and in May, 1916, the court entered the following final decree:

> This cause came on to be heard at this term, and was argued by counsel; and thereupon, upon consideration thereof, it was ordered, adjudged and decreed, as follows, viz:
>
> First. That the name "Howard," without prefix or suffix, on pianos, or contained in advertisements or otherwise used in connection with pianos, indicates that the pianos bearing or referred to by said name, are the product of the plaintiff, The Baldwin Company, and said name "Howard" distinguishes plaintiff's pianos from the pianos of all other manufacturers; and that the plaintiff, The Baldwin Company, and its predecessors in business, have been ever since December, 1896, and The Baldwin Company now

is the true, lawful and sole owner of said word "Howard" as a name for its pianos, and it alone is entitled to use the said word (simpliciter) on pianos, or in advertising matter relating thereto.

Second. That the defendant, R. S. Howard Company, has infringed upon and violated the rights of the plaintiff in its said name "Howard" by threatening to use the said word on pianos not the product of the plaintiff, and by using the same in advertisements and otherwise in connection with the sales of its said pianos, and by placing said name on the back of its pianos.

Third. That an injunction issue out of and under the seal of this court restraining and enjoining said defendant, R. S. Howard Company, its officers, agents, etc., perpetually and forever, from directly or indirectly making or causing to be made, selling or causing to be sold or offering for sale pianos bearing the said word "Howard" and not the product of the plaintiff, except with the initials "R. S." or the name "Robert S." prefixed and the word "Company" affixed to said word "Howard" wherever the said word appears on said pianos or boxes or packages containing the same, and from marking or advertising or describing in any manner by said word, pianos not the product of the plaintiff except with the initials "R. S." or the name "Robert S." prefixed to said word and with the word "Company" affixed thereto in as conspicuous and prominent a manner as the word "Howard," and from marking, advertising or describing pianos manufactured or sold

by it with any name or in any manner calculated or liable to confuse or deceive purchasers into the belief that said pianos are the product of the plaintiff.

Fourth. Plaintiff having waived its rights to recover any profits and damages to which it may be entitled by reason of the aforesaid infringement and violation of its rights, there will be no accounting for profits or damages by the defendant.

Fifth. That the plaintiff has the right to use the name "The Howard Piano Company" as a name for one of the corporations owned and controlled by it, and it alone is entitled to use the word "Howard" without prefix or suffix in the name of any company, firm or corporation that manufactures pianos bearing said name; and that the defendant's counter-claim be, and it hereby is, dismissed with costs.

Sixth. That the plaintiff recover costs from the defendant.

C. M. Hough, D. J."

The R. S. Howard Company appealed the case to the United States Circuit Court of Appeals for the Second Circuit, which affirmed the decree of the District Court. R. S. Howard Company then applied to this court for a writ of certiorari, which was denied on March 6, 1917 (243 U. S. 636). The opinion of the District Court is reported in 233 Fed. 439, and that of the Court of Appeals in 238 Fed. 154.

The Baldwin Company thereupon filed in the Patent Office a duly certified copy of the record in the District

Court in New York and in the Court of Appeals. On final hearing in the Patent Office the Examiner of Interferences, and the Commissioner of Patents, on appeal to him, held that the "thing adjudged" in the New York case was a bar to the claim of the R. S. Howard Company to cancel the certificates of registration of the trade mark "Howard" issued to The Baldwin Company, and dismissed the petition of R. S. Howard Company.

The R. S. Howard Company took an appeal from the decision of the Commissioner of Patents to the Court of Appeals of the District of Columbia, one of the assignments of error being that "the Commissioner of Patents erred in holding that the decision of the Federal Court and of the Court of Appeals of the Second Circuit aforesaid were res adjudicata of any rights of the parties in this proceeding."

The Decision of the Court of Appeals of the District of Columbia.

The court reversed the decision of the Commissioner of Patents and held that the R. S. Howard Company was entitled to have the certificates of registration of the trade mark "Howard" issued to The Baldwin Company cancelled. In deciding the case it said:

> "Unquestionably, The Baldwin Company was the first to make a trade mark use of the word 'Howard,' but in our view of the case that is of no importance. The sole question here

is, was The Baldwin Company entitled to the exclusive use of this mark on the date of its application for registration? If not, has the Howard Company been injured by the registration of the mark?

The court decided the first question by holding that The Baldwin Company was not entitled to the exclusive use of the mark on the date of its applications for registration (November 15, 1897, and May, 1905), notwithstanding the judgment in New York that "the plaintiff, the Baldwin Company, and its predecessors in business, have been ever since December, 1896, and The Baldwin Company now is the true, lawful and sole owner of said word 'Howard' as a name for its pianos and it alone is entitled to use the said word (simpliciter) on pianos or advertising matter relating thereto;" and that "the defendant, R. S. Howard Company has infringed upon and violated the rights of the plaintiff in its said name 'Howard' by threatening to use the said word on pianos not the product of the plaintiff, and by using the same in advertisements and otherwise in connection with the sales of its said pianos,by placing the said name on the back of its pianos;" and that "the plaintiff has the right to use the name 'The Howard Piano Company' as a name for one of the corporations owned and controlled by it, and it alone is entitled to use the word 'Howard Piano Company' as a name for one of the corporations owned and controlled by it, and it alone is entitled to use the word 'Howard' with-

out prefix or suffix in the name of any company, firm or corporation that manufactures pianos bearing said name."

Ignoring the "thing adjudged," the court cited cases in support of its own view; as if the correctness of the New York decisions was open to inquiry. If it were, it could be pointed out that the decision in Howe Scale Co. vs. Wyckoff, Seamans & Benedict, 198 U. S. 118, cited by the court, was that "in the absence of contract, fraud or **estoppel**, any man may use his own name in all **legitimate** ways and as the whole or part of a corporate name," and that "a personal name cannot be exclusively appropriated by anyone against others **having a right to use it**;" and that Mr. Justice Brown's statement in Brown Chemical Co. vs. Meyer, 139 U. S. 540 is similarly qualified.

The Court of Appeals of the District of Columbia answered its second question by holding that R. S. Howard Company was injured by The Baldwin Company's registration of "Howard" as a trade mark, saying that "where the party is seeking to prevent the adoption of his name as a trade mark, or the cancellation of its registration, his action is grounded upon the invasion of a property right inhering in the name itself, and damage will be presumed," notwithstanding the judgment in New York that the defendant had no right to use the name "Howard," and specifically that "the plaintiff, The Baldwin Company, has the right to use the name 'Howard Piano Company' as a name

for one of the corporations owned and controlled by it, and it alone is entitled to use the word 'Howard' without prefix or suffix in the name of any company, firm or corporation that manufactures pianos bearing said name."

How can it be held that the R. S. Howard Company has a property right in a name which by a prior decree of a court of the United States it has been perpetually enjoined from using, or that it can suffer damage, in a legal sense, from the use of that name by The Baldwin Company in accordance with such decree.

The court swept aside the New York judgment, saying; "The court decisions can be dismissed from further consideration, since they were confined solely to the question of unfair competition, a matter of no concern in this proceeding, either by way of estoppel or otherwise;" as if the name applied to an action were material in determining the "thing adjudged;" and overlooking or ignoring moreover the statement of the Court of Appeals for the Second Circuit (238 Fed. 154), that the case was before it "on appeal from a decree of the District Court for the Southern District of New York in an action brought by The Baldwin Company against the R. S. Howard Company for unfair competition **by reason of the use by the defendant of the complainant's trade mark 'Howard'** upon pianos not made or sold by the complainant;" and also overlooking or ignoring the following statement of Coxe, J., in delivering the opinion of the court, to-wit: "This is an action

in equity upon the trade mark 'Howard' as applied to pianos. The custom of the trade is to stencil the name upon the front of the pianos just above the key-board and also upon the cases in which the pianos are shipped. The question here is whether the R. S. Howard Company, defendant, has the right to use the word 'Howard' as a trade mark in connection with the sales of pianos manufactured by it."

The Federal Court in New York did not enjoin the prosecution of the cancellation proceedings, and it is true, as stated by the Court of Appeals of the District of Columbia, that the Commissioner of Patents is vested by statute with jurisdiction of such proceedings, subject to appeal to the Court of Appeals of the District of Columbia. But the Commissioner and the Court of Appeals in hearing and deciding the proceeding were bound by the Constitution and laws of the United States to give effect to the prior adjudication of the court in New York. This the Commissioner did, and for so doing, his decision was reversed by the Court of Appeals of the District of Columbia. The rule governing the Commissioner, and binding upon that court is thus stated in Southern Pacific Railroad Co. vs. United States., 168, p. 48:

> "The general principle announced in numerous cases is that a right, question or fact distinctly put in issue and directly determined by a court of competent jurisdiction, as a ground of recovery, cannot be disputed in a subsequent

> suit between the same parties or their privies; and even if the second suit is for a different cause of action, the right, question or fact once so determined must, as between the same parties or their privies, be taken as conclusively established, so long as the judgment in the first suit remains unmodified."

It is equally well settled that the judgment of a court of the United States is conclusive as to all the media concludendi, and cannot be impeached in any other court even by showing that it was based on a mistake of law.

Fauntleroy vs. Lum, 210 U. S. 230.

American Express Co. vs. Mullens, 212 U. S. 311, 314.

Everett vs. Everett, 215 U. S. 203.

Embry vs. Palmer, 107 U. S. 3.

The decision of the Court of Appeals of the District of Columbia involves either a new question of law, or a plain disregard of its duty under the constitution and laws of the United States to give effect to the judgment of the United States Circuit Court of Appeals for the Second Circuit. Upon either hypothesis the case would seem to be one in which a writ of certiorari should be awarded, if it be held that this court has not jurisdiction on appeal.

In Southern Pacific Railroad vs. United States, 168 U. S., at p. 48, Mr. Justice Harlan, after stating the principle of the "thing adjudged," said:

> "This general rule is demanded by the very object for which civil courts have been established, which is to secure the peace and repose of society by the settlement of matters capable of judicial determination. Its enforcement is essential to the maintenance of social order; for, the aid of judicial tribunals would not be invoked for the vindication of rights of person and property, if, as between parties and their privies, conclusiveness did not attend the judgments of such tribunals in respect of all matters properly put in issue and actually determined by them."

In Hart Steel Co. vs. Railroad Supply Co., 244 U. S. 294, 299, Mr. Justice Clark delivering the opinion of the court said:

> "This doctrine of res judicata is not a mere matter of practice or procedure inherited from a more technical time than ours. It is a rule of fundamental and substantial justice, 'of public policy and of private peace,' which should be cordially regarded and enforced by the courts to the end that rights once established by the final judgment of a court of competent jurisdiction shall be recognized by those who are bound by it in every way, wherever the judgment is entitled to respect."

The justice of your petitioner's claim, as an American manufacturer and merchant, is indicated by the following statement of the case in the opinion of the Court of Appeals for the Second Circuit, 238 Fed. 154:

"The Baldwin Co. adopted the name 'Howard' alone to designate pianos sold by it in 1896, with the full knowledge of R. S. Howard, and procured the trade mark in that name with his acquiescence. It has built up a large and flourishing business in this manner, with the knowledge of R. S. Howard, and it would now be most inequitable to permit him to destroy this business and reap the fruits thereof by transferring a large part thereof to himself. He has a perfect right to use his own name, R. S. Howard, in the piano business, but he has not at this late day the right to appropriate the good will of the complainant's business by the use of the trade mark 'Howard,' which has by long use come to mean the pianos sold by the complainant.

The name 'Howard' without prefix or suffix, when used in connection with pianos, indicated that they were the product of The Baldwin Company, the complainant herein. There can be no doubt as to the wide publicity given by the complainant to the 'Howard' piano and the large sales made by it under that name. In other words, it was the enterprise, energy, capital and brains of the complainant company that established and maintained the reputation of the Howard piano and that company is entitled to have its rights protected. The facts necessary to understand the situation are fully set out in the opinion of Judge Hough and need not be repeated here."

The foreign business of The Baldwin Company is seriously threatened by the decision of the Court of

Appeals of the District of Columbia. The respondent cannot get legitimately any direct benefit from it, because according to the decision, it cannot register "Howard" as a trade mark. But citizens of foreign countries in which The Baldwin Company has secured registration on the basis of the registration in the Patent Office of the United States, are in position to register, and at the instigation of the R. S. Howard Company, may register the name "Howard" in such countries, and so reap the benefit of the business which The Baldwin Company has built up in such countries.

Respectfully submitted

Lawrence Maxwell,

John E. Cross,

Counsel for The Baldwin Company.

SUPREME COURT OF THE UNITED STATES,
OCTOBER TERM, 1918.

No. 139

The Baldwin Company, Appellant,
vs.
R. S. Howard Company.

The Valley Gem Piano Company (The Howard Piano Company Substituted) and The Baldwin Company, Appellants,
vs.
R. S. Howard Company.

In the Matter of an Application for the Allowance of an Appeal from the Judgment of the Court of Appeals of the District of Columbia.

Petition for Appeal, Assignment of Errors, and Brief in Support Thereof.

Lawrence Maxwell,
John H. Cross,
Counsel.

Neal Stationery Publishing Company, 1005-1009 10th Street, Washington, D. C.

In the Court of Appeals of the District of Columbia.

OCTOBER TERM, 1918.

R. S. Howard Company, Appellant,

vs.

The Baldwin Company, Appellee.

R. S. Howard Company, Appellant,

vs.

The Valley Gem Piano Company (The Howard Piano Company, Substituted) and The Baldwin Company, Appellees.

Patent Appeals Nos. 1201 and 1202, Consolidated.

PETITION FOR APPEAL AND ASSIGNMENT OF ERRORS.

The Baldwin Company and The Valley Gem Piano Company (The Howard Piano Company, Substituted), appellees in the above entitled cases consolidated, pray an appeal to the Supreme Court of the United States from the judgment of the Court of Appeals of the District of Columbia entered March 3, 1919, and assign as error that the court erred:

1. In holding, notwithstanding the "thing adjudged" in the case of The Baldwin Company vs. R. S. Howard Company, that The Valley Gem Piano Company was not entitled to the use of the trade mark "Howard" registered by it on March 8, 1898, at the date of its application for registration thereof.

2. In holding, notwithstanding the "thing adjudged" in the said case, that The Baldwin Company was not entitled to the use of the trade mark "Howard" registered by it on October 17, 1905, at the date of its application for registration thereof.

3. In holding that the R. S. Howard Company was injured by said registrations, or either of them, or entitled to maintain said proceedings for the cancellation of said registrations, or either of them.

4. In holding that the Commissioner of Patents had power as an officer of the United States or was authorized by the Trade Mark Act of 1905, to cancel the registration No. 31411 issued under the Trade Mark Act of 1881.

5. In failing to give the faith and credit required by the Constitution and laws of the United States to the judgment of the United States Circuit Court of Appeals for the Second Circuit, affirming the decree of the District Court of the United States for the Southern District of New York in the case of The Baldwin Company vs. R. S. Howard Company, in which it was adjudged that The Baldwin Company and its predecessors in business have been ever since 1896,

and The Baldwin Company now is, the true, lawful and sole owner of the word "Howard" as a name for its pianos, and that the R. S. Howard Company is not entitled to use said name as a mark or name for its pianos; the judgment and proceedings in which case, duly certified as provided by the Act of Congress, were filed by the defendants as a part of the record in said cancellation proceedings, and relied upon by them as a bar to said proceedings.

Your petitioners pray that their appeal may be allowed and that all proceedings under the judgment of the court be stayed pending the decision of the Supreme Court upon their giving bond to operate as a supersedeas; that the transcript of the record, or so much thereof as may be necessary to present the errors complained of, may be transmitted to the Supreme Court of the United States, and for all other relief in that behalf to which they may be entitled.

Lawrence Maxwell,
John E. Cross,
Counsel.

Brief in Support of the Petition for Appeal.

An application was made to the Court of Appeals of the District of Columbia for the allowance of an appeal and denied. Thereupon application was made to the Chief Justice, who referred it to the court.

A duly certified copy of the entire transcript of record of the case, including the proceedings in the Court of Appeals of the District of Columbia, is submitted, and also, printed separately, so much thereof, commencing with the final hearing in the Patent Office, as is deemed necessary for the consideration of the points relied upon in the assignment of errors. In the petition for a writ of certiorari, submitted simultaneously with the petition for the allowance of an appeal, the court will find a summary statement of the proceedings.

The consolidated case in the Court of Appeals of the District of Columbia was an appeal by the R. S. Howard Company from the decision of the Commissioner of Patents dismissing cancellation proceedings brought by it in 1914 to cancel two certificates of registration of a trade mark for pianos consisting of the word "Howard," one issued on October 17, 1905, to The Baldwin Company, and the other on March 8, 1898, to a predecessor of The Baldwin Company. Both registrations were owned by The Baldwin Company when the cancellation proceedings were instituted, and are now owned by it.

The first registration was under the Trade Mark

Act of 1881, c. 138, 21 Stat. 502, the second under the Act of 1905, c. 592, 33 Stat. 724. The cancellation proceedings were under section 13 of the Act of 1905. The appeal from the decision of the Commissioner of Patents to the Court of Appeals of the District was under section 9, and its decision, subject only to review by this court, is final. R. S. 4914 provides that "the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and shall govern the further proceedings in the case."

The appeal is sought under the following provisions of section 250, Judicial Code:

> Any final judgment or decree of the Court of Appeals of the District of Columbia may be reexamined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in the following cases:
>
> Fifth. In cases in which the existence or scope of any power or duty of an officer of the United States is drawn in question.
>
> Sixth. In cases in which the construction of any law of the United States is drawn in question by the defendant.

I.

The judgment of the Court of Appeals is a final judgment.

It reverses the decision of the Commissioner of Patents, who refused to cancel the registrations. Upon receipt of the mandate of the Court of Appeals, he will

be obliged to cancel the registrations, and his certificate of such cancellation will be immediately available to competitors of The Baldwin Company to secure cancellation of the registration of its mark in foreign countries, based upon its registration in the United States. The Baldwin Company has no remedy for the loss thus threatened of a large foreign business, built up in the course of twenty years, except by a direct proceeding to revise the judgment of the Court of Appeals of the District of Columbia.

The case is distinguishable from Frasch vs. Moore, 211 U. S. 1, and Johnson vs. Mueser, 212 U. S. 283, both of which involved applications for the **issue** of letters-patents which were **refused**, the ground of decision being that the applicants had an adequate remedy, expressly provided, by a bill in equity under R. S. 4915. Atkins vs. Moore, 212 U. S., 285, involved an application for the **registration** of a trade mark, which was **refused**. The present case is one for the **cancellation** of registrations of a trade mark, one issued fourteen, and the other twenty-three years ago in which The Baldwin Company has a valuable **existing** property right.

With respect to refusals to issue letters-patent or to register trade marks, the court said (212 U. S., page 290); "It is not as if the culminating act interfered with the person or property of others," adding; "When some case shall arise in which rights of persons or property must be affected by the decision, it will be-

come necessary to consider the question now attempted to be raised." The present is such a case.

II.

The case is appealable under clauses Fifth and Sixth of section 250, Judicial Code.

It is a case in which the construction of laws of the United States is drawn in question by the defendant, to-wit: The Trade Mark Act of 1905, and R. S. 905, which provides that the records and judicial proceedings of the courts of any State or Territory or of any country subject to the jurisdiction of the United States "shall have such faith and credit given to them in every court within the United States as they have by law or usage in the courts of the State from which they are taken."

Both are general laws of the United States within the meaning of clause sixth (McGowan vs. Parish, 228 U. S. 312, 317; Newman vs. Frezzell, 238 U. S. 537, 552), and Sec. 905 applies, as held in Embry vs. Palmer, 107 U. S. 3, 9, 10, to judgments of any court of the United States "wherever rendered and wherever sought to be enforced."

The right to **cancel** the registration of a trade mark depends upon the following section of the Trade Mark Act of 1905:

> "Section 13. That whenever any person shall deem himself injured by the registration of a trade mark in the Patent Office he may at any

> time apply to the Commissioner of Patents to cancel the registration thereof. The Commissioner shall refer such application to the examiner in charge of interferances, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the commissioner shall cancel the registration. Appeal may be taken to the commissioner in person from the decision of examiner of interferences."

The question is not whether the mark was registrable, as assumed by the Court of Appeals, but whether the original registration in 1898, having been "made with the full knowledge and consent of Robert S. Howard," as found by Judge Hough (P. R. 62), the R. S. Howard Co. is entitled sixteen years thereafter to have the registration cancelled. The Examiner of Interferances, and the Commissioner of Patents on appeal to him, both held that it was not entitled to have the registration cancelled, because it was conclusively established by the judgment in New York (1) that The Baldwin Company and its predecessors were "entitled to the use of the mark at the dates of the applications for registration thereof," and (2) that the R. S. Howard Company was not "injured by the registra-

tion," and could not be, since it was perpetually enjoined from using the mark.

The Court of Appeals, ignoring the distinction between registrability and the right to cancel, and throwing the New York adjudication out of the window, reversed the decision of the Commissioner. The conflicting decisions would seem to demonstrate that the case is one in which the construction of general laws of the United States (the Trade Mark Act and R. S. 905) are drawn in question, and that it is therefore appealable under clause Sixth of section 250 of the Judicial Code. The construction of the cancellation provision of the Act of 1905, was clearly drawn in question by the defendant, and also R. S. 905. The "faith and credit" which the Court of Appeals of the District of Columbia was required by R. S. 905 to give to the New York judgment, the record of the judgment and proceedings of the court being unimpeached, was a pure question of law, and one which necessarily involved the "construction" of R. S. 905 to-wit: the meaning of its provisions and their application to the case in hand.

The case is also appealable under clause Sixth of the Code, in view of the decision of the Court of Appeals that a registration under the Act of 1881, may be cancelled under the Act of 1905, not because the Act of 1905 confers such right in terms or by necessary implication, but because it is a "speedy and sensible remedy" which it was within the power of Congress to apply to registrations under the prior act. There are obvious

reasons for holding that if Congress in framing a new Trade Mark Act in 1905, which for the first time provided for cancellation of trade marks, had intended the provision to apply to registrations under the Act of 1881, it would have indicated its purpose. We do not find that the question has been before this court.

III.

The case is appealable also under clause Fifth, being a case in which the existence or scope of a power or duty of the Commissioner of Patents, as an officer of the United States, is drawn in question.

Respectfully submitted,

Lawrence Maxwell,

John E. Cross,

Counsel.

NOV 8 1920
JAMES D. MAHER,
CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1920.

Nos. 113 and 139.

THE BALDWIN COMPANY,

Appellant,

against

R. S. HOWARD COMPANY,

No. 113.

THE VALLEY GEM PIANO COMPANY (The Howard Piano Company, substituted) and THE BALDWIN COMPANY,

Appellants,

against

R. S. HOWARD COMPANY.

No. 139.

Motion and Brief for R. S. Howard Co. to Dismiss.

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1920

Supreme Court of the United States

OCTOBER TERM, 1920.

Nos. 113 and 139.

THE BALDWIN COMPANY, Appellant, against R. S. HOWARD COMPANY.	No. 113.
THE VALLEY GEM PIANO COMPANY (The Howard Piano Company, substituted) and THE BALDWIN COMPANY, Appellants, against R. S. HOWARD COMPANY.	No. 139.

MOTION OF R. S. HOWARD COMPANY TO DISMISS FOR WANT OF JURISDICTION, ETC.

Now comes the R. S. Howard Company, the appellee above named, and moves the Court to dismiss the appeals and deny the petitions for writs of certiorari in the above-entitled cases on the ground that the Court is without jurisdiction to review and that no substantial question is involved.

R. S. HOWARD COMPANY,
By SAMUEL S. WATSON,
Its Attorney.

To:
Lawrence Maxwell, Esq., and
John E. Cross, Esq.,
Attorneys for Appellants.

Please take notice that the R. S. Howard Company, the above-named appellee, will, on November 29th, 1920, upon the opening of this Court, or as soon thereafter as counsel can be heard, move this Court to dismiss the appeals and to deny the petitions for writs of certiorari, on the ground of want of jurisdiction to review and that no substantial question is involved.

Yours, &c.,
SAMUEL S. WATSON,
Attorney for R. S. Howard Company,
120 Broadway,
New York City, N. Y.

Statement.

In August, 1914, R. S. Howard Company, a corporation, the respondent, presented its application to the Patent Office praying that Trade-Mark Registration No. 46,993, registered October 17, 1905, by The Baldwin Company, for pianos, and Trade-Mark Registration No. 31,411, registered March 8, 1898, by The Valley Gem Piano Company, for pianos, be cancelled.

The Baldwin Company claims to own both said trade-mark registrations.

Motion to Dismiss.

The Cases at Bar Should be Dismissed for Want of Jurisdiction, Following the Rule of Stare Decisis.

In the cases at bar the appeal from the decision of the Commissioner of Patents to the Court of Appeals of the District of Columbia was taken under Section 9 of the Trade-Mark Act of 1905 (c. 592, 33 Stat. 724). This is admitted by appellants (see Petition for Appeal, p. 5).

This Court four times, at least, has decided flatly and unanimously that a decision of the Court of Appeals of the District of Columbia on appeals from the Commissioner of Patents is *not* a final judgment or decree, and, therefore, not reviewable by this Court, either on an appeal, writ of error, or writ of certiorari, and in each of these four cases have dismissed the appeal or writ of error, or denied the certiorari, on the ground of want of jurisdiction. These cases are:

Frasch vs. Moore, 211 U. S. 1, was an appeal, writ of error and certiorari, to review a decision of the Court of Appeals of the District of Columbia affirming a decision of the Commissioner of Patents requiring a division between process and apparatus claims in a patent application.

Johnson vs. Mueser, 212 U. S. 283, was a writ of error to review a decision of the Court of Appeals of the District of Columbia which affirmed a decision of the Commissioner of Patents in a patent interference proceeding involving priority of invention.

Gaines vs. Knecht, 212 U. S. 561, was a writ of error to review a decision of the Court of Appeals of the District of Columbia which affirmed a decision of the Commissioner of Patents dismissing an opposition to an application to register a trade-mark.

Atkins vs. Moore, 212 U. S. 285 (the latest case, 1909), was an appeal and writ of error to review a decision of the Court of Appeals of the District of Columbia, which affirmed a decision of the Commissioner of Patents in a proceeding arising under an application to register a trade-mark.

In *Atkins vs. Moore (supra)*, the Chief Justice, speaking for the Court, said (p. 289):

> "In *Frasch vs. Moore*, 211 U. S. 1, 29 Sup. Ct. Rep. 6, it was held that decisions in the Court of Appeals of the District of Columbia in appeals from the Commissioner of Patents under Section 9 of the Act of February 9, 1893 (Chap. 74, 27 Stat. at L. 434, 436, U. S. Comp. Stat. 1901, p. 3391), were interlocutory and not final, and not reviewable by this Court under Section 8 of that act, because not final judgments or decrees within the meaning of that section. When certified to the Commissioner of Patents, they 'govern the further proceedings in the case' (Revised Statutes, Section 4914, U. S. Comp. Stat. 1901, p. 3392). But are not final judgments or decrees at law or in equity within the purview of Section 8.
>
> "In *Gaines vs. Knecht*, we applied the same rule to a writ of error to the decision of the Court of Appeals, rendered on appeal to that Court from a decision of the Commissioner of Patents in proceedings arising under an application for a trade-mark * * *.
>
> "*Gaines vs. Knecht* was a case of opposition to the registration of a trade-mark under Sections 6 and 7 of the Act of February 20, 1905, the objections being that the act was unconstitutional, and also that the applicant's mark was so similar to the mark of opponent that it would be likely to lead to confusion, and enable applicant to perpetrate a fraud on the public. The Examiner of Interferences dismissed the opposition, and from his decision the case was appealed to the Commissioner, who affirmed

> the decision. An appeal was then taken to the Court of Appeals, and that Court affirmed the Commissioner, and 'ordered that this decision and the proceedings in this Court be certified to the Commissioner of Patents, as required by law.' * * *
>
> "In the light of the various details of the Act of February 20, 1905, and of the specific provisions of Section 9, we were of the opinion that proceedings under the act were governed by the same rules of practice and procedure as in the instance of patents, and the writ of error was accordingly dismissed. The same result must follow in the present case. * * *
>
> "Appeal and writ of error dismissed."

Appellants urge that *Johnson vs. Mueser (supra)*, may be distinguished on the ground that the loser had another remedy and could apply for a patent to a Court of Equity under Sec. 4915 of the Rev. Stat., and that under Sec. 4914 of the Rev. Stat. any person interested could contest the validity of the patent to the winner, notwithstanding the decision of the Court of Appeals of the District of Columbia. No effort is made, however, to distinguish the other three cases; the decision in each of these three cases was final in the same sense and to the same extent as the decisions in the cases now at bar. In the last two cases cited above substantial trade-mark rights were involved, in neither of which cases did the loser have any further remedy; in principle, these two cases are not distinguishable from the cases at bar.

Nor can the cases at bar be distinguished, as appellants urge, on the ground that here "rights of persons or property" are involved. The "right" claimed here, and the only claim of "right" involved, is the right to a registration of the common surname "Howard." Such claim of "right," if not without merit on its face, has positively been foreclosed by the repeated

decisions of this Court (*Howe Scales Co. vs. Wyckoff, Seamans & Benedict*, 198 U. S. 118; *Merriam Co. vs. Syndicate Pub. Co.*, 237 U. S. 618, and cases cited), and a contention, or an appeal, based upon such a claim of "right" would appear to be frivolous.

> "If * * * the averment as to a right arising under the Federal Constitution or statutes was unsubstantial and without real merit, either because of its frivolous character upon its face, or from the fact that reliance was based upon a claim of Federal or statutory right denied by former adjudications of this Court, then the appeal to this Court must be dismissed. *Newburyport Water Co. vs. Newburyport*, 193 U. S. 561, 576, 48 L. ed. 795, 799, 24 Sup. Ct. Rep. 553; *Equitable Life Assur. Soc. vs. Brown*, 187 U. S. 308, 311, 47 L. ed. 190, 192, 23 Sup. Ct. Rep. 123."
> *Merriam Co. vs. Syndicate Pub. Co.*, 237 U. S. 618, 621.

> "The claim must be real and substantial, not merely colorable or without reasonable foundation. * * * Whether the question * * * is real and substantial, or is merely colorable and without reasonable foundation, depends, *inter alia*, upon whether it is an open one in the Supreme Court, or has been solemnly and directly determined by that Court."
> *Harris vs. Rosenberger*, 145 Fed. (C. C. A.) 449, 452, and cases cited (Van Deventer, C. J.).

> "The right to appeal is one of substance, and not of mere form. Where a question has been foreclosed by the repeated decisions of this Court, that question can no longer be a ground for an appeal."
> *Kansas vs. Bradley*, 26 Fed. 289 (Brewer, J.).

There is no Judgment or Decree (Final or Otherwise) Before this Court for Review.

In appeals from decisions of the Commissioner of Patents under said Sec. 9 of the Trade-Mark Act of 1905, the Court of Appeals of the District of Columbia enters no judgment or decree (and is not authorized so to do), not even a judgment for costs, but merely certifies its decision to the Commissioner of Patents which "shall govern the further proceedings in the case" (Rev. Stat., Sec. 4914).

In *Wells vs. Reynolds*, 3 App. D. C. 43, a motion was made for judgment for costs. In denying the motion, the Court, through Chief Justice Alvey, said:

> "Upon consideration of this motion, the Court has concluded that under the law it has no power or jurisdiction to award costs, or to execute any judgment therefor, that might be entered to cases of appeals from the Commissioner of Patents. The motion is therefore denied" (Dec. 5th, 1894).

There has been no reversal, modification or exception to said ruling or practice.

The cases at bar should be dismissed on the ground that the Court is without jurisdiction; also on the ground that no "real or substantial" question is involved.

The petitions for writs of certiorari should also be denied.

Respectfully submitted,

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Attorney for R. S. Howard Co.,
120 Broadway,
New York.

MAY 31 1919

No. 10[redacted]3 [redacted]113

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1918. No.

THE BALDWIN COMPANY,

Petitioner,

against

R. S. HOWARD COMPANY,

Respondent.

In re Petition for Writ of Certiorari to the Court of Appeals of the District of Columbia.

Brief on Behalf of Respondent.

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1919

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1918.

No.——

THE BALDWIN COMPANY,
Petitioner,

against

R. S. HOWARD COMPANY,
Respondent.

In re Petition for Writ of Certiorari requiring the Court of Appeals of the District of Columbia to certify to the Supreme Court of the United States for review and determination the causes of

R. S. HOWARD COMPANY,
Appellant-Respondent,

against

THE BALDWIN COMPANY,
Appellee-Petitioner.

and

R. S. HOWARD COMPANY,
Appellant-Respondent,

against

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY, substituted) and THE BALDWIN COMPANY,
Appellees-Petitioners.

BRIEF ON BEHALF OF RESPONDENT.

Statement.

On or about August 6, 1914, R. S. Howard Company, a corporation, the respondent, presented its application to the Patent Office praying that Trade-Mark Registration No. 46,993, registered October 17, 1905, by The Baldwin Company, for pianos, and Trade-Mark Registration No. 31,411, registered March 8, 1898, by The Valley Gem Piano Company, for pianos, be canceled.

Said The Baldwin Company claims to own both said trade-mark registrations.

Grounds for Cancellation of Registration No. 31,411.

The R. S. Howard Company applied to cancel Registration No. 31,411 on the ground that registrant was not entitled to the use of the mark or to register the mark at the date of its application for registration, in that:

> (1) Registrant (or its predecessors in business) was not the first to adopt and use the name "Howard" as a trade name and mark for pianos, but that applicant's predecessor in business, Robert S. Howard, was the first to adopt and use the name "Howard" as a trade name and mark for pianos, and that the applicant to cancel and its said predecessor in business have continuously used the name "Howard" as a trade name and mark for pianos since such first adoption and use, which was long prior to the time when registrant claims to have first adopted and used said mark.

(2) Registrant, prior to its application to register same, had never used the mark in commerce between the United States and foreign nations or Indian tribes.

(3) Registrant had never used the mark prior to its application to register same, or at any time.

(4) The principal feature of the mark is the word "Howard," an individual or proper name, a common surname, and also a common geographical term, which was not registrable under the Trade-Mark Act in force at the date of its registration.

(5) The name "Howard" is the predominating and dominant feature of applicant's corporate name, and registrant or its successors in business had never made use of the name "Howard" as a trade-mark for pianos prior to the date of applicant's incorporation.

(6) The mark is not used by the registrant or its successors in business, but has been abandoned by registrant and its successors in business.

Grounds for Cancellation of Registration No. 46,993.

The R. S. Howard Company applied to cancel Registration No. 46,993, on the ground that registrant was not entitled to the use of the mark, or to register the mark, at the date of its application for registration thereof, in that:

(1) Registrant or its predecessors in business were not the first to adopt and use the name "Howard" as a trade name or mark for pianos, but that applicant's predecessor in business was the first to adopt and use the name "Howard"

as a trade name and mark for pianos, and applicant and its predecessor in business have continuously used the name "Howard" as a trade name and mark for pianos since such first adoption and use, which was long prior to the time when registrant or its predecessor in business claims to have first adopted and used said mark.

(2) The mark consists merely in the name of an individual, a common surname, not written, printed, impressed or woven in some particular or distinctive manner, or in association with the portrait of the individual, is also a geographical term, and not registrable under the Trade-Mark Act in force at the date of its registration.

(3) The registration was obtained by fraud because the statement and declaration forming a part of the application to register the mark were false in that:

(a) The mark had not been continuously used in the business of registrant and its predecessor since December, 1896.

(b) The name "Howard" was never at any time used by registrant, or its predecessors in business, printed or impressed in a particular, distinctive or peculiar manner.

(c) Registrant or its predecessors in business had never made statutory use of the mark prior to its registration; and

(4) The name "Howard" is the predominating and dominant feature of applicant's corporate name, and registrant or its predecessors in business had never made use of the name "Howard" as a trade-mark for pianos prior to the date of applicant's incorporation.

The Answers to the Application to Cancel.

The answers were in the nature of general denials and alleged that said The Valley Gem Piano Company was the first to adopt and use the name "Howard" as a mark for pianos, and first adopted and used same about December 15, 1896, and that said The Valley Gem Piano Company and its successor, said The Baldwin Company, had used said name "Howard" and said registered marks continuously since about December 15, 1896, as a mark for pianos, the said The Baldwin Company claiming title exclusively through an assignment from said The Valley Gem Piano Company, and as the successor to said The Valley Gem Piano Company, an Ohio corporation, said assignment from said The Valley Gem Piano Company to said The Baldwin Company having been made about December 6, 1901; also that applicant to cancel was not injured.

"Full Faith and Credit" Not Involved in This Action.

The principal ground relied upon by petitioner is that the Court of Appeals of the District of Columbia did not give full faith and credit to a prior judgment in an action by The Baldwin Company against the R. S. Howard Company.

After most of the testimony had been taken in these cancellation proceedings, The Baldwin Company brought an action against the R. S. Howard Company in the United States District Court for the Southern District of New York. This action (as stated by the Court in its decision) was

> "For infringement of Trade-Mark No. 31,411, registered March 8, 1898; also Trade-Mark No. 46,993, registered October 17, 1905;

> also the name 'Howard' as a common-law trade-mark for pianos and for unfair competition in that the defendant uses, or threatens to use, the name 'Howard' in marking and in connection with the sale of pianos, as distinguished from the name 'R. S. Howard Company,' 'R. S. Howard Co.,' or 'R. S. Howard' * * * The prayer of the bill is for the usual relief, and in addition that defendant be enjoined from further prosecuting certain cancellation proceedings now pending in the Patent Office in respect to said two trade-marks" (Rec., p. 2633, fol. 2706).

The judgment in the above-mentioned action (which for convenience is designated the "equity action") was never pleaded in these proceedings; no mention is made of it in the pleadings.

The judgment roll in the equity action was never offered in evidence.

Both Courts, in the equity action, although urged expressly, refused to interfere with these cancellation proceedings (Rec., p. 2636, fol. 2721).

The Baldwin Company, at the trial in the equity action, withdrew their claims of infringement of the trade-mark registrations and waived all profits and damages.

Both Courts, in the equity action, refused to pass upon the validity of the trade-mark registrations, the United States Circuit Court of Appeals expressly stating "that all questions concerning the validity of the registrations should be left to the cancellation proceedings" (Rec., p. 2645, fol. 2734).

Both Courts based their decision and judgment "solely on principles of unfair competition," "solely to its common-law rights," and decreed that the R. S. Howard Company was entitled to use the name "Howard" as a mark for pianos, with the initials "R. S." or the name "Robert S." prefixed, and the word "Com-

pany" or "Co." affixed (Rec., p. 2639, fol. 2722; pp. 2641-42, fols. 2726-7).

The United States Circuit Court of Appeals, in the equity action, expressly stated that its decision was based solely on unfair competition and that the validity of the trade-mark registrations was not in issue, the Court saying:

> "At the final hearing below plaintiff did not claim infringement of its registrations and confined its charge of infringement solely to its common-law rights in the name 'Howard.' * * * It was evidently the opinion of the Court below that all questions concerning the validity of the registrations should be left to the cancellation proceedings instituted by the R. S. Howard Company in the Patent Office and now about to come to final hearing there" (Rec., p. 2645, fol. 2734).

In view of the foregoing, it is respectfully submitted that the question of "full faith and credit" is not involved in these proceedings.

There Are no Questions of Great Gravity, or of General Public Importance, Which Require, or Render Desirable, the Intervention of This Court.

The Questions Here Involved Are All Foreclosed by Decisions of This Court.

As to Registration No. 31,411.

1. It stands decided (*Merriam Co. vs. Syndicate Pub. Co.*, 237 U. S. 618; *Howe Scale Co. vs. Wyckoff, Seamans & Benedict*, 198 U. S. 118, and cases therein cited) that the personal name "Howard," the dominant feature of the mark registered, "is manifestly incapable of exclusive appropriation as a valid trade-

mark" or for registration; therefore, "the registrant was not entitled to the use of the mark at the date of his application for registration" (Sec Section 13, Trade-Mark Act 1905, "use" meaning "exclusive use"; see p. 12 *infra*).

"Howard" is also a common geographical term and was not registrable under the Trade-Mark Act of 1881. *Elgin Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 665; *Delaware & Hudson Canal Co. vs. Clark*, 13 Wall 321.

2. It stands conclusively shown by the testimony of The Baldwin Company's own officers and from said company's own records (and there is no contradiction) that the registrant (1) never used the mark in foreign commerce or in commerce with Indian tribes prior to registration, or *at any time* (see *infra*, pp. 32-4); (2) never used the mark in any manner *at any time*, as it had no business and never did any business *at any time* (see *infra*, pp. 26-32).

3. It stands decided that a registration (No. 31,411) is invalid where there has been no statutory use of the mark prior to registration; the registration here was obtained by fraud, on false affidavits. *Elgin Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 665; *Warner vs. Searle & Hereth Co.*, 191 U. S. 195; *South Carolina vs. Seymour*, 2 App. D. C. 240; *Bronson Co. vs. Duell*, 17 App. D C. 471; *Planten vs. Canton Pharmacy Co.*, 33 App. D. C. 268 (see *infra*, p. 34).

4. The Baldwin Company claims to be the owner of the registration and mark No. 31,411. It stands admitted by The Baldwin Company's own officers that the mark registered (No. 31,411) has been abandoned. See Sec. 13 of Trade-Mark Act of 1905 (see testimony *infra*, pp. 47-51).

As to Registration No. 46,993.

1. It stands conclusively shown by the testimony of The Baldwin Company's own officers (see testimony summarized *infra*, pp. 54-5) that the mark registered (No. 46,993) had never been used by registrant prior to its registration; its first use by registrant was not earlier than 1912; this renders the registration invalid. Said registration was also improperly granted and is invalid because obtained by fraud on false affidavits. The use of the mark shown and described in Registration No. 31,411 (which is substantially the same as Registrant's Exhibit No. 39, see reproduction *infra*, p. 93) is not such a use as will justify the registration of the mark shown in Registration No. 46,993 (see cases immediately below).

The testimony of the officers of The Baldwin Company is that The Baldwin Company and its associated concerns used at different periods four markings, and *four markings only*, for marking their "Howard" pianos, viz: Registrant's Exhibits Nos. 37 and 39 (No. 39 being an impression of No. 37), reproduced at p. 93 *infra;* Registrant's Exhibits Nos. 26 and 40 (No. 40 being a reproduction of No. 26), and reproduced *infra*, p. 94; Registrant's Exhibits Nos. 38 and 41 (No. 41 being a reproduction of No. 38); and Registrant's Exhibits Nos. 27 and 42 (No. 42 being a reproduction of No. 27) (Rec., p. 1238, Qs. 35, 36, 40, 41; pp. 1277, 1279, Q186, as to Exhibits 26 and 27; Q189 as to Exhibit 38; pp. 1306, 1307, Qs. 264, 265).

The Baldwin Company's officers' testimony is that markings identical with Registrant's Exhibit No. 39 are the only markings for "Howard" pianos used prior to 1912 (see *infra*, pp. 54-5) which markings are substantially identical with the mark registered No. 31,411, the essential features claimed being the name

"Howard" and the initial letters "VGPCo." in monogram. This mark was never used by the Registrant, The Valley Gem Piano Company, because it never had any business or did any business. All the pianos bearing this mark were made and sold (at least, until sometime after 1903) by The Ellington Piano Company, an Ohio corporation, whose business was entirely separate and distinct from any other concern, as testified by its officers; this marking was abandoned in 1912 (Rec., pp. 746, 747, Qs. 3-8); that markings identical with Registrant's Exhibits Nos. 40, 41 and 42 were first used in 1912, and Registrant's Exhibits Nos. 40 and 42 are the only markings now used by The Baldwin Company and its allied concerns in marking "Howard" pianos (Rec., p. 1306, Q264). It will be noted that the markings "Registrant's Exhibits" Nos. 40 and 41 include the name "Howard" and the initials "HPCo." (in monogram) of The Howard Piano Company, and that Registrant's Exhibit No. 42 is the only marking ever used on "Howard" pianos by any Baldwin concern which is without *some* monogram. The stencils used for marking the "Howard" piano packing boxes are Registrant's Exhibits Nos. 19 and 20 (impressions of the same are Registrant's Exhibits Nos. 24 and 25); both have the monogram. "He can register only what he has used." *Elgin Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 665; *Bronson Co. vs. Duell*, 17 App. D. C. 471; *Corbin vs. Gould*, 133 U. S. 308; *Planten vs. Canton Pharmacy Co.*, 33 App. D. C. 268; *Quaker City Flour Mills Co. vs. Quaker Oats Co.*, 43 App. D. C. 260; *Richter vs. Reynolds*, 59 Fed. (C. C. A.) 577; *Kohler Mfg Co. vs. Beeshore*, 59 Fed. 577 (*see infra*, pp. 55-58).

2. It stands conclusively shown by the testimony of The Baldwin Company's own officers and by its plead-

ings and affidavits in evidence (see *infra*, pp. 40-47) that the title of The Baldwin Company to the mark registered (*No. 46,993*) totally fails, in that it claims no rights to this mark *except* as the assignee and successor in business of The Valley Gem Piano Company. As The Valley Gem Piano Company at no time ever had any business or did any business, it had no trade-mark rights and could not acquire any trade-mark rights, and therefore had nothing to transfer; if a transfer was made, it was *in gross*. The Baldwin Company claims to have acquired the corporate capital stock of The Valley Gem Piano Company about January 1, 1902 (see *infra*, pp. 54-58).

3. It stands decided that the personal name "Howard" (also a common geographical term), was not registrable under the Trade-Mark Act of 1905, except under circumstances not existing in this case. *Merriam Co. vs. Syndicate Pub. Co.*, 237 U. S. 618; *Thad. Davids Co. vs. Davids Mfg. Co.*, 233 U. S. 461; *Howe Scale Co. vs. Wyckoff, etc.*, 198 U. S. 118.

The Trade-Mark Act of 1905, Sec. 5, expressly prohibits registration of a personal name except under circumstances not present in this case. *Rogers vs. International Silver Co.*, 34 App. D. C. 410.

The statutory prohibition relates back to the date of adoption. If it were then "incapable of exclusive appropriation," the validity of its registration may be assailed. As is shown by cases cited below and *supra*, *priority of use* is immaterial. The Trade-Mark Act requires that a registrant *must be entitled to the exclusive use* of the mark *at the date of the application* for registration. It follows that the registration was secured in direct violation of the express terms of the Trade-Mark Act.

4. The mark is not displayed in a particular or distinctive manner. *Oliver Plow Works vs. William J. Oliver Mfg. Co.*, 40 App. D. C. 125 (see *infra*, p. 51). The Baldwin Company does not seriously contend that the mark is displayed in a particular or distinctive manner.

Section 13 of the Trade-Mark Act of 1905.

"Cancellation is authorized by Section 13 of the Trade-Mark Act if it appears upon application therefor by any person deeming himself injured by the registration:

"1. That the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or

"2. That the mark was not used by the registrant, or

"3. That it has been abandoned.

* * * * *

"The right to use referred to in the first of the above conditions is believed to mean the right of exclusive use. The use referred to in the second condition is clearly a use of a mark as a trade-mark for the goods mentioned in the registration."

Pioneer Suspender Co. vs. Lewis Oppenheimer's Son, C. D. 1907, 114.

Illinois Hydraulic Cement Co. vs. Utica Hydraulic Cement Co., 120 O. G. 2505.

Magic Curler Co. vs. Porter, C. D. 1907, 163.

E. T. Fraim Lock Co. vs. Reading Hardware Co., C. D. 1909, 29.

Registrations No. 31,411 and No. 46,993.

From the foregoing, it follows, as to both registrations, that the registrants were neither entitled to the "exclusive use" nor the "use" of the marks as trademarks, at the date of their applications for registration.

Not only must the mark be of such a character as to entitle the registrant to its exclusive use *at the date of adoption,* but *statutory use* must also be shown or registration is invalid. *Elgin Watch Co. vs. Illinois Watch Case Co.,* 179 U. S. 665; *Bronson Co. vs. Duell,* 17 App. D. C. 471; *Merriam Co. vs. Syndicate Pub. Co.,* 237 U. S. 618; *Howe Scale Co. vs. Wyckoff, etc.,* 198 U. S. 118.

Section 3 of the Trade-Mark Act of 1881 provided that

> "No alleged trade-mark shall be registered unless the same appears to be lawfully used as such by the applicant in foreign commerce or commerce with the Indian tribes, as above mentioned, or is within the provisions of a treaty. * * *"

The Trade-Mark Act of 1881 also provides that only "Owners of trade-marks" could register same:

> "The phrase, 'owner of trade-marks' manifestly limits the right of registration to such person or persons, natural or artificial, as possess the legal title to that for which registration is sought, and it further limits the right of registration to that which is a trade-mark. * * *
>
> "Section 3 expressly declares that 'no alleged trade-mark' shall be registered unless the same appear to be *lawfully used as such* by the applicant" (italics by the Court). *Bronson vs. Duell,* 17 App. D. C. 471.
>
> "The Trade-Mark Act approved February 20, 1905, * * * under which registration is sought, recognizing the law applicable to the subject, forbids the registration of a trade-mark of the mere name of individuals, firms, corporations, or associations" * * * unless "in actual and exclusive use as a trade-mark * * * for ten years next preceding the passage of this Act." *Howe Scale Co. vs. Wyckoff, etc.,* 198 U. S. 118.

See also:

Thad. Davids Co. vs. Davids Mfg. Co., 233 U. S. 461.

Warner vs. Searle & Hereth Co., 191 U. S. 195.

"The Trade-Mark Act (of 1905) confers the right of registration * * * providing the applicant complies with various requirements stated in the Act. * * * Statutory use of the mark is a prerequisite to the right of registration." *Planten vs. Canton Pharmacy Co.*, 33 App. D. C. 268, 270.

"Howard" Without the Monogram "VGPCo."

It stands conclusively shown by the testimony of their own officers that no Baldwin concern had ever made use of the name "Howard" *simpliciter* (that is, without the monogram) as a mark for pianos, prior to the date of incorporation of the R. S. Howard Company (1902), but had always used "Howard" and "VGPCo." (see *infra*, pp. 47-51); their first use of "Howard" without the monogram was in 1912.

In an Application to Cancel under Section 13 of the Trade-Mark Act of 1905, "Prior Use" or "Acquiescence" Are Immaterial Where the Mark is a Nontechnical Mark.

Duluth Superior Milling Co. vs. Koper, 37 App. D. C. 115.

Carroll vs. Duluth Superior Milling Co., 232 Fed. (C. C. A.) 675.

Van Alstyne Co. vs. Boutwell Milling Co., 43 App. D. C. 430.

Heaton-Peninsula Co. vs. Independent Button Fastener Co., 43 App. D. C. 264.

Joseph Lay Co. vs. Indianapolis Brush Mfg. Co., 40 App. D. C. 36.

McIlhenny Sons vs. New Iberia Extract Co., 34 App. D. C. 43.
Kentucky Dist. & Warch. Co. vs. Old Lexington Club Dist. Co., 31 App. D. C. 223.
(See *infra*, pp. 68-71, where these cases are summarized.)

Injury and Damage.

The *inevitable* injury and damage resulting from improper trade-mark registrations are stated in *Elgin Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 665; *Thad. Davids Co. vs. Davids Mfg. Co.*, 233 U. S. 461; *Old Lexington Club Dist. Co. vs. Kentucky Dist. & Warch. Co.*, 234 Fed. 464 (affd. on the opinion below 247 Fed. 1005); *Electro Steel Co. vs. Linderburg Steel Co.*, 43 App. D. C. 270.

In *Elgin National Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 665, this Court expressed the inevitable damage resulting from improper registrations in the following language:

> "Thus it is seen that under the act registration is *prima facie* evidence of ownership; that the certificate is evidence in any suit or action in which the registered trade-mark is brought in controversy; that the act practically enables treaty stipulations to be carried out and affords the basis for judicial redress for infringement in foreign countries, where such redress cannot ordinarily be had without registration, as well as in the courts of the United States, when jurisdiction would not otherwise exist. For it is the assertion of rights derived under the act which gives cognizance to courts of the United States when the controversy is between citizens of the same state, though the benefit of the act cannot be availed of if the alleged trade-mark is not susceptible of exclusive ownership as such, and not, therefore, of registration."

In a cancellation proceeding, *Electro Steel Co. vs. Linderburg Steel Co.*, 43 App. D. C. 270, the Court said:

> "Should registrants be permitted to retain their registration they would be * * * in a position to institute expensive and troublesome litigation basing their suits upon said registration and attacking both the petitioner's purchasing trade as well as the purchasing public in general, and they would be in a position to threaten and intimidate the purchasing public. In this way the business of petitioner would be seriously and permanently damaged; its sales * * * would necessarily fall off. * * * and the trade and business of petitioner would be seriously injured were the registrants to be allowed to retain their registration * * *."

Injury to R. S. Howard Company.

1. Any concern entitled to use the name "Howard" in any form, as a trade or business name, in the piano business, will be *presumed* to be injured and damaged by said registration of the name "Howard." Damage will be implied as a matter of law. *Elgin Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 665, and cases, *supra*.

It was adjudicated in the equity action between the parties (*supra*) that the R. S. Howard Company is entitled to use "R. S. Howard Co." as a mark for its pianos (Rec., p. 2842).

If The Baldwin Company were entitled to the registration of the name "Howard," it would be entitled to the *exclusive use* of "Howard" *in every form*, whether used *simpliciter*, or with prefixes or with suffixes, and the use of "R. S. Howard Co." by the R. S. Howard Company would be an infringement of such registered mark.

Davids vs. Davids Mfg. Co., 233 U. S. 461.

Robert S. Howard, the predecessor in business of the R. S. Howard Company, sold (and was the exclusive seller of) pianos marked "Howard," "R. S. Howard & Co." and "Howard & Co." for SEVEN YEARS PRIOR to the date that the petitioner *claims* to have first used "Howard" as a name for pianos. The record contains the testimony of thirty-five witnesses who handled or sold these "Howard" pianos, which were bought from or through Robert S. Howard *prior to 1896.* (See *infra,* pp. 60-62.)

Pianos bearing the name "Howard," or any name of which the name "Howard" formed a part, have always been called "Howard" pianos by practically everybody, because "Howard" was the dominant feature of the name on the fallboard; and this was true whether it was "Howard," or "R. S. Howard & Co.," or "Howard & Co.," or "R. S. Howard Co."

> "There is no doubt that from the time any variant of 'Howard' was inscribed upon pianos the retail trade, the user and the public generally spoke of them as 'Howard' pianos" (opinion of Judge Hough, Rec., p. 2636, fol. 2712).

Prefixes and suffixes are entirely disregarded by the trade and public generally (see testimony of Armstrong, petitioner's president, Rec., p. 2396, XQs. 143-145; Dickinson, petitioner's vice president, Rec., p. 1807, XQ64; p. 1809, RDQ75; p. 1810, RXQ77; Chas. H. Steinway, of Steinway & Sons, Rec., pp. 804-806, Qs. 9-14; Geo. J. Dowling, president of the Cable Company, Rec., p. 593, Q11).

In *Guth vs. Guth Chocolate Co.,* 224 Fed. (C. C. A.), 932, where the controversy was between the use of "Guth" and "Guth Chocolate Co.," the Court said:

> "It is the surname which catches the public, and few purchasers would notice the difference between one form and the other. In the nature of things confusion was inevitable."

Thad. Davids Co. vs. Davids, 233 U. S. 461, is directly in point. In the *Davids* case the mark registered was "Davids," properly registered under the "ten-year" clause.

It was held that this registered mark was infringed by the use of "C. I. Davids Co." This Court said:

> "The further argument is made that, assuming that the complainant has a valid registered trade-mark, still the protection is limited to its use when standing alone (as the complainant has used it on its labels) and that there can be no infringement unless it is used in this precise manner. The statutory right cannot be so narrowly limited. Not only exact reproductions, but a 'colorable imitation' is within the statute; otherwise, the trade-mark would be of little avail as by shrewd simulation it could be appropriated with impunity * * *. Moreover, in view of this statutory right, it could not be considered necessary that the complainant in order to establish infringement should show wrongful intent in fact on the part of the defendant, or facts justifying the inference of such an intent (citing cases). Having duly registered under the act, the complainant would be entitled to protection against any infringing use; * * *
>
> "We agree with the Circuit Court that infringement was shown. The complainant put its mark 'Davids' prominently at the top of its labels. The defendants, in the same position on its labels, put 'C. I. Davids Co.' At the bottom of their labels the defendants placed 'Davids Mfg. Co.' The use of the name in this manner was a mere simulation of the complainant's mark which it duly registered; it constituted a 'colorable imitation' within the meaning of the Act."
>
> "A validly registered trade-mark cannot be used, either in part or as a whole, by any other than the owner, even with words explaining

> that the article to which it is attached is not manufactured by the owner of the trade-mark." *Manitou Spring Co. vs. Schueler*, 239 Fed. (C. C. A.) 593.

In re Hoff, 30 App. D. C. 233, is identical with the case at bar. In that case the Court held that the name "Hoff's" and the name "Leopold Hoff's" are so nearly similar as to create confusion and that registration should be refused, although the courts had decided that applicant to register was the prior user, was solely entitled to use "Hoff" or "Hoff's" (*simpliciter*), and had already enjoined opposer from using "Hoff" or "Hoff's" (alone), the Court decreeing that opposer must distinguish by using "Leopold Hoff."

In *Peter Schoehhoffer Brewing Co. vs. Maltine Co.*, 30 App. D. C. 340, 346, the Court said:

> "An imitation of a trade name with partial differences such as the public would not observe, does the same harm as an entire counterfeit, and would be enjoined accordingly. Where the trade name or trade-mark consists of a word it may be used by its appropriator in any style of print or on any form of label, and its use by another in any form is unlawful. In such case, as the goods become known by the name or word by which they have been designated, and not merely by the manner or fashion in which the word is written or printed, or the accessories surrounding it, the unlawful use of the word in any form may be restrained."

It is obvious that the "same harm" would be done the other party *lawfully* using a similar name.

Registration was refused in all the following cases, on the ground of similarity which would cause confusion and, therefore, injury and damage.

In re Wright, 33 App. D. C. 510, "Taylor," "Old Taylor," "G. A. Taylor," "Kentucky Taylor," were all held to be deceptively similar.

"Tucker" and "J. C. Tucker" in *Brown-Forman Co. vs. Beech Hill Distilling Co.*, 30 App. D. C. 485.

In *Kentucky Dist. & Wareh. Company vs. Old Lexington Club Dist. Co.*, 31 App. D. C. 223, "Old Lexington Club" and "Lexington Club."

Ex parte Ames Shovel & Tool Co., 120 Ms. Dec. 242; "Myers" and "H. M. Myers."

> "The substantial question as stated by the tribunals of the office, is as to whether the proposed trade-mark, 'Green Ribbon,' so nearly resembles the trade-mark of the appellee, 'as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers.'"
>
> *Lang vs. Green River Distilling Co.*, 33 App. D. C. 506.

Where two parties use similar marks or names in the same line of business, it has been universally recognized that *inevitable* damage and injury results, that it is impossible to avoid confusion and damage.

Numerous cases might be cited, as, for example:

Brown Chem. Co. vs. Meyer, 139 U. S. 540.
Singer Mfg. Co. vs. June, 163 U. S. 169.
Howe Scale Co. vs. Wyckoff, Seamans & Benedict, 198 U. S. 118.
Meneely vs. Meneely, 62 N. Y. 427 (aff. 1 Hun 367), a case often cited by the Supreme Court.
Fuller vs. Huff, 104 Fed. (C. C. A.) 141.

2. R. S. Howard Company injured and damaged by The Baldwin Company's intimidating letters to the R. S. Howard Company's customers threatening suits for infringement of "duly registered" trade-marks. (See *infra*, pp. 72-7.)

3. R. S. Howard Company injured and damaged by The Baldwin Company's suit and threatened suits for infringement of the trade-mark registrations in suit against itself and its customers. (See *infra*, pp. 77-80.)

4. R. S. Howard Company injured and damaged by the registrations in suit because the registrations are *prima facie* evidence of *exclusive* ownership of a *valid* trade-mark of the name "Howard" *in every form*, including the form "R. S. Howard Co." (See *infra*, p. 72.)

5. R. S. Howard Company injured and damaged by registration of the name "Howard," the dominant feature of its corporate name. Confusion and damage obvious and inevitable because of the deceptive similarity of "Howard" and "R. S. Howard Co." The Trade-Mark Act of 1905, Section 5, expressly prohibits registration of any mark which would "be likely to cause confusion or mistake in the mind of the public." (See *infra*, pp. 80-2.)

6. R. S. Howard Company injured and damaged by the foreign registrations of The Baldwin Company of the name "Howard" for pianos, which registrations were secured upon, and continue to exist, *solely* by reason of the registration in the United States Patent Office. (See *infra*, pp. 82-92.)

Jurisdiction Under Section 13 of Trade-Mark Act of 1905.

It is respectfully submitted that the purposes of Section 13 of the Trade-Mark Act of 1905 should be construed liberally and that it has been construed broadly enough to give any applicant a standing to cancel any mark which offers either a present or prospective prospect of injury or damage.

It is further respectfully submitted that the invalidity in law of registrations should be equally as good a ground for cancellation as some present or prospective personal or peculiar damage.

Electro Steel Co. vs. Linderburg Steel Co., 43 App. D. C. 270.
Goodrich Drug Co. vs. Cassada Mfg. Co., 46 App. D. C. 146.
Duluth Superior Milling Co. vs. Koper, 37 App. D. C. 115.
Heaton-Peninsula Co. vs. Independent Button Fastener Co., 43 App. D. C. 264.
McIlhenny Sons vs. The New Iberia Extract Co., 34 App. D. C. 43.

In the cases at bar, no bona fide attempt is made to defend the validity of the registrations, or to deny that they were improperly and improvidently made.

Nor is it contended that the applications to cancel fail to allege amply sufficient jurisdictional facts.

Section 13 of the Trade-Mark Act of 1905 says that "whenever any person shall deem himself injured by the registration" he shall have the right to apply to cancel, that is, shall have a standing to obtain cancellation, if the grounds for cancellation provided by Section 13 are shown to exist.

It is respectfully submitted that jurisdiction, and allegations of jurisdictional facts, should be determined by the well established rules of practice and procedure of Federal Equity Courts. Such were considered in the recent case of *Fair vs. Kohler Die Co.*, 228 U. S. 22, where the parties were residents of the same state and the bill charged infringement of patent rights in general terms because defendant was breaching conditions which plaintiff had attempted to impose upon second purchasers of the patented device, but which defendant contended could not be held to be an infringement of a right under the Patent Act.

We take the following from Mr. Justice Holmes' opinion:

> "The appeal is upon the question of jurisdiction alone. There is no uncertainty or ambiguity and we are of opinion that the case is properly here. *Petri vs. Creelman Lumber Co.*, 199 U. S. 487, 492.
>
> "Jurisdiction is authority to decide the case either way. Unsuccessful as well as successful suits may be brought upon the (Patent) act, and a decision that a patent is bad, whether on the facts or the law, is as binding as one that is good. See *Fauntleroy vs. Lum*, 210 U. S. 230, 235. No doubt if it should appear that the plaintiff was not really relying upon the Patent law for his alleged rights, or if the claim of right were frivolous, the case might be dismissed. In the former instance the suit would not really and substantially involve a controversy within the jurisdiction of the Court, *Excelsior Wooden Pipe Co. vs. Pacific Bridge Co.*, 185 U. S. 282, 287, 288, and in the latter the jurisdiction would not be denied, except possibly in form. *Deming vs. Carlisle Packing Co.*, 226 U. S. 102, 109. But if the plaintiff really makes a substantial claim under an Act of Congress, there is jurisdiction whether the claim ultimately be held good or bad. * * *
>
> "In this case the plea, though purporting to go to the jurisdiction of the Court, merely means that the patent law does not give a patentee a right to impose such a condition as the plaintiff attempted to impose upon second purchases of the device. The plaintiff no doubt maintains that the law does give him that right, and that even if the alleged infringements are confined to the acts admitted by the plea, they are infringements none the less. The bill hardly can be confined to that claim, but if it were, it is made in good faith and is not frivolous, it is a claim of right under the patent law and the Circuit Court properly took juris-

diction of the case. *Excelsior Wooden Pipe Co. vs. Pacific Bridge Co.*, 185 U. S. 282, 295. *White vs. Rankin*, 144 U. S. 628, 635, 636, 639."

It is respectfully submitted that the R. S. Howard Company has met fully all the conditions and requirements of Section 13 of the Trade-Mark Act of 1905, as to its "interest in the subject-matter," its "injury" and damage, to entitle it to cancellation.

Annexed is an appendix summarizing the facts and testimony and citing the authorities in detail, to which reference is respectfully made.

The petitions for writs of certiorari should be denied.

Dated, New York, May 31, 1919.

Respectfully submitted,

SAMUEL S. WATSON,
Counsel for Respondent.

APPENDIX.

Parties Involved in These Proceedings, All Entirely Separate Concerns (Rec., 746-7).

The Valley Gem Piano Company,
an Ohio corporation, incorporated October, 1905 (Rec., p. 1157, Q71), its assets claimed to have been transferred to The Baldwin Company in December, 1901. It never, at any time, did any business. In 1912, its name was changed to "The Howard Piano Company."

The Howard Piano Company
was a new name for The Valley Gem Piano Company, the name being changed in 1912 (Rec., pp. 1098-9).

The Baldwin Piano Company
was incorporated under the laws of Ohio, August, 1892 (Rec., p. 1157, Q71).

The Baldwin Company
was incorporated under the laws of Ohio, February, 1898 (Rec., p. 1157, Q71).

The Ellington Piano Company,
an Ohio corporation, incorporated February, 1893.

D. H. Baldwin & Company,
a partnership, engaged in the retail piano business in Cincinnati. The partners of this firm were the principal stockholders in the above corporations.

R. S. Howard Company,
a New York corporation, incorporated in April, 1902, to manufacture and sell pianos, succeeded to the good-

will and business of Robert S. Howard, who became its president and largest stockholder. Robert S. Howard had been in the piano business since 1877 (Rec., p. 200, Qs. 5-8; p. 248, XQs. 203-5).

The Facts.

There Was No Statutory Use of Mark No. 31,411 Prior to Registration.

The Valley Gem Piano Company, the registrant of the Mark No. 31,411, never used the mark prior to its application to register, *or at any time.*

The Valley Gem Piano Company was nothing but an empty shell, according to the testimony of its own officers. It had no plant. It never made any pianos. It never marked any pianos. It never sold pianos. It never did any work on, or in connection with, any pianos. It *never did any business of any kind.* There is no evidence which shows use of the mark by The Valley Gem Piano Company *at any time.*

LEVI D. SARGENT testified (Rec., p. 1232) that he is now and since 1912 has been, the treasurer of The Ellington Piano Company; that he was secretary of The Valley Gem Piano Company from 1900 to 1912 (Rec., p. 1253, Qs. 97, 98), and an officer (now treasurer) of The Howard Piano Company (Q96, Rec., p. 1253); that he has been a director of The Baldwin Company since the latter part of 1901 (Rec., p. 1257, Q111; p. 1311, XQs. 271-274); that he has been employed by The Ellington Piano Company since 1892 or 1893, doing general office work, looking after shipments and factory work, and in charge of its factory under Lucien Wulsin from 1893 to 1900, when he assumed general management of its factory,

and has been in charge of its factory ever since 1900 (Rec., p. 1232, Qs. 1-15). He produced a piano register book (Registrants' Exhibit No. 16), which he testified contained a record of all "Howard" and "Valley Gem" pianos made by the Baldwin concerns (all were made in Cincinnati) from May, 1895, to October 1st, 1900 (Rec., pp. 1234-5, Qs. 21-24); also another piano register book (Registrants' Exhibit No 18), a continuation of Registrants' Exhibit No. 16, which contained a record of all "Howard" pianos made in Cincinnati from October 1st, 1900, to December, 1903.

LEVI D. SARGENT also testified (Rec., p. 1234):

"Q17. State what makes of pianos, if you know, were manufactured at the Ellington factory during the latter '90s? A. Ellington, Valley Gem and Howard" (Rec., p. 1237).

"Q32. What, if anything, did you have to do with the shipment of pianos in December, 1896, which were marked 'Valley Gem' and 'Howard'? A. I looked after all these shipments during December, 1896, saw that they were properly marked and packed before shipment, and sent to the depot" (Rec., p. 1314).

"XQ292. You produced these piano registers, the first one being Registrants' Exhibit No. 16, and have testified, as I recall, that you were in charge of or directly responsible for the management of the factory of The Ellington Piano Co. during all the time the pianos were manufactured which were listed in this register. Is that correct? A. Yes, sir."

"XQ293. Were all of the pianos which were marked 'Valley Gem' or with the name 'Howard' manufactured in the Ellington factories during the

period covered by the register, Registrants' Exhibit No. 16, listed in this register? A. To the best of my knowledge and belief, all pianos manufactured, that is, Valley Gem and Howard, are entered in that register manufactured during the period covered by this register. I don't know of any Howard or Valley Gem pianos not entered in there during that period" (Rec., p. 1315).

"XQ297. So that register, Registrants' Exhibit No 16, contains a complete list of the pianos which were marked 'Valley Gem' and 'Howard,' which were made in Cincinnati during the period covered by the register, namely, from May, 1895, to September, 1900; is that correct? A. It is correct, to the best of my knowledge and belief, as I had charge of all the manufacturing of these pianos and the entries were made under my direction."

LEVI D. SARGENT testified that all "Howard" transfers and stencils were always bought and paid for by The Ellington Piano Company (Rec., p. 1259, Qs. 119-123; p. 1238, Qs. 38-40); there is not one word of evidence that The Valley Gem Piano Company ever ordered, purchased or paid for any material or labor of any kind whatever for or on pianos, at any time (Rec., pp. 1306-7, Qs. 264-265; pp. 1262-8, Qs. 135-154; pp. 1436-9, Qs. 15-16, 21-26, 31).

LEVI D SARGENT testified that all "Howard" pianos were made from the beginning after the scales of The Ellington piano; the materials were selected and purchased by The Ellington Piano Company and the pianos were made, inspected, shipped and sold by The Ellington Piano Company, the money collected by and paid to The Ellington Piano Company.

No Use of Mark No. 31,411 Prior to Registration.

LEVI D. SARGENT testified (Rec., p. 1695):

"Q85. Please state whether it (the billing of pianos) was done in the name of anyone else than D. H. Baldwin & Co. and The Ellington Piano Company, and if so, in whose name? A. Why, to the best of my recollection, all of that billing was either through The Ellington Piano Company or D. H. Baldwin & Co.

"Q86. To whom were the payments made, if you know, for the bills referred to? A. Why, the accounts mentioned were settled either direct to The Ellington Piano Company or through D. H. Baldwin & Co. The payments may have been made to D. H. Baldwin & Co. and turned over to The Ellington Piano Company, or may have been made direct."

The "Howard" pianos were made by The Ellington Piano Company and were shipped by that company to dealers direct or to dealers' customers. There are a host of such accounts in Registrants' Exhibits Nos. 29, 30 and 31, showing such shipments made on orders from Robert S. Howard and from his customers. Some of these accounts are read into the record by Mr. Sargent (Rec., p. 1347, XQ445; pp. 1692-6, Qs. 78-88).

GEORGE W. ARMSTRONG, JR., president of The Baldwin Company, one of the organizers of The Baldwin Company and The Valley Gem Piano Company, officially connected with both companies since their organization, and a member of the firm of D. H. Baldwin & Co. since 1883, testified that The Valley Gem Piano Company never had any factory or property of any kind at any time (Rec., p. 2389, XQ93; pp. 2393-4, XQs. 114-118), except the name "Valley

Gem" (Rec., pp. 2393-4, XQs. 114-118), no plant (Rec., p. 2390, XQ96), never sold pianos (Rec., p. 2390, XQ97), pianos marked "Howard" were both made and sold by The Ellington Piano Company (Rec., pp. 2389-90, XQs. 92-102), all the billing was through The Ellington Piano Company (Rec., p. 2390, XQ102).

GEORGE W. ARMSTRONG, JR., testified (Rec., p. 2389):

"XQ91. When was the Valley Gem Piano Company incorporated? A. I don't recall the exact date; I should imagine it would be about 1895 or 1894.

"XQ92. What did it do—what was its business? A. The Valley Gem Piano Company was a corporation that had the pianos made in the Ellington factory, and it was designed to have another make, or line, as we call it in the piano business.

"XQ93. It never made any pianos itself at all? A. It had no active manufacturing existence.

"XQ94. And as a matter of fact, it was a mere paper name, was it not? A. No; it had stock subscribed.

"XQ96. It never had any plant? A. No; they always manufactured right in the Ellington piano factory.

"XQ97. It never sold the pianos itself? A. No.

"XQ98. The Ellington Company made the pianos? A. The Ellington Company made the pianos.

"XQ99. And they sold them to D. H. Baldwin & Company? A. Yes.

"XQ100. And the Valley Gem Company never made any of the pianos, that is your understanding? A. Yes.

"XQ101. And never handled any of them? They were always made by the Ellington Company? A. Yes, in a department by themselves."

(Rec., p. 2391):

"XQ105. A. About forty years ago or more we had sold a great many Valley Gem pianos which were made in Ripley, Ohio, the principal owner of them being a man named Chase. He went into bankruptcy, the business was closed out, and a man by the name of George W. Early, in Columbus, Ohio, who was a former employee of ours and a very good friend of ours, had bought up the name. We were casting around then for the name for an inexpensive piano to put in our business of D. H. Baldwin & Company, and I happened to think that the old name would be worth something to us in that locality. I went to Mr. Early in Columbus, Ohio, and I gave him a hundred dollars for that name, and we then incorporated that business. That was the genesis of the Valley Gem Piano Company. * * *"

(Rec., p. 2392):

"XQ111. Did the Valley Gem Piano Company have any property? A. It had its capital stock of $25,000.

"XQ112. Well, that was a liability, wasn't it? A. Well, in one way I may say it was; but the members of the firm each owned $5,000 of that.

"XQ114. Did they have any physical assets of any kind? A. No; the trade name (Valley Gem) I consider was an asset.

"XQ115. That was all they ever had? A. Yes; and that I thought was of real value.

"XQ116. Was that the only thing they ever had? A. Well, practically speaking.

"XQ117. Did you buy any machinery or tools or anything else when you bought that from Early? A. No.

"XQ118. Just the name? A. Yes."

GEORGE W. ARMSTRONG, JR., also testifies that The Baldwin Company acquired all the stock (from the members of the firm of D. H. Baldwin & Co., each of whom owned one-fifth, and constituted all of the stockholders) of The Valley Gem Piano Company and The Ellington Piano Company (Qs. 12 to 15, Rec., pp. 2378-9), and taking over of this stock of The Valley Gem Piano Company and The Ellington Piano Company by The Baldwin Company was the only "transfer or taking over" which took place (XQs. 130-135, Rec., pp. 2394-5).

The Mark Registered No. 31,411, Was Not Used by the Valley Gem Piano Company or Any Other Baldwin Concern in Commerce Between the United States and Foreign Nations or Indian Tribes, or With the Dominion of Canada, Prior to the Application to Register.

The declaration in No. 31,411 was verified November 8, 1897; application was filed November 15, 1897.

Levi D. Sargent testified that no Howard pianos, to his knowledge, were shipped to any Indian or Indian tribe during the years 1896 or 1897 (Rec., pp. 763-4, Qs. 22-35).

Mr. Sargent also testified that Registrants' Exhibit No. 16 shows all the shipments of Howard pianos during the period which this register covers, *i. e.*, from

May, 1895, to October 1, 1900 (Rec., pp. 1704-6, XQs. 117-121), and that Registrants' Exhibit No. 16 shows that the first shipment of a Howard piano to any foreign country, was made to Canada on November 29, 1897 (Rec., pp. 1704-6, XQs. 115-121; pp. 1938-40, XQs. 26-37).

LEVI D. SARGENT testified (Rec., p. 1704):

"XQ118. Do Registrants' Exhibits Nos. 16 and 18 show all the shipments of pianos marked Howard, made in Cincinnati, prior to March 31st, 1902? A. Those registers would show all shipments into the Dominion of Canada of the pianos marked Howard made at the factories in Cincinnati."

(Rec., p. 1939):

"XQ32. But if such (export) shipments were made, that register (Registrants' Exhibit No. 16) would show it? A. The register would show any such shipments."

(Rec., p. 1940):

"XQ35. If there were any such shipments made for export, how would that be indicated in Registrants' Exhibit No 16, made of Howard pianos during 1897 or 1898? A. The record would show the date and destination, but would not show the source from where the orders came.

"XQ36. If they were shipped to Canada, for example, it would show Canada? A. It would show Canada.

"XQ37. Or if shipped to any other foreign country, it would show that country? A. If shipped to any other foreign country, it would show in the record."

This testimony and the "record" referred to (Registrants' Exhibit 16), shows that the first shipment of

a Howard piano for export to any foreign country was made to Canada on November 29th, 1897 (Sargent's testimony, Rec., p. 1938, XQs. 27-32).

It is respectfully submitted that the foregoing shows entire failure of statutory use requisite to a valid registration.

Statutory Use Must Be Shown or Registration Invalid.

In *Elgin Watch Co. vs. Illinois Watch Co.*, 179 U. S. 665, the Supreme Court summarizes the Trade-Mark Act of March 3rd, 1881, and holds that "no alleged trade-mark shall be registered unless the same appear lawfully used as such by the applicant in foreign commerce or commerce with the Indian tribes."

> *Warner vs. Searle & Hereth Co.*, 191 U. S. 195, 204.

In referring to the requisites and conditions for registration contained in the Trade-Mark Act of 1881, the Court in *South Carolina vs Seymour*, 2 App. D. C. 240, held that to be entitled to registration a trade-mark must be shown to have been used in foreign trade or in lawful commercial intercourse with an Indian tribe, and that the Trade-Mark Act of 1881,

> "limits the registration of trade-marks to such only as may have been actually used in commerce with foreign nations or the Indian tribes. A trade-mark that may have been in undisturbed use for years in domestic trade, and invested with all the characteristics of a trade-mark good at common law, is nevertheless not a trade-mark in the sense of this statute unless it shall have been lawfully used in commerce with foreign nations or the Indian tribes."

Registration Invalid Unless Statutory Use Is Shown.

In *ex parte Strasburger & Co.*, 20 O. G. 155, the applicant was required to specify some foreign nation or Indian tribe with which the mark had been used in lawful commerce in order that it may be made to appear that such is the fact, saying:

> "Section 3 of the Act of March 3, 1881, provides that 'no alleged trade-mark shall be registered unless the same appears to be lawfully used as such by the applicant in foreign commerce or commerce with the Indian tribes, as above mentioned, or is within the provisions of a treaty,' etc. * * *. I find in the passage quoted two requisites named as essential to a valid registration: First, that it shall appear that the proposed trade-mark is lawfully used as such; and, second, that it shall appear that it is used in foreign commerce or in commerce with Indian tribes."

A certificate of registration cannot be taken as evidence that the requirements of the law have been met. *Smith vs. Reynold*, 10 Blatch. 85.

In *ex parte The Commercial Vehicle*, C. D. 1910, pp. 67, 68, it was said:

> "As the application now stands, it relies for its validity upon the original verified papers, which contain the erroneous statement, under oath, that the mark has been in use since about the first day of October, 1909.
>
> "It is well settled that no trade-mark right is acquired by the mere adoption of a trade-mark without use thereof in commerce, and the applicant and his attorney are chargeable with knowledge of this rule of law.
>
> "As the mark was not used prior to the filing of the application, it is not registrable upon this application."

Registration Invalid Unless Statutory Use Is Shown.

In *Bronson Co. vs. Duell*, 17 App. D. C. 471, the Court had under consideration the Trade-Mark Act of 1881, and discussed and decided some fundamental questions, including the question as to who could register a trade-mark, the Act providing that only "owners of trade-marks" could register same, and then only under certain conditions. In the able decision of Mr. Justice Shepard this Court, among other things, states:

> "The phrase 'owners of trade-marks' manifestly limits the right of registration to such person or persons, natural or artificial, as possess the legal title to that for which registration is sought, and it further limits the right of registration to that which is a trade-mark.
> * * * * *
> "If he (the Commissioner) finds that the 'alleged trade-mark' is the name of the applicant, or any other name which cannot be lawfully converted into a trade-mark at common law * * * or that it is not the property of the applicant, he cannot admit it to registration * * *." (Quoting with approval the language used in *Seymour vs. South Carolina*, 2 App. D. C. 240.)
> * * * * *
> "The Commissioner, in office at the time of the passage of the existing law, had no doubt that the lawful right to convert a word or symbol into a trade-mark was intended to remain a prerequisite condition of registration * * *. And that practice has not, since that time, been departed from; until recently, indeed, its soundness seems never to have been questioned.
> * * * * *
> "Section 3 expressly declares that 'no alleged trade-mark' shall be registered unless the same appears to be *lawfully used as such* by the applicant. (Italics by the Court.)
> * * * * *

The Name "Howard" Not Registrable.

> "In our judgment, then, 'the owners of trade-marks,' who, by the first section, are permitted to obtain registration of the same, are those that, in the manner and under the conditions prescribed, shall have used such words and symbols only as at common law, are susceptible of exclusive appropriation as trade-marks; and this is one of the essential elements of 'the presumptive lawfulness of claim to the alleged trade-mark'" * * *.

In the above case, the Court said that if the Commissioner is bound to register anything claimed as a trade-mark, provided the claimant shall have used it in lawful commerce and it be not identical or a deceptive resemblance of the known trade-mark of another, it would follow that Congress must have intended to create lawful trade-marks in words and symbols not capable of appropriation as such at common law, making registration *prima facie* evidence of ownership and infringers liable to the penalties provided by the Act, thereby opening the door to harassing and fruitless litigation and the acquisition of *prima facie* rights of ownership of words and symbols incapable of exclusive appropriation as lawful trade-marks.

"Howard," a Common Surname, Not Registrable.

In Registration No. 31,411, registrants' mark is described as consisting "of the word 'Howard' in connection with the initials 'VGPCo.' in the form of a monogram"; some accessories are then described, registrant then stating "the principal feature of which is the word 'Howard' in connection with the initials 'VGPCo.' arranged monogramatically."

The Name "Howard" Not Registrable.

A personal name, a common surname, was not registrable under the Trade-Mark Act of 1881.

In *Merriam Co. vs. Syndicate Pub. Co.*, 237 U. S. 618, this Court said:

> "The Act of 1881 expressly denied the right of an applicant to obtain a trade-mark upon his own name, and gave no recognition to the right to a trade-mark in a proper name, nor did it confer authority to register such name and thereby acquire a right not recognized at common law. *Brown Chemical Co. vs. Meyer*, 139 U. S. 540, 542, 35 L. Ed. 247, 248, 11 Sup. Ct. Rep. 625; *Elgin Nat'l Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 665, 45 L. Ed. 365, 21 Sup. Ct. Rep. 270; *Howe Scale Co. vs. Wyckoff, Seamans & Benedict*, 198 U. S. 118, 134, 135, 49 L. Ed. 972, 984, 25 Sup. Ct. Rep. 609."

A proper name, even though fancifully or distinctively displayed, could not be registered under the Act of 1881.

A. Featherstone & Co., 86 O. G. 1497.
Ex parte Thaddeus Davids & Co., 15 O. G. 94.
Ex parte Gilson & Co., 30 O. G. 1992.

A Non-Registrable Name, Word, or Term, Does not Become Registrable by Combining It With Registrable Subject-Matter.

Ex parte Farnum & Co., 19 O. G. 412.
Ex parte Engelhard & Sons Co., C. D. 1904, 122.
Ex parte P. H. Hanes Knitting Co., C. D. 1913, 205.

Geographical Term Not Registrable.

A mark is not registrable unless its controlling features are registrable.

In re Crescent Typewriter Supply Co., 30 App. D. C. 324.
In re Hopkins, 29 App. D. C. 118.
Ex parte Union Carbide Co., C. D. 1908, 160.
Johnson vs Brandeau, 32 App. D. C. 348.
In re Schweinfurter, 38 App. D. C. 279, 280.

Geographical Name or Term not Registrable.

There is no authority to register a geographical name or term under any of the provisions of either the Trade-Mark Act of 1881 or 1905, except possibly under the "ten-year" clause of the Trade-Mark Act of 1905.

> "Sec. 5 of said Trade-Mark Act (33 Stat. at L. 726, Chap. 592; U. S. Comp. Stat. Supp., 1909, p. 1278) prohibits the registration of any mark 'merely a geographical name or term.' This provision is simply declaratory of the common law * * *" *McIlhenny vs. New Iberia E. of T. P. Co.*, 34 App. D. C. 430, 432, citing *Delaware & H. Canal Co. vs. Clark*, 13 Wall. 321, 20 L. Ed. 582. * * * *Elgin Natl. Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 673; 45 L. Ed. 378.

In *ex parte Wolverine Mfg. Co.*, C. D. 1910, 41, the word "Cadillac" was refused registration as it had a geographical significance, it being the county seat of Wexford County, Michigan, and also of a town in France.

> "Whatever may be applicant's right to the mark under the doctrine of unfair competition, he has under well-settled law no right to its

registration as a trade-mark." (Quoting from *Ex parte Francis D. Moulton & Co.*, 70 Mss. Dec. 420.)

"Upper Hudson" (geographical), *Van Alstyne vs. Boutwell Milling Co.*, 43 App. D. C. 530; "Hudson Mills" (geographical) *ex parte Lax & Bugheimer*, 120 Ms. Dc. 291, Aug. 30, 1916.

"Howard" is the county seat of Elk County, Kansas; also county seat of Miner County, South Dakota; it is a town in Pennsylvania, Missouri, Michigan, Kansas, Colorado, Georgia, North Carolina, Ohio, New York and other states. There are Howard counties in Indiana, Iowa, Missouri, Maryland, Texas and perhaps in other states (see U. S. Census, 1910).

The association of a registrable word or symbol with a geographical term does not make the combination registrable. *Ex parte Ely & Walker Dry Goods Co.*, C. D. 1910, 130.

The Baldwin Company's Title to Registration No. 31,411 Entirely Fails.

The Baldwin Company claims its title and rights to Mark No. 31,411 and to the name "Howard" as a mark for pianos, solely from and through The Valley Gem Piano Company, claiming that The Valley Gem Piano Company adopted and first began to use the name "Howard" as a mark or brand for pianos in December, 1896, and that The Valley Gem Piano Company continued to use this name and mark for pianos continuously until December, 1901, at which time the rights of The Valley Gem Piano Company were assigned and transferred to The Baldwin Company. The Baldwin Company claims to have used the name "Howard" as a mark or brand for pianos continuously

ever since said assignment and transfer to it from The Valley Gem Piano Company; that is, since about January 1, 1902. (See Answer in Cancellation No. 302, paragraphs "1," "8" and "11"; Record, pp. 1086, 1090, 1095; "Confirmatory Assignment," The Howard Piano Company to The Baldwin Company, dated September 22nd, 1914, Rec., p. 1182.)

The Baldwin Company makes no claim to Mark No. 31,411, or to the name "Howard" as a mark for pianos, in any of the pleadings or testimony, EXCEPT AS THE ASSIGNEE AND SUCCESSOR OF THE VALLEY GEM PIANO COMPANY. We quote the following from the record in support of the foregoing:

In its complaint in the equity action in the United States District Court, The Baldwin Company alleged, in paragraph marked III (Rec., p. 2600):

> "That in or about the year 1896 The Valley Gem Piano Company * * * began to manufacture, * * * high-grade, medium-priced or commercial pianos and on or about the 15th day of December, 1896, and in advance of all others, devised, originated, appropriated, adopted, applied and used as a trade-mark for its said pianos, manufactured and sold by it, the name 'Howard'; * * *."

And in said complaint, paragraph IV (Rec., p. 2601):

> "That at the time of the adoption of the trade-mark 'Howard' by The Valley Gem Piano Company, as aforesaid, * * * The Valley Gem Piano Company had the legal right to appropriate and use the name 'Howard' as a trade-mark for pianos, and your orator, as its successor in business has the exclusive right to use the name 'Howard' as its lawful trade-mark for pianos manufactured and sold by it."

Registrants' Title to Registration No. 31,411 Fails.

In said complaint in equity, paragraph VI (Rec., p. 2601), The Baldwin Company alleged that in December, 1901, The Valley Gem Piano Company transferred to The Baldwin Company its business, assets and good will, together with the trade-mark "Howard," and that by virtue of such assignment The Baldwin Company is now the owner of such trade-mark.

In Cancellation No. 302, the answer contains the following:

(Rec., p. 1085):

> "1. That The Baldwin Company * * * is the owner of the trade-mark registered in the United States Patent Office on March 8th, 1898, certificate of registration No. 31,411, consisting of the word 'Howard' for pianos, by virtue of a general assignment on or about the 6th day of December, 1901, from The Valley Gem Piano Company to The Baldwin Company * * *."

(Rec., p. 1090):

> "8. Further answering, this respondent alleges that in or about the year 1896 or 1897, The Valley Gem Piano Company began to manufacture a high-grade, cheap piano, and desiring to identify and distinguish its said pianos * * * did, on or about the 15th day of December,1896, and in advance of all others, devise, originate, appropriate, adopt, apply and use as a trade-mark for the said pianos manufactured and sold by it, the word 'Howard' printed in distinctive, ornamental type, resembling Old English, * * * which word was accompanied by the initials 'VGPCo.' of The Valley Gem Piano Company, in the form of a monogram; and that * * * The Valley Gem Piano Company on the 15th day of November, 1897, * * * filed * * * an application for the registration of said trade-mark * * *."

(Rec., p. 1092):

> "9. That * * * said pianos became known to the public by the trade-mark 'Howard' solely through the manufacture of The Valley Gem Piano Company which was continued until said company was succeeded by The Baldwin Company, as hereinafter set forth, and the said trade-mark indicated the manufacture of said The Valley Gem Piano Company to the trade * * * , the said The Baldwin Company being the owner of the trade-mark 'Howard' for pianos, by virtue of an assignment thereof including the business and good will from The Valley Gem Piano Company, * * *."

(Rec., p. 1095):

> "11. Further answering, this respondent says that the trade-mark 'Howard' for pianos has been continuously used by The Valley Gem Piano Company and its successor in business, The Baldwin Company, in interstate and foreign commerce, from the 15th day of December, 1896, down to and including the present time, said trade-mark having been duly assigned, transferred and conveyed by The Valley Gem Piano Company to The Baldwin Company on the 6th day of December, 1901, by a general conveyance of all the business of The Valley Gem Piano Company to The Baldwin Company * * *."

In Cancellation No. 301, the answer of The Baldwin Company contains the following (Rec., p. 1055):

> "8. Further answering, this registrant, The Baldwin Company, alleges that, in or about the year 1896 or 1897 its predecessor in business, The Valley Gem Piano Company, began to manufacture a high-grade, cheap piano, and desiring to identify and distinguish its said pianos * * * did, on or about the 15th day of

> December, 1896, and in advance of all others, devise, originate, appropriate, adopt, apply and use as a trade-mark for the said pianos manufactured and sold by it, the word 'Howard' printed in distinctive, ornamental type, resembling Old English * * * which word was accompanied by the initials 'VGPCo.' of The Valley Gem Piano Company in the form of a monogram * * *."

The answer, in Cancellation No. 301 then recites application to register and registration of the Mark No. 31,411, annexes a specimen of the mark to the answer, and alleges that the pianos bearing the mark were manufactured by The Valley Gem Piano Company. Also the following (Rec., p. 1058):

> "9. That * * * said pianos became known to the public by the trade-mark 'Howard' solely through the manufacture of The Valley Gem Piano Company which was continued until said company was succeeded by The Baldwin Company, as hereinafter set forth, and the said trade-mark indicated the manufacture of said The Valley Gem Piano Company to the trade * * *, the said The Baldwin Company being the owner of the trade-mark 'Howard' for pianos, by virtue of an assignment thereof, including the business and good will from The Valley Gem Piano Company * * *."

(Rec., p. 1061):

> "11. Further answering this registrant says that the trade-mark 'Howard' for pianos has been continuously used by The Valley Gem Piano Company and its successor in business, The Baldwin Company, in interstate and foreign commerce, from the 15th day of December, 1896, down to and including the present time, said trade-mark, together with the business and good will of the business in connection

> with which the same has been used, having been duly assigned, transferred and conveyed by The Valley Gem Piano Company to The Baldwin Company."

The following is from the affidavit verified May 22nd, 1915, contained in the File Wrapper and contents of application to register mark No. 46,993 (Rec., p. 20):

> "Lucien Wulsin, being duly sworn, deposes and says, that he is president of The Baldwin Company, the applicant in the above-named application for the registration of the word 'Howard' as a trade-mark for pianos: that he was president of The Valley Gem Piano Company when that corporation adopted the said trade-mark and applied it to pianos and used it continuously until the good will, business and trade-mark of The Valley Gem Piano Company were transferred to and became the property of The Baldwin Company."

The Baldwin Company, in its petition verified the 14th day of April, 1915, filed in Cancellation No. 301, said:

> "1. That it is the owner of the trade-marks consisting of the word 'Howard' for pianos, which were registered in the United States Patent Office by its predecessor in business, The Valley Gem Piano Company, on May 8th, 1898, Certificate of Registration No. 31,411, and subsequently registered in its own name on October 17th, 1905, Certificate of Registration No. 46,993."

In its proofs in these proceedings, The Baldwin Company claims title to No. 31,411 by virtue of a transfer of the Valley Gem Piano Company to R. N. Jenkinson in December, 1901, and an alleged acceptance of the transfer by Jenkinson to The Baldwin

Company under date of December 31, 1901 (Rec., pp. 1166-76; Sargent's testimony, Qs. 164, 166, pp. 1270-1).

In contradiction of this, Mr. Armstrong, petitioner's president, testifies that the only transfer made by The Valley Gem Piano Company to The Baldwin Company was the transfer or taking over in December, 1901, by The Baldwin Company of all the stock of The Valley Gem Piano Company from the individual members of the firm of D. H. Baldwin & Co., each of whom owned one-fifth, which The Baldwin Company still owns (Rec., pp. 2394-5, XQs. 130-135).

Mr. Armstrong also testified that, after this alleged transfer or "taking over" of the stock of The Valley Gem Piano Company by The Baldwin Company, The Valley Gem Piano Company did no further business and has never done any since (Rec., pp. 2389-93, XQs. 91-118; see also McGee's testimony, Rec., pp. 1202-3, XQs. 169-171).

R. N. JENKINSON, called as a witness by The Baldwin Company, testified that he has no recollection of making the payments mentioned in these paper transfers. He testified (Rec., p. 1666):

"XQ10. If you paid any such considerable sum, you would be likely to remember it, wouldn't you? A. It seems to me I would, but I have no recollection whatever."

This testimony of registrants' officers clearly shows that the documentary matter put in evidence by The Baldwin Company respecting an alleged assignment or transfer of the property of The Valley Gem Piano Company through Jenkinson to The Baldwin Company, *if made*, was a mere sham.

Even though there were such a paper transfer, it was *in gross*, as The Valley Gem Piano Company had nothing to transfer, no goodwill, no business; at no time had it ever done any business.

Under this state of facts, The Baldwin Co.'s title to the mark No. 31,411 absolutely fails.

Standard Brewing Co. vs. Interboro Brewing Co., 229 Fed. C. C. A. 543, 2nd Circuit.
Eiseman vs Schiffer, 157 Fed. 473.
Folk vs. Am. West Indies Co., 180 N. Y. 455.
Detroit Creamery Co vs. Velvet Brand Ice Cream Co., 153 N. W. 664.
Lea vs. New Home Sewing Mach. Co., 139 Fed. 732.

The Mark, No. 31,411, Has Been Abandoned.

The testimony of George W. Armstrong, Jr., petitioner's president, and Levi D. Sargent, one of petitioner's directors, and connected with registrants and its allied concerns since 1893 (quoted below), shows by registrants' own witnesses that the mark No. 31,411 has been abandoned.

I quote from the testimony of Levi D. Sargent, one of The Baldwin Company's officers in charge of the manufacturing and shipping, from the testimony of Frank A. McGee, The Baldwin Company's auditor, and from the testimony of George W. Armstrong, Jr., The Baldwin Company's president:

LEVI D. SARGENT testified (Rec., p. 761):

"Q9. I show you Registrants' Exhibits 26, 27, 37, 38, 39, 40, 41 and 42, and ask you which of those exhibits you are now using in marking pianos? A. No.

26 is now being used on Howard pianos of our manufacture; No. 40 is an impression of same; No. 27 is also being used, of which No. 42 is an impression."

(Registrants' Exhibit No. 40 is a reproduction, transferred to cardboard, of Registrants' Exhibit No. 26; Registrants' Exhibit No. 42 is an impression of Registrants' Exhibit No. 27; Registrants' Exhibit No. 39 is an impression of Registrants' Exhibit No. 37; Registrants' Exhibit No. 41 is an impression of Registrants' Exhibit No. 38; all these markings are reproduced *infra*, pp. 93-6. The above markings, The Baldwin Company's officers testify were the only markings ever used for "Howard" pianos. Rec., pp. 1238, Qs. 35, 36, 40, 41; pp. 1277, 1279, Qs. 186, 189; pp. 1306-7, Qs. 264, 265.)

"Q10. These are the only ones that are being used at the present time on the fall-board of pianos? A. On the fall-board of pianos these two are being used at the present time.

"Q11. I asked you if those are the only ones? A. To the best of my recollection they are the only ones being used at the present time.

"Q12. How long have you been using transfers like Registrants' Exhibit No. 40? A. Why, we have been using transfers like Exhibit No. 40 practically since 1896, except that the size of letter and the space covered has been reduced.

"Q13. Did the transfers similar to Registrants' Exhibit No. 40, which you used in 1896, have the monogram 'HPCo.' on? A. No, the monogram was changed when the style of the corporation was changed.

"Q14. And when you changed the name of the corporation, did you change the marking on the fall-board

from the monogram 'VGPCo.' to 'HPCo.'? A. The monogram was changed just as soon as we could have designs submitted and transfers made.

"Q15. And you ceased to use the marking 'VGPCo.' on it at that time? A. Yes, sir.

"Q16. And never used it any since, on the fall-board? A. Not unless there happened to be some old ones around when the men would get hold of them, not knowing it; there may have been a few used, but none to my knowledge.

"Q17. Did you use the monogram 'VGPCo.' on any other part of the piano after you changed the name of The Valley Gem Piano Company to The Howard Piano Company? A. No, the monogram 'VGPCo.' was not used after that.

"Q18. When did you begin to use the transfers like Registrants' Exhibit No. 42? A. At the time we brought out our player called the 'Manualo,' and the name 'Manualo' having been duly registered by The Baldwin Company, it was combined with the trade-mark 'Howard 'and used on the fall-board of the Howard Manualo, which is a player piano.

"Q19. When was that change made? A. I would be unable to give you the exact date, but to the best of my recollection I would say possibly 1912.

"Q20. Or thereabouts? A. Yes.

"Q21. Since that time you never used the monogram on the Howard player piano? A. Not on the player piano."

FRANK A. MCGEE testified (Rec., p. 1201):

"Q162. State, if you know, what wording appears upon the fall-board of the Howard pianos which are now being manufactured? A. The word 'Howard,'

a little monogram, 'HPCo., Cincinnati-Chicago,' the monogram formerly of The V. G. P. Co., Cincinnati-Chicago, and my impression is that before it was only the word 'Cincinnati.'

"Q163. What do the letters 'HPCo.' mean or for what name do they stand as at present used? A. The Howard Piano Co.

"Q164. State, if you know, how long the present form of transfer with the monogram 'HPCo.' has been in use? A. Just as soon as we could secure the transfer from the manufacturer after The Valley Gem Piano Co. name was changed to The Howard Piano Co. We may have used some of the old Valley Gem Piano Co. transfers even after the receipt of the new transfers in order to use up the old ones or to secure a better quality or design of transfer with the initials, 'HPCo.'"

GEORGE W. ARMSTRONG, JR., testified (Rec., p. 2399):

"XQ173. When was it that you discontinued the initials V. G. P. Co.? A. I don't recall.

"XQ174. Well, ten years ago or five years ago, or when? A. I don't recall. I haven't the faintest recollection.

"XQ175. But you don't use that any more? A. No.

"XQ176. You abandoned that? A. Yes.

"XQ177. And it has been several years since you have used them? A. I don't recall when the date was.

"XQ178. When you changed the name of the Valley Gem Company to the Howard Piano Company, didn't you abandon the initials V. G. P. Co.? A. I suppose so; that would be the most natural thing to do.

"XQ179. When you did discontinue it you didn't intend ever to take it up again? A. The V. G. P.—no."

"Howard" Not Displayed in the Registration in a Particular or Distinctive Manner.

The Court of Appeals of the District of Columbia has repeatedly stated its interpretation of what constitutes a display in a "particular or distinctive manner," as required by Section 5 of the Trade-Mark Act of 1905, as follows:

> "The scope of the statute is well defined in *ex parte Polar Knitting Mills*, 154 Off. Gaz. 251, as follows: 'It is believed that the controlling principle underlying the requirement of the statute that a mere name, unless written or printed in a distinctive manner, may not be registered, is that the distinctive manner in which the name is displayed must be of a character as to give such a distinctive impression to the eye of the ordinary observer as to outweigh the significance of the mere name.' This rule was approved *in re Artesian Mfg. Co.*, 37 App. D. C. 113. We think the mark in question comes clearly within the prohibition of the act, and falls short of meeting the conditions of the rule above stated." *Oliver Plow Works vs. W'm. J. Oliver Mfg. Co.*, 40 App. D. C. 125.

Registration No. 46,993; Name "Howard" Not Registrable.

The Trade-Mark Act of 1905 (Section 5), expressly prohibits registration of a proper name except under conditions not existing in the cases at bar. *Howe*

Scale Co. vs. Wyckoff, etc., 198 U. S. 118; *Merriam Co. vs. Syndicate Pub. Co.*, 237 U. S. 618; *Thad. Davids vs. Davids Mfg. Co.*, 233 U. S. 461; *Planten vs. Gedney*, 224 Fed. (C. C. A.) 382; *in re Spalding & Bros*, 27 App. D. C. 314.

Registration No. 46,993, Based Upon, and Reregistration of Registration No. 31,411; as Title to No. 31,411 Is Fatally Defective, Title to No. 46,993 Entirely Fails.

The File Wrapper and contents of Registration No. 46,993 shows that in the original application papers, the statement and drawing of No. 46,993 was substantially identical with the statement and drawing of Registration No. 31,411.

As further shown by the pleadings and the petitions already cited, Registration No. 46,993 was based upon the adoption and use of the mark by The Valley Gem Piano Company; that is, upon the mark No. 31,411, and as a reregistration of No. 31,411.

Reference to the File Wrapper and contents of No. 46,993 (Rec., pp. 16-23) shows that in the original application to register this mark, the mark was described substantially the same as in No. 31,411, "and consists of the arbitrary word 'Howard' in connection with the initials 'VGPCo.' in the form of a monogram." This is followed by a description substantially verbatim to that contained in the statement in Registration No. 31,411, including the following phrase: "The form of lettering of Howard may be differently arranged without materially altering the character of the trade-mark the principal feature of

which is the word 'Howard.'" Use is claimed from the same date as claimed in No. 31,411 (Dec. 15, 1896).

Registration of No. 46,993 was refused on the ground, among others, of prior Registration No. 31,411. Whereupon an affidavit of Lucien Wulsin (then president of The Baldwin Company, and formerly president of The Valley Gem Piano Company), verified May 22nd, 1905, was filed and made a part of the application papers (see File Wrapper, Rec., p. 20), and registration requested on the ground that The Baldwin Company was the assignee of the word "Howard" as a trade-mark from The Valley Gem Piano Company, the affidavit stating and claiming that The Valley Gem Piano Company adopted, applied and used the mark until it transferred the same to The Baldwin Company (which was a false statement).

Application Papers in Registration No. 46,993 Irregular and Registration Improperly Allowed.

The original drawing in the Application No. 46,993 was identical with the drawing in Registration No. 31,411, and the drawing was changed in a material manner without a new declaration; this was improper and without authority of law. *Ex parte Newman*, C. D. 1910, 194.

The statement was also materially modified and changed without a new declaration; such changes were without authority of law. *Ex parte Felten & Guilleaume-Lahmeyerwerke Actien-Gesellschaft*, C. D. 1910, 7.

"He can register only what he has used." *Elgin Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 665; *Kohler Mfg. Co. vs. Beeshore*, 57 Fed. (C. C. A.) 572.

The Baldwin Company or Its Predecessor Never Used "Howard" Without the Monogram "VGPCo." Prior to 1912, and Its Registration of "Howard" in 1905, Was Obtained by a False Statement and Declaration.

The evidence (as already set forth in detail) shows that The Valley Gem Piano Company never made, marked, sold, dealt in, or dealt with, pianos in any manner, or did any business of any kind. Under such circumstances it could have no trade-mark to transfer, and any attempted transfer by it would transfer nothing. *Standard Brewing Co. vs. Interboro Brewing Co.*, 229 Fed. (C. C. A.) 543.

The evidence already recited also shows that the statement in the application to register No. 46,993 was untrue in that there had been no use of the trade-mark by The Baldwin Company of The Valley Gem Piano Company from December, 1896, and no use by any Baldwin concern *in any event*, until 1912.

The evidence further shows that whatever mark or marks (containing the name "Howard") were used by any of the Baldwin concerns, at any time prior to the application to register No. 46,993, was not the name "Howard," but the name "Howard" in conjunction with the initials "VGPCo.," arranged monogrammatically. This is the testimony of the witnesses (registrants' officers) and by the "transfers" produced by registrants' officers as samples of the markings put on the pianos, as well as the "stencils" used (as testified by registrants' officers), for marking the

boxes in which the pianos were packed. There is not a line of evidence that the name "Howard" without the monogram "VGPCo." was ever used on pianos by any of the Baldwin concerns at any time prior to the year 1912. In further proof of this, attention is requested to the specimen "transfer" annexed to the answer in Cancellation No. 302 (Rec., p. 1064); to the several registrants' exhibits of "transfers" which the Baldwin concerns claim to have used (*infra*, p. 93-6).

There Was Never Statutory Use of Mark No. 46,993 Prior to the Application to Register Same, or Prior to 1912.

This testimony, given by officers of, and witnesses called by The Baldwin Company, shows conclusively that all "transfers" and "stencils" for marking "Howard" pianos and piano boxes were, prior to 1912, "Howard" with the monogram "VGPCO.," and the name of the City "Cincinnati," and not "Howard" alone, or "Howard, *simpliciter*." This shows failure of statutory use of "Howard" alone, and if these facts had been known to the Commissioner he should have refused the registration (No. 46,993) on that ground.

Elgin Watch Co. vs. Illinois Watch Case Co., 179 U. S. 665.

Kohler Mfg. Co. vs. Beeshore, 57 Fed. (C. C. A.) 572.

> "Statutory use of the mark is a prerequisite to the right of registration * * * having described and shown one thing, he cannot, when the exigencies of the situation demand, limit his claim to a particular feature of the original

mark. *Johnson vs. Brandau*, 32 App. D. C. 348. * * *

"In other words, proof of the use of the words, 'Planten's C. & C. or Black Capsules' in the case where those words have been registered as a trade-mark, does not establish the use of the words, 'Black Capsules' as a trade-mark, for the words eliminated from the registered mark are, under the prior application an essential part of that mark.

"There being no evidence in the record of statutory use of the words, 'Black Capsules' as a trade-mark by Planten, the Commissioner should have refused registration to Planten on that ground."

Planten vs. Canton Pharmacy Co., 33 App. D. C. 268.

In *Quaker City Flour Mills Co. vs. Quaker Oats Co. et al.*, 43 App. D. C. 260, it was held that registration of the word "Quaker" could not be had on proof of the use of "Quaker City Mills" or "Quaker City."

In re Motz Tire & Rubber Co., 40 App. D. C. 487, the Court said:

> "We think that the law requires that the mark applied for must be the same as the mark shown to have been used. To hold otherwise would permit appellant, in this instance, to convert a mark which the statute prohibits from being registered, because of its geographical insignification, into a technical trade-mark by eliminating the word which makes it geographical while the geographical term is the one which has actually been used. The law will not permit that which it expressly prohibits to be legally accomplished by indirect methods."

In *Corbin vs. Gould*, 133 U. S. 308, complainants had registered a mark "the essential features of

which are the symbol of a diamond and the arbitrary selected word 'Tycoon.'" Defendant used "Tycoon" as a part of his label, which was shown to be a word commonly used in the tea trade.

> "The trade-mark for tea (No. 9952) registered in the Patent Office by plaintiff's predecessor, was for the combination of the figure of a diamond and the words 'The Tycoon Tea' enclosed in it; and its registration conferred no exclusive right to the use of the word 'Tycoon' considered by itself." Headnote to *Corbin vs. Gould*, 133 U. S. 308.

In *Richter vs. Reynolds*, 59 Fed. (C. C. A.) 577, the Court held that complainant was limited to what was claimed in his application to register, and was not entitled to something different; that the use of one device is not the use of a different device, or the same device with additions or subtractions. In his application to register his trade-mark under the Act of 1881, complainant declared (as stated by the Court):

> "'The essential feature of which is the representation of a red anchor in the oval space.' As evidence tending to show what was really claimed or had been intended to be appropriated, the Court below was clearly right in taking this into consideration; and, in our opinion, it was right, also, in concluding therefrom that the complainant's intention was to confine his claim of trade-mark to the specific device designated and described, and which he further declared to be one which he had 'adopted.' Upon both the grounds which have been discussed, the complainant's claims to the word 'anchor,' and to the symbol of an anchor, irrespective of its being red, and enclosed in an oval space, were properly rejected."

In *Kohler vs. Beeshore*, 59 Fed. 572, the Court affirmed the doctrine of *Richter vs. Reynolds*, 2 Fed. 455; affirmed 59 Fed. 577, which in turn referred with approval to *Kohler Mfg. Co. vs. Beeshore*, 59 Fed. 572.

Business History of R. S. Howard Co.

R. S. Howard Company was organized as a New York corporation in April, 1902; succeeded to the business, goodwill and name of Robert S. Howard, acquired a factory in New York City, and began the manufacture and sale of pianos marked "Howard," "R. S. Howard Co.," commonly called "Howard" pianos (Rec., p. 200, Qs. 5-8; p. 248, XQs. 203-5; p. 251).

Robert S. Howard's Business History.

1877 to 1889: Robert S. Howard became a piano salesman in 1877 and continued until 1889 to sell pianos, at retail on his own account and at wholesale in the principal cities of the United States as representative of leading piano manufacturers, such as John Church & Co., Cincinnati; Chickering & Sons, of Boston; Hallett & Comston, of Boston; Sohmer & Company, of New York; during this period he became proficient in piano tuning, piano tone regulating, piano action regulating, the details of piano manufacture, and a practical piano manufacturer (Rec., p. 173, Q124; p. 2417, Qs. 81, 82; p. 85, XQ140; p. 201, Qs. 12, 13).

August, 1889, to December 31st, 1892: In August, 1889, Robert S. Howard became connected with the New England Piano Company, of Boston, one of the largest piano manufacturing concerns in the country, and continued this connection until December 31,

1892. At the outset of his connection with the New England Piano Company, Mr. Howard spent some time about their factory suggesting improvements in construction, methods of manufacture, design, etc., and arranged to have pianos manufactured by that concern marked with his own name "Howard" (Rec., p. 203, Qs. 15, 16), "it was a part of the arrangement" (Rec., p. 2409, Q34). These "Howard" pianos, in addition to the regular lines of the New England Company, Mr. Howard sold to his trade, old customers and acquaintances in the piano business throughout the United States and Canada (Rec., p. 204, Qs. 17, 18).

These pianos were marked, beginning in 1889, "Howard, New York," "R. S. Howard & Co., Boston," also "Howard & Co., Boston," beginning in 1893 (Rec., pp. 190-193, Qs. 6-21).

January 1, 1893, to 1896: Robert S. Howard was connected with J. & C. Fischer, piano manufacturers, of New York, selling their product all over the United States, and also selling "Howard" pianos for his own account and risk, made by the New England Piano Company (Rec., pp. 206-208, Qs. 30-36; pp. 2481-2, XQs. 223-230). These "Howard" pianos were supplied to Mr. Howard at a fixed factory price, Mr. Howard guaranteeing payment for same and receiving the difference between the factory price and the price at which he sold them (Rec., pp. 206-208, Qs. 30-36; pp. 2481-2, XQs. 220-223). These "Howard" pianos were sold by Mr. Howard in the principal cities of the United States (Rec., p. 2409, Q33; p. 2425, XQs. 132-138; p. 2494, Q60; Applicant's Exhibit 112, Rec., pp. 786-792; p. 2523, XQs. 245-252; p. 476, Q53; p. 529, Qs. 11-13).

Judge Hough finds that

> "there were thousands sold under the title 'R. S. Howard & Co.,' 'Howard, New York,' 'Howard & Co., Boston,' and 'R. S. Howard & Co., Boston' " (Rec., p. 2636, fol. 2713).

Judge Hough also finds:

> "No other salesman except Howard sold pianos with the 'Howard' mark upon them. * * * There is no doubt that from the time any variant of 'Howard' was inscribed upon pianos, the retail trade, the user and the public generally spoke of them as 'Howard' pianos." * * * (Rec., p. 2636, fol. 2712).

The New England Piano Company never claimed to own the mark or brand "Howard" for pianos, but, on the contrary, recognized that it belonged to Robert S. Howard. (Rec., p. 2455, Qs. 63-64; p. 154, Qs. 41, 42; p. 2422, Q111; p. 2030, Q10; p. 2043, XQs. 88, 89).

In 1896 the New England Piano Company became financially embarrassed and stopped the manufacture of all pianos for about a year and a half (Rec., p. 207, Q. 34; p. 268, XQ. 302; p. 2414, Qs. 61-63; p. 2421, Qs. 107-10; p. 2451, Qs. 38-46; p. 2477, XQs. 198-200; p. 96, RDQs. 224-226; p. 2495, Qs. 67-77; p. 2537, XQs. 335-339).

The record contains the testimony of forty-eight witnesses who knew about or dealt in "Howard" pianos sold by Robert S. Howard and R. S. Howard Company, all of whom testified that such pianos were always known and designated as "Howard" pianos. Thirty-five of these witnesses sold or handled pianos marked "Howard" (either "Howard," "R. S. Howard & Co." or "Howard & Co.") bought from Robert S. Howard PRIOR TO 1896. The following are the

names of these witnesses: Leander S. Sherman, San Francisco, Cal. (Rec., p. 465); Frank T. Bowers, Belvedere, Cal. (Rec., p. 502); Erastus P. LaSalle, Richmond, Cal. (Rec., p. 521); Frank Anrys, San Francisco, Cal. (Rec., p. 528); Joseph E. Whitney, Portland, O. (Rec., p. 537); Frank J. Hart, Los Angeles, Cal. (Rec., p. 442); A. G. Bartlett, Los Angeles, Cal. (Rec., p. 456); I. W. Gardner, Los Angeles, Cal. (Rec., p. 392); J. F. Sayler, Los Angeles, Cal. (Rec., p. 400); Edward A. Geissler, Los Angeles, Cal. (Rec., p. 360); F. W. Blanchard, Los Angeles, Cal. (Rec., p. 417); Geo. S. Marygold, Los Angeles, Cal. (Rec., p. 431); Wm. S. Lanneau, Charleston, S. C. (Rec., p. 310); John F. Greer, Charleston, S. C. (Rec., p. 328); Platt P. Gibbs, Chicago, Ill. (Rec., p. 580); Orvin L. Fox, Chicago, Ill. (Rec., p. 568); Joseph A. Stewart, Atlanta, Ga. (Rec., p. 698); Charles A. Schlichter, Burlington, Ia. (Rec., p. 599); James Vaughan, Detroit, Mich. (Rec., p. 733); Edwin A. Kieselhorst, St. Louis, Mo. (Rec., p. 771); Benjamin B. Crew, Atlanta, Ga. (Rec., p. 1861); John E. Mulvey, Boston, Mass. (Rec., p. 1986); Noble E. Hill, Boston, Mass. (Rec., p. 2016); J. H. Brenner, San Francisco, Cal. (Rec., p. 2092); Charles H. Dewing, Oakland, Cal. (Rec., p. 2109); George A. Heidinger, Portland, O. (Rec., p. 2182); Fergus Coalter, Salt Lake City, Utah (Rec., p. 2204); William B. Turlington, Jr., Baltimore, Md. (Rec., p. 628); George B. Kennedy, Washington, D. C. (Rec., 650); Percy S. Foster, Washington, D. C. (Rec., p. 678); William C. Dierks, Pittsburgh, Pa. (Rec., p. 612); George J. Dowling, Chicago, Ill. (Rec., p. 592); Sheridan Daboll, Rochester, N. Y. (Rec., p. 99); William P. Bubel, Rochester, N. Y. (Rec., p. 861); Benjamin S. Wise, New

York City (Rec., p. 106); Frederick G. Howe, Springfield, Mass. (Rec., p. 124); Arthur A. Sternberger, Philadelphia, Pa. (Rec., p. 137); Frederick A. Hindermister, Scranton, Pa. (Rec., p. 194); Herbert G. Reed, Portland, O. (Rec., p. 548); Hjalmar J. Carlson, Denver, Colo. (Rec., p. 559); George W. Markens, Brooklyn, N. Y. (Rec., p. 118); John L. Stowers, Havana, Cuba (Rec., p. 688); Thomas F. Scanlan, Boston, Mass. (Rec., pp. 67, 2446); George J. Mulcahy, Boston, Mass. (Rec., pp. 145, 2406); William J. Simonson, Ann Arbor, Mich. (Rec., p. 706); George J. Husbands, Boston, Mass. (Rec., p. 2028); Walter L. Ishelman, St. Joseph, Mo. (Rec., p. 2249); Robert S. Howard, New York City (Rec., pp. 200, 2487).

Beginning in December, 1896, Mr. Howard testifies that he obtained "Howard" pianos on the same general plan and basis from D. H. Baldwin & Company of Cincinnati; these pianos were made by The Ellington Piano Company of Cincinnati, O.

1896 to December 31, 1898: Robert S. Howard continued with J. & C. Fischer, as before, up till January 1st, 1898, and then with the Schuberts and Sohmer & Company, piano manufacturers, till December 31, 1898; during all this period Robert S. Howard continued to sell "Howard" pianos on his own account and risk made by The Ellington Piano Company, Cincinnati, Ohio, and furnished to him at a fixed factory price, under an arrangement similar to that which he had with the New England Piano Company (Rec., pp. 2496-9, Qs. 79-93; p. 2527, XQs. 266-270; p. 2529, XQs. 276-278; p. 206, Qs. 30-39; pp. 2502-03, Qs. 127-131).

Robert S. Howard had no connection or business arrangements of any kind with D. H. Baldwin &

Company or any of its allied concerns, except the arrangement respecting these "Howard" pianos, until January 1, 1899; up to January 1, 1899, he was still employed by the Fischers, Schuberts and Sohmer & Co., selling "Howard" pianos on the side. All "Howard" pianos made by the Baldwin concerns for a number of months after Mr. Howard made his arrangements with them were sold by Mr. Howard; after several months stray "Howard" pianos began to be sent from time to time to the retail stores of D. H. Baldwin & Co. Mr. Howard's letters and orders in evidence (Applicant's Exhibit 117 and Registrants' Exhibit 229) show that the prices at which Mr. Howard sold these "Howard" pianos were fixed by Mr. Howard and varied as between different dealers, and the books of the Ellington Piano Co. show that he was credited with the difference between the fixed factory price and his selling prices, varying from $2.50 to $15.00 per piano (Registrants' Exhibit 31, Rec., pp. 1348-51).

January 1, 1899, to March 31, 1902: Beginning January 1, 1899, Robert S. Howard was associated with D. H. Baldwin & Co. selling their several grades of pianos under a salary, expense and profit-sharing agreement, whereby the several grades of pianos of the Baldwin concerns were supplied at fixed factory prices, and Mr. Howard's business kept in a separate account. Mr. Howard received a salary and expense account and a large exclusive territory. After the profits earned equalled the salary and expense account, Mr. Howard was to receive all profits up to $1,700, and also a percentage of all profits after that amount had been earned. The selling arrangement covering the "Howard" pianos was placed in a separate paragraph of the contract, Mr. Howard retaining the ex-

clusive territory of the whole United States for "Howard" pianos *"excepting"* a certain limited territory in the Central West, immediately contributory to D. H. Baldwin & Co.'s retail stores. The factory prices of the different makes of pianos were changed from time to time, the selling price of all grades of the pianos was fixed by Mr. Howard, and the account was charged with all bad debts. The agreement is printed Rec., pp. 1065-1070, and was terminated by Mr. Howard, according to its terms, on March 31, 1902 (Rec., pp. 2498-9, Qs. 92, 93).

April, 1902, to the present time: Robert S. Howard organized the R. S. Howard Company in April, 1902, became its president, general manager and active executive head, and has continued as such to the present time. This company forthwith acquired a complete piano factory in the City of New York, and also the business, good will, trade-name and trademarks of Robert S. Howard, and immediately after its organization began the manufacture of pianos which were marked "Howard" and "R. S. Howard Co." on their fallboards; this company has continued the manufacture of pianos continuously since 1902, which have been sold in the principal cities of the United States from the Atlantic to the Pacific, north and south, and also in a long list of foreign countries (Rec., pp. 2498-2500, Qs. 91, 94, 105; p. 200, Qs. 2-8; p. 2121, Q59; p. 119, Q10; p. 122, XQs. 27-33).

The Patent Office Decisions in These Proceedings Were Based Solely on the Ground that Appellant Had Failed to Show that It Was Damaged.

The Court of Appeals of the District of Columbia reversed the decisions of the Patent Office. The Patent Office erred, in that it failed to distinguish between unfair competition rights (that is, rights under the common law), and the rights, remedies and penalties under the statutes pertaining to trade-mark registrations.

The test applied by the Patent Office was erroneous, and *directly* in conflict with the following decisions of the Court of Appeals of the District of Columbia:

Battle Creek Sanitarium Co. vs. Fuller, 30 App. D. C. 411.
American Stove Co. vs. Detroit Stove Works, 31 App. D. C. 304.
Kentucky Dist. & Wareh. Co. vs. Old Lexington Club Dist. Co., 31 App. D. C. 223.
In re Hoff, 33 App. D. C. 233.
Rookwood Pottery Co. vs. Wilhelm Co., 43 App. D. C. 1.
Nairn Linoleum Co. vs. Ringwalt Linoleum Works, 46 App. D. C. 64.
Goodrich Drug Co. vs. Cassada Mfg. Co., 46 App. D. C. 146.
Nofziger vs. Schulze Baking Co., 46 App. D. C. 292.
Re Estate of P. D. Beckwith, Inc., 252 O. G. 245.
Williams vs. Kern & Sons, 47 App. D. C. 441.

"Interest in the Subject-Matter."

"Likelihood of Confusion," "Facts From Which Damage May Be Inferred," or "the Mere probability of Confusion" Is Sufficient "Interest in the Subject-matter" to Sustain Cancellation Proceedings.

It is not necessary to *prove* actual damage.

> "It is sufficient if injury to the plaintiff's business is threatened or imminent." *T. A. Vulcan vs. Myers*, 139 N. Y. 364, 367; *Mfg. Co. vs. Trainer*, 101 U. S. 51.

"One who can show an interest in the subject-matter entitling him to claim that he would be damaged by the registration"; facts "from which damage might be inferred"; "the likelihood of confusion"; "the mere probability of confusion is sufficient."

In *Rookwood Pottery Co. vs. Wilhelm Co.*, 43 App. D. C. 1, the Court said:

> "The statute is prospective, in that it forbids the registration of a mark which is *likely* to create confusion in the public mind, *or* is *likely* to deceive purchasers. It is not necessary that actual confusion be shown; the mere probability of confusion is sufficient." Italics are by the Court.

In *Nofsiger vs. Schulze Baking Co.*, 46 App. D. C. 292, "Butter-Cream" for bread was opposed by owners of "Butter-Nut" and "Butter-Krust" for bread, the Court said:

> "There is no testimony as to any actual confusion in trade, by reason of the opposing marks. Looking at the marks, it would seem that there is such a similarity as would probably tend to confusion in trade." This held to be sufficient "interest in the subject-matter."

"Interest in the Subject-Matter."

In *Re Estate of P. D. Beckwith, Inc.*, 252 O. G. 245, (not yet reported) the Court said that the statute "forbids the registration of any mark which may lead to confusion in trade." The purpose of the statute is "primarily to protect the public against confusion in trade."

> "The test is not whether buyers would confuse the products, but whether they would confuse the source from which they come." *Williams vs. Kern & Sons*, 47 App. D. C. 441. Citing *American Stove Co. vs. Detroit Stove Works*, 31 App. D. C. 304.

In the very recent case of *Goodrich Drug Co. vs. Cassada Mfg. Co.*, 46 App. D. C. 146, a cancellation case, where no actual confusion was shown, the Court said:

> "The decision, after all, must be based largely upon the impression conveyed to the mind of the Court as to the probable result of the use of these marks upon the same kind of goods. That it would be likely to lead to confusion we have no doubt. But if a doubt existed, it should be resolved for the protection of the public, in whose interest the prohibition of the statute as to the registration of trademarks likely to create confusion in trade was enacted." Cancellation was granted, reversing the decision of the Patent Office.
>
> "Where there is doubt it should be resolved in favor of the protection of the public." *Williams vs. Kern & Sons*, 47 App. D. C. 441, *Lambert Pharmacy Co. vs. Mentho-Listine Co.*, 47 App. D. C. 197, 198.

If Registered Mark is Non-Technical, Prior Use, Acquiescence, Etc., are Immaterial.

In Opposition Proceedings Under Section 6, and in Cancellation Proceedings Under Section 13 of the Trade-Mark Act of 1905, the Requirements as to "Interest in the Subject-Matter" Are the Same.

Such is the distinct and specific holding of the Court of Appeals of the District of Columbia in a number of cases, including *Underwood Typewriter Co. vs. A. B. Dick Co.*, 36 App. D. C. 175, 178, and *Battle Creek Sanitarium Co. vs. Fuller*, 30 App. D. C. 411, 415.

In Cancellation and Opposition Proceedings Where the Mark Is a Non-Technical Mark, the Questions of "First Use," "Abandonment" and "Acquiescence" Are Immaterial.

Carroll vs. Duluth Superior Milling Co., 232 Fed. (C. C. A.) 675.
Duluth Superior Milling Co. vs. Koper, 37 App. D. C. 115.
Heaton-Peninsula Co. vs. Independent Button Fastener Co., 43 App. D. C. 264.
Van Alstyne Co. vs. Boutwell Milling Co., 43 App. D. C. 530.
Joseph Lay Co. vs. Indianapolis Brush Mfg. Co., 40 App. D. C. 36.
McIlhenny Sons vs. New Iberia Extract Co., 34 App. D. C. 43;
Kentucky Dist. & Wareh. Co. vs. Old Lexington C. Dist. Co., 31 App. D. C. 223;
Brown-Forman Co. vs. Beech Hill Dist. Co., 30 App. D. C. 485.

If Registered Mark is Non-Technical, Prior Use, Acquiescence, Etc., are Immaterial.

Upon application to cancel a non-technical mark, which has been improperly or improvidently registered, cancellation is granted irrespective of prior user, acquiescence or abandonment.

Van Alstyne Co. vs. Boutwell Milling Co., Supra, a cancellation case where the registration was under the "ten-year clause" of the words "Upper Hudson" for flour, the registration was cancelled although the registrant was the first user. We take the following from the headnote:

> "the Commissioner of Patents properly cancelled the registration * * * (following *Duluth Superior Milling Co. vs. Koper*, 37 App. D. C. 115), irrespective of the questions of first use, abandonment and acquiescence."
>
> "Passing by the question of first use of the mark on account of its non-technical character and also the question of abandonment and acquiescence, we agree with the Commissioner that Van Alstyne & Co. had not the exclusive use of the trade-mark for the ten years prior to registration made necessary by the act." *Van Alstyne & Co. vs. Boutwell Milling Co.*, 43 App. D. C. 530, 532.

In *Duluth Superior Milling Co. vs. Koper, supra* the registration was under the "ten-year clause" of the words "A. A. Freeman & Co." over the word "Superlative" for flour. The registrant admittedly was the first user and had been the exclusive user for some years prior to any use by the applicant to cancel. Cancellation was granted. Priority of use and ownership or title were considered immaterial. *Carroll vs. Duluth Superior Milling Co.*, 232 Fed. (C. C. A.), 675, same mark involved the ruling of the Court of Appeals in *Duluth Superior Milling Co. vs. Koper, supra,* was approved and followed.

If Registered Mark is Non-Technical, Prior Use, Acquiescence, Etc., are Immaterial.

In *Heaton-Peninsular Co. vs. Independent Button Fastener Co.*, 43 App. D. C. 264, the registrant was the first user and had registered under the "ten-year clause" an illustration of a button fastener as a trade-mark. As the mark was not such a mark as could be properly appropriated or registered, cancellation was granted.

Joseph Lay Co. vs. Indianapolis Brush Mfg. Co. 40 App. D. C. 36, was a proceeding to cancel a trade-mark consisting of a red band around the body of a broom, registered under the ten-year clause, registration of the mark as a technical trade-mark had been previously refused. Cancellation was decreed although the applicant did not claim priority of use and adoption but only claimed use during the ten-year period.

In *McIlhenny Sons vs. The New Iberia Extract Co.*, 34 App. D. C. 43, the mark sought to be cancelled was "Tobasco" for pepper sauce, adjudged to be a geographical term or name. The registrant was conceded to be the first user. Cancellation was granted as it was improperly registered and registrant not entitled to the exclusive use.

In *Kentucky Dist. & Warh. Co. vs. Old Lexington C. Dist. Co*, 31 App. D. C. 223, it was held that as "Old Lexington Club" was not a technical mark, priority of use was immaterial. Applicant to register was the prior user.

> "Inasmuch as the ground of opposition is that the mark is descriptive, it matters not whether the opponent's use of it was before or after that of the applicant." *Piston Ring Co. vs. Sta-Tite Packing Co.*, 118 Ms. Dec. 8. *Brakeley vs. Sears & Nichols Co.*, C. D. 1912, 144.

"Damage" by Intimidating Letters.

In *Magic Curler Co. vs. Porter*, C. D. 1907, 163, an early cancellation proceeding, the Commissioner said:

> "The right registered is a supposed right to exclusive use. The evident intention of Congress was to permit any person deeming himself injured by a registration to question the validity thereof in the Patent Office, and to obtain cancellation thereof if the registrant had no trade-mark right therein at the time of his application for registration, or if, having had such a right at that time, he has subsequently lost the same. There is more reason why a party who has himself no trade-mark right, but who is harassed in his business through an improper registration, should be permitted to overthrow that registration than there is for according this relief to one who is the possesser of a trade-mark right. The latter party may obtain relief against injury through the invalid registration by interference proceedings, registration to himself and suit thereon. The former party though liable to the same injury, has not the same opportunity for combating it."

Specific Causes of Injury to R. S. Howard Co.

I.

R. S. Howard Company Damaged by the Improper Registration of the Personal Name "Howard."

Any person or concern entitled to use the name "Howard" in any form as a trade or business name in the same line of business is damaged by an im-

proper registration of the name "Howard." Confusion and damage are inevitable and obvious. The authorities have already been cited.

II.

R. S. Howard Company Damaged by the Improper Registrations Because the Registrations Are Prima Facie Evidence of Exclusive Ownership of a Valid Trade-Mark of the Name "Howard."

The damage resulting from such an improper registration has already been clearly stated by this Court.

Elgin Nat'l Watch Co. vs. Illinois Watch Case Co., 179 U. S. 665.
Electro Steel Co. vs. Linderburg Steel Co., 43 App. D. C. 270.

III.

R. S. Howard Company Damaged by the Baldwin Company's Intimidating Letters to R. S. Howard Company's Customers.

The record shows that The Baldwin Company has been sending threatening and intimidating letters to R. S. Howard Company's customers claiming rights under trade-marks "duly registered by us in the United States Patent Office," and we "will take all necessary steps to protect our rights against infringement."

Samples of these threatening and intimidating letters are set out in Applicant's Exhibit 111 (Rec., p. 960) admitted to have been written and sent by The Baldwin Company (Rec., p. 2300, XQs. 91-94).

"Damage" by Intimidating Letters.

Any use by The Baldwin Company of the registrations sought to be cancelled which threatens to cause damage or injury is sufficient to give the R. S. Howard Company a standing to cancel.

Any conduct or language which influences or tends to influence customers or the public to withdraw or withhold its custom from the R. S. Howard Company is damage and injury.

It is immaterial whether such effect is produced by persuasion, by threats, or by falsehood. *Am. Wells Works Co. vs. Layne & Bowler Co.*, 241 U. S. 257.

In the case at bar, The Baldwin Company threatens the R. S. Howard Company's customers with the penalties incurred under the statutes for infringing registered trade-marks. This is obviously a threatened injury and damage, directly founded upon the registrations improperly granted and now sought to be cancelled.

It must be presumed that the public and the R. S. Howard Company's customers know the additional penalties imposed for infringing a registered trade-mark over and above those penalties imposed for infringing a mark not registered and not registrable.

The direct and obvious purpose of the letters was to intimidate the R. S. Howard Company's customers, threaten them with litigation, cause them to cease to buy the R. S. Howard Company's pianos, thereby causing the R. S. Howard Company to lose gains and profits. However vague the language of such intimidating letters may be, to intelligent business men, they have no doubtful meaning and their purpose and result are plain.

> "Why it is to intimidate these people or prevent them from dealing in complainant's beer.

"Damage" by Intimidating Letters.

That far it is oppressive c
complainant and tends to d of the business of
There is no question about lestroy its business.
would intimidate these peop that, insofar as it
membered that there are ple. It must be re-
this world, who would be any timid people in
danger of even small losse much influenced by
ing Co. vs. Hansen, 144 Fed. d. 1011, 1014.

Anything that unfairly obstructs or unlawfully interferes with the R. S. Howard Company's business would be an injury and its continuance prohibited. To disturb or annoy, or to threaten with annoyance or injury, is an actionable wrong.

"Nor does it matter whether the wrongdoer effects his object by persuasion or by false representations.

* * * * *

"Loss of business is the only natural result to be expected from such action and if continued the failure of the enterprise would inevitably follow." *Barr vs. Essex Trades Council*, 30 Atl. Rep. (N. J. Eq.) 881, 886, 887.

Nor is it essential that the statement contained in the circulars or letters be false; it is sufficient if the scheme of using the trade-mark registrations, obtained without authority of law, is used to intimidate the R. S. Howard Company's customers and is held as a continuing menace to all who would deal or wish to deal with the R. S. Howard Company. Such, in substance, is the language of the Courts in *Barr vs. Essex Trades Council*, 30 Atl. Rep. (N. J. Eq.) 881, *and Sherry vs. Perkins*, 147 Mass. 212, both cited with approval in *Seattle Brewing Co. vs. Hansen*, 144 Fed. 1011.

"Damage" by Intimidating Letters.

In *Emack vs. Kane*, 34 Fed. 47 (a case cited with approval in a number of instances by the U. S. Circuit Court of Appeals), the defendant sent circulars to plaintiff's customers threatening to bring suit against them for infringement of patents. In granting an injunction, Judge Blodgett, among other things, said:

> "Statements and charges intended to frighten away a man's customers, and intimidate them from dealing with him, may wholly break up and ruin him financially."
>
> * * * * *
>
> "The average business man undoubtedly dreads and avoids, if he can, a lawsuit of any kind, and a suit for infringement of a patent is so far outside of the common man's experience that he is terrified by even a threat of such a suit."

The Court might with equal truth have said the same of a trade-mark infringement suit.

In *Racine Paper Goods Co. vs. Dittgen*, 171 Fed (C. C. A.) 631, the defendant had been circulating among plaintiff's customers and the trade generally, by letters and otherwise, representations that plaintiff was infringing defendant's letters patent. After citing with approval *Emack vs. Kane*, 34 Fed. 47, *Farquhar Co., Ltd. vs. National Harrow Co.*, 102 Fed. (C. C. A.) 714, *Advance Platt & Co. vs. National Harrow Co.*, 121 Fed. (C. C. A.) 827, the Court, in granting an injunction, said:

> "In the cases cited, *supra*, the means employed to injure the business of the three complainants was by circulars addressed to the trade differing from the acts of appellant here-

> in more in volume and method of distribution than in substance. The distinction goes to the degree of certainty in establishing the malicious motive, not to the question of amount of damage sustained. In other words, it requires no prolonged or extensive series of damaging assaults upon one's business to call into service the restraining hand of the law, provided it satisfactorily appears that the acts are done with the purpose of injuring the business and have injured, and are calculated to injure. When this is proven, fraud will be implied." (See also decision below, 164 Fed. 85, and *Kidd vs. Horry*, 28 Fed. 773, Mr. Justice Bradley.)

In *Am. Wells Works Co. vs. Layne*, 241 U. S. 257, the defendant wrote letters to plaintiff's customers claiming that plaintiff's pump infringed defendant's rights, whereupon plaintiff sued the defendant for damages to its business caused by such threats. In sustaining plaintiff's declaration as disclosing a good cause of action, Mr. Justice Holmes, speaking for the Court, said:

> "It is evident that the claim for damages is based upon conduct, or more specifically, language tending to persuade the public to withdraw its custom from the plaintiff and having that effect to its damage. Such conduct having such effect is equally actionable whether it produces the result by persuasion, by threats, or by falsehood. *Moran vs. Dumphy*, 177 Massachusetts, 485, 487. And it is enough to allege and prove the conduct and effect, leaving the defendant to justify it if he can.
>
> "Finally we see no sound distinction between persuading by malevolent advice and accomplishing the same result by falsehood or putting in fear. * * * It appears to us not to

matter which motive is relied upon. If accomplishing the end by one of them is a wrong to the plaintiff, accomplishing it by either of the others must be equally wrong.

"It follows from what we have said that we are of the opinion that both counts of the declaration disclose a good cause of action. * * *"

See also,

Moran vs. Dumphy, 177 Mass. 485, 487.
Ogilvie Co. vs. Merriam Co., 149 Fed. 858.

IV.

R. S. Howard Company Damaged by The Baldwin Company's Suit for Infringement of Registrations, Which Suit May Be Renewed against R. S. Howard Company or Its Customers at any Time.

The R. S. Howard Company has been sued for infringement of both said registered trade-marks of The Baldwin Company wherein threefold damages for such alleged infringement were demanded.

The answer of The Baldwin Company, in Cancellation No. 301, to the second supplemental petition to cancel (Rec,. pp. 1080, 1082, 1083) contains the following:

"This respondent admits that on or about November 29, 1915, The Baldwin Company (registrant herein), filed a suit in equity against the R. S. Howard Company (petitioner herein), in the United States District Court for the Southern District of New York, and that subpoena in said equity suit was served upon the R. S. Howard Company on or about November 29, 1915. * * *

"Damage" by Infringement Suit.

> "Respondent admits that as one of its causes of action in said equity suit infringement is alleged by the R. S. Howard Company of the registered trade-marks Nos. 31,411, dated March 8, 1898, and 46,993, dated October 17, 1905, which are the trade-mark registrations involved in these proceedings, but that the jurisdiction of the Court in said equity suit is also invoked to enjoin unfair competition in trade, said suit being between citizens of different states, and to enjoin the infringement of the trade-mark and trade name 'Howard' which, it is alleged in the bill of complaint, now has universally a secondary meaning both to the public and in the trade as a designation of pianos manufactured by The Baldwin Company and its predecessors in business.
>
> "Respondent admits that The Baldwin Company has prayed for threefold damages to be recovered from the R. S. Howard Company on account of its infringement of said registered trade-marks * * *."

The answer of The Baldwin Company, *et al.*, in Cancellation No. 302 (Rec., pp. 1105, 1107, 1108) contains the same admission as to Registration No. 31,411, in substantially the same language.

That damage results from threatened suits based on improper registrations of trade-marks is clear (see citation, *supra*, pp. 66-7, 71-2).

In *Magic Curler Co. vs. Porter*, C. D. 1907, 163, an early cancellation proceeding, the Commissioner said:

> "There is more reason why a party who has himself no trade-mark right, but who is harrassed in his business through an improper registration, should be permitted to overthrow that registration than there is for according this relief to one who is the possessor of a trade-mark right. The latter party may obtain

> relief against injury through the invalid registration by interference proceedings, registration to himself and suit thereon. The former party, though liable to the same injury, has not the same opportunity for combating it."

In *Familton vs. Alonzo Bliss Co.*, C. D. 1908, 189, and in *Hydraulic Press Brick Co. vs. Hocking Valley Products Co.*, 120 Ms. Dec. 196, it was held that suing or threatening to sue was "damage" and a "sufficient interest in the subject-matter." In the latter case it was held that "injury" is sufficiently established by showing that the petitioner to cancel had been sued in the Supreme Court, District of Columbia, for infringement of the improperly registered trade-mark.

In *Familton vs. Alonzo Bliss Med. Co.*, C. D. 1908, 180 (a cancellation proceeding), notice had been given that unless the applicant to cancel discontinued the use of the mark, suit would be brought; customers of the applicant to cancel had been threatened with suit by the registrants' agents. This held a sufficient showing of "injury."

In *Needham Tire Co. vs. Hood Rubber Co.*, 124 Ms. Dec. 396, it was held that suit begun or threatened was sufficient showing of "interest in the subject-matter."

It is immaterial that The Baldwin Company on final hearing in the equity action waived all profits and damages for the alleged infringement (Rec. p. 2642), or that the trade-mark registrations were not pressed and finally entirely withdrawn (Rec., pp. 2639, 2645). The Baldwin Company, in its brief, stating that "the validity of the registrations is not in issue in the case" (Rec., p. 2645).

It is obvious that The Baldwin Company could, at any time, bring another suit alleging infringement of

its registered trade-marks, either against the R. S. Howard Company or its customers, and could continue its practices of sending intimidating letters claiming infringement of registered trade-marks; and such actions and practices would always be imminent and threatening as long as the trade-mark registrations remain uncancelled.

V.

R. S. Howard Company Damaged by Registration of the Name "Howard," the Dominant Feature of Its Corporate Name.

R. S. Howard Company was incorporated in April, 1902 (Rec., p. 200, Q5).

The testimony of The Baldwin Company is that up to 1912, the markings used on all "Howard" pianos made by any of the Baldwin concerns contained the wording "Howard, VGPCo. (in monogram), Cabinet Grand (in a scroll), Trade-Mark, Cincinnati, Chicago" (shown in Registrants' Exhibit 39; see reproduction, pp. 93-6, *infra*). It was not until 1912 that the name "Howard" without the monogram was ever used by any Baldwin concern on either pianos or player pianos. In 1912, when the name "The Valley Gem Piano Company" was changed to "The Howard Piano Company," the monogram was changed to "HPCo." and the monogram "VGPCo." was abandoned by The Baldwin Company and not used thereafter (Rec., pp. 761-764). The markings are Registrants' Exhibits 40 and 41 (see *infra*, pp. 94-5).

It was in 1912 that the Baldwin concerns first began to use the marking shown in Registrants' Exhibit No. 42 (which is an impression of Registrants' Exhibit No. 27, *infra*, p. 96), using the same on a

player piano. If any Baldwin concern ever used "Howard" without arbitrary accessories as a marking for pianos, this marking (Registrants' Exhibit No. 42) was such first use. It is difficult to understand how this marking (Registrants' Exhibit No. 42) can, in any event, be said to be "Howard" *simpliciter.*

The testimony of The Baldwin Company's officers, regarding the use of their several markings, has been reproduced, *supra*, pp. 47-51. This testimony is conclusive that "Howard" without "VGPCo." was never used prior to 1912.

Where a name or mark is the dominant and distinguishing feature of the corporate name of a corporation which was incorporated prior to the use of the word or name as a trade-mark, damage and injury to the corporation will be implied as a matter of law, and a sufficient showing of "interest in the subject-matter" made.

Asbestone Co. vs. The Philip Carey Mfg. Co., 41 App. D. C. 507.
Mansfield Tire & Rubber Company vs. Ford Motor Company, 44 App. D. C. 205.
In re United Drug Co., 222 O. G. 729; 44 App. D. C. 209.
D. H. Burrell & Co. vs. Simplex Electric Heating Co., 44 App. D. C. 452.
N. Wolf & Sons vs. Lord & Taylor, 41 App. D. C. 514.
Investor Pub. Co. vs. Dobinson, 72 Fed. 603.

"Damage" from The Baldwin Company's Foreign Registration of the Name "Howard."

VI.

The R. S. Howard Company Is Damaged by The Baldwin Company's Foreign Registrations of the Name "Howard" for Pianos.

The Baldwin Company admits that it has registered the name "Howard" as a trade-mark for pianos in a number of foreign countries and at the time this admission was made applications were pending for registration in a number of other foreign countries (Rec., pp. 820, 821).

FRANK A. MCGEE, The Baldwin Company's auditor, in December, 1915, testified that the word "Howard" had been registered as a trade-mark for pianos in Argentine Republic, Brazil, Panama, Colombia, Italy and Mexico (Rec., p. 879, Q9). All these registrations had been applied for since these proceedings were begun (Alice G. Donegan's testimony, Rec., p. 2368, XQ8), and that a number of other applications were pending in April, 1916 (Rec., p. 2368), and that some fifteen applications had been filed, many of them based on the United States registration (Miss Donegan's testimony, Rec., p. 2368, XQs. 10, 11).

Attention is respectfully called to the testimony of Arthur W. Barber (Rec., p. 884) and John L. Stowers (Rec., p. 697; quoted *infra*, pp. 86-92).

The testimony of ARTHUR W. BARBER shows that:

> (a) In a long list of foreign countries (about twenty) registration of a trade-mark cannot be made by a foreigner until registration is made in the foreigner's home country and a certified copy of the home registration included as a part of the application;

(b) Registration of a trade-mark in any country belonging to the International Trade-Mark Union, is generally secured *pro forma*, by submitting an application accompanied by a certified registration in the home country;

(c) Most of the principal countries of the world (about 29) belong to the International Trade-Mark Union including Cuba, Brazil, Italy and Mexico.

(d) The effect of registrations in foreign countries is to prevent the sale of goods bearing marks similar, in whole or in part;

(e) The penalties for infringement in most of these countries are criminal, subjecting the seller to imprisonment, the stock of goods to confiscation, and the seller to a fine;

(f) What may be considered a "similar" marking is quite indefinite and undeterminable, but that any mark bearing any dominant features of the registered mark would be considered "similar";

(g) In most foreign countries the distinction between trade-marks and business names is not clearly understood particularly in South American countries;

(h) The standing which a registered trade-mark in these countries gives would undoubtedly cause great injury and damage to a concern using a similar business name, with the probability of a ruined trade and years of expense of litigation before there could be any

hope of securing from a Court the right to sell under a business name which in any degree bore resemblance to a registered trade-mark.

VII.

Damage to R. S. Howard Co.'s Foreign Business by The Baldwin Company's Foreign Registrations.

ROBERT S. HOWARD, president and manager of R. S. Howard Company, testified that immediately after the company was organized in 1902, it began the sale of pianos in this and foreign countries and that since 1902 they have been sold extensively "throughout the world" (Rec., p. 212, Q59). He testified that these pianos from the beginning were marked "Howard" and "R. S. Howard & Co." (some one way, some the other, indiscriminately, see stencils and testimony, *supra*) and that said markings had been continued ever since (Rec., p. 293, RDQs. 418-422; p. 210, Qs. 50-55).

GEORGE W. MARKENS, who has looked after the selling and shipping of pianos made by the R. S. Howard Company since 1903, testified (Rec., p. 119):

"Q10. In what countries have you sold or arranged a sale of the pianos made by the R. S. Howard Company of New York? A. Argentine Republic, Brazil, Chile, Panama, Colombia, Spain, Portugal, France, Italy, Belgium, Australia, New Zealand, India, Japan, and have been attending to all their export shipping and requirements in Cuba and Mexico and Porto Rico."

"Damage" From The Baldwin Company's Foreign Registration of the Name "Howard."

ROBERT S. HOWARD testified (Rec., p. 2548):

"Q398. Will you please tell us why the R. S. Howard Company began the cancellation proceedings in the United States Patent Office, which has been referred to in the testimony in this action, the record of which has been filed in this case? A. Because of troubles that started in Cuba in connection with the business there. After doing business there about twelve years, shipping in several thousands of instruments, and having as a matter of record in the Custom House eighty per cent of the business of Cuba, the Howard piano was the easiest instrument to sell there, and one of my dealer's agents started in business for himself and got the pianos manufactured by the plaintiff in this action.

"Q400. Do you know whether in connection with activities in selling pianos in Cuba, the plaintiff company did anything to oust you, or prevent you from selling your pianos in Cuba? A. They did, in applying for a trade-mark on the Howard name.

"Q401. For pianos? A. For pianos.

"Q403. What was the advice given to you, or R. S. Howard Company by its attorneys in Cuba, as to the effect of the registration of the name 'Howard' by The Baldwin Company in Cuba as a trade-mark for pianos? A. That the Howard pianos in possession of our dealers there would be attached, and he would be arrested and go to jail; the goods would be confiscated."

JOHN L. STOWERS, a retail piano dealer of Havana, Cuba, testified that he had been selling pianos made by the R. S. Howard Company throughout Cuba for eleven years, having twenty-two agencies in the island;

that the biggest portion of the pianos received from R. S. Howard Company have been marked "R. S. Howard Co., New York," some with the word "Howard," but none marked "Howard," alone, in recent years (Rec., p. 688, Qs. 1, 2, 4, 11, 12, 25).

MR. STOWERS also testified (Rec., p. 697):

"Q1. Please state, if you know, what the effect would have been upon you personally, and upon your business, if that application to register the trade-mark 'Howard' by The Baldwin Company in Cuba, referred to in Applicant's Exhibit No. 109, had been consummated?

"The Witness: The effect in Cuba is criminal for selling a piano that is supposed to conflict with any other make of pianos, and my stock of pianos would have been taken by the agent of The Baldwin Company and confiscated, and I would have been subject to several years in prison."

The Court's attention is particularly directed to Applicant's Exhibit No. 109 (Rec., p. 918), a decree by the President of the Republic of Cuba, in reference to the registration of "Howard" as a mark for pianos by The Baldwin Company. This application by The Baldwin Company to register "Howard" in Cuba as a trade-mark for pianos is still pending in the courts of Cuba, the application being based *solely* upon the registration No. 46,993 in the United States Patent Office.

ARTHUR W. BARBER, 43 years old, a lawyer, educated in and familiar with the laws relating to trade-mark registration, trade-mark protection and trade-mark litigation in the United States and foreign countries, testified (Rec., p. 885):

"Damage" From The Baldwin Company's Foreign Registration of the Name "Howard."

"Q4. If you know, please state which of the following countries, namely: Argentine Republic, Brazil, Panama, Columbia, Italy, Cuba and Mexico, if any, require, as a condition precedent to the registration of a trade-mark in such country or countries by an Ohio corporation, prior registration in the United States and the submission of a certified copy of such prior registration in the United States as a part of the application before registration can be had in such foreign country or countries? A. I have had charge of trade-mark registration in all of these countries to the number of scores and probably hundreds in each country and am familiar with the requirements for registration for each of them. Under the circumstances indicated in the question, prior registration in the United States is required for Brazil, Panama, Columbia and Cuba.

"Q5. State, if you know, which of the countries enumerated in my last question, if any, make infringement of registered trade-marks a criminal or penal offense under their laws? A. In each of the countries enumerated in the last question the infringement of the trade-marks registered therein is a criminal or penal offense.

"Q6. State, if you know, in what foreign countries, if any, enumerated in the second preceding question, pianos made and offered for sale in such countries by a New York corporation, and bearing marks or names identical with, similar to, or imitations of, a trade-mark for pianos registered in such foreign countries by an Ohio corporation, would be subject to confiscation under the laws of such country or countries? A. In each of the countries enumerated, with the possible exception of Cuba. With respect

"Damage" From The Baldwin Co
Registration of the Name "ompany's Foreign
'Howard."

to Cuba the trade-mark law makes
the confiscation of goods under the no provision for
but I have been several times advisese circumstances,
torneys that goods could be confiscaised by Cuban at-
cumstances mentioned by virtue of ated under the cir-
the Penal Code." the provisions of

(Rec., p. 901):

"XQ40. * * * A. * * * I would
that the registration of the name 'Hd certainly believe
by The Baldwin Company would gHoward' in Brazil
tunity to do incalculable damage to give it the oppor-
R. S. Howard Company in that co the trade of the
countenance to threats that might beountry by lending
agents and dealers in its goods ane made against its
basis for criminal prosecutions and nd by affording a
be successfully defended by the R. suits which might
pany, if it could persuade Brazilian S. Howard Com-
the interpretation of the Internationan Courts to accept
tained in my answer to Q39. Eval Convention con-
however, it is clear that the R. S. Iven in that event,
would be subjected to great expenseHoward Company
might be damaged considerably, if se and its business
the meantime. The idea I aim to not irreparably, in
all Latin-American countries the convey is; that in
rights theoretically clear in law is v assertion of the
may be made very difficult by any very expensive and
entrench himself behind a shadow one who is able to
to command or willing to pay for p of right and able
political influence."

(Rec., p. 900):

"XQ39. * * * A. * * * It
ways to be understood in dealing witIt is, of course, al-
countries, that to have a right is ith Latin-American
s one thing under

their laws, and to be able to enforce it is another thing."

(Rec., p. 906):

"XQ53. * * * A. I know no way that anyone can be prevented from making threats whether with or without foundation, but the important difference between the status of The Baldwin Company and of the R. S. Howard Company in Brazil, as disclosed in this examination, is that The Baldwin Company has a certificate of registration of a trade-mark in Brazil consisting of the name 'Howard,' and can produce a certificate as proof of its right to use the name before any court or tribunal, while the R. S. Howard Company would be at a very great disadvantage without a certificate of registration and forced to rely upon the provisions of the International Convention. I would consider it a very difficult proposition to find a lawyer in Brazil who could properly appreciate the difference between a trade-mark and a trade name and recognize the rights of the R. S. Howard Company as secured by the International Convention and having found him, I would consider that he would have a very difficult task to convince a Court in that country of the justice of his view. In my experience there is only one Latin-American country where the principles of trade-mark law are understood or the nature of trade-mark rights are adequately recognized, and that country is not Brazil, and is not among the countries referred to in my testimony."

(Rec., p. 931):

"XQ90. * * * A. * * * The registration of the name 'Howard' by The Baldwin Company might very readily be made the basis of proceedings in those

(foreign) countries, or any of them, against dealers in the goods of the R. S. Howard Company, which proceedings made under color of trade-mark registration might be used to work great damage to the trade in the goods of the R. S. Howard Company. The timidity of dealers in the handling of goods the trade-mark on which is questioned or is the subject of dispute is very well recognized in all countries and is quite as pronounced in Spanish-American countries as in the United States."

(Rec., p. 932):

"XQ92. * * * A. The continued liability to such threats or proceedings would seem to me a very material present damage. * * *"

(Rec., p. 932):

"XQ93. * * * A. There are very few decisions reported in accessible from in any of the countries of Latin-America. I have known of a case with which I was occupied for a year or two in Brazil and in many other of the Latin-American countries in behalf of a client located in the United States who was doing business under his surname as a trade-name and applying it to his goods in the form of his *fac simile* signature. A competitor in the United States obtained a registration in Brazil of a similar trade-name, differing only from the one previously mentioned in that it terminated in the letter 'y' instead of 'ie.' By means of this registration in Brazil, the party in question was able to put my client to an expense of about two thousand dollars for the establishment of his rights, and to kill his trade in that country for more than a year and to such an extent that it has never recovered."

"Damage" From The Baldwin Company's Foreign Registration of the Name "Howard."

(Rec., p. 942):

"RDQ115. Please state what countries are members of the International Convention of 1883? A. Austria, Belgium, Brazil, Cuba, Denmark (including the Faroe Islands), Dominican Republic, Germany, Spain, United States, Hungary, France, including Algiers, Great Britain, Australia, Ceylon, New Zealand, Trinidad and Tobago, Italy, Japan, Mexico, Norway, Holland, Dutch East Indies, Surinam, Curacao, Portugal (including the Azores and Maderie), Servia, Sweden, Switzerland, Tunis, German Colonies. This is the list published by the International Bureau of Bern, Switzerland, under date of January 1, 1915. There have been no changes since that date, so far as I have been informed.

"RDQ116. Do you know of any changes that have occurred in 1914? A. There have been no changes, so far as I know, since January 1, 1909.

"RDQ117. For the convenience of the Commissioner of Patents, will you kindly read into the record Articles 6, 9 and 10 of the International Convention to which you have alluded in your testimony? A. The provisions of Articles 6, 9 and 10 of the International Convention of 1883 are as follows:

(Record, p. 943):

"'Article 6: Every trade or commercial mark regularly registered in the country of origin shall be admitted to registration and so protected in all the other countries of the Union.

"'The country where the registrant has his principal establishment shall be considered as the country of origin.

"Damage" From The Baldwin Company's Foreign Registration of the Name "Howard."

" 'If its principal establishment is not located in one of the countries of the Union, the country to which the registrant belongs shall be considered as the country of origin.

" 'The registration may be refused if the object for which it is asked is considered contrary to morals or to public order.

" 'Article 9: Every product unlawfully bearing a trade or commercial mark or a commercial name, may be seized upon importation into those of the States of the Union in which this mark or this commercial name has a right to the protection of the law.

" 'The seizure shall be made, either at the instance of the public prosecutor, or of the party interested, according to the domestic legislation of each State.

" 'Article 10: The provisions of the preceding article shall be applicable to every product falsely bearing, as an indication of origin, the name of a definite locality, when this indication is joined to a fictitious commercial name or a name borrowed with a fraudulent intent.

" 'Every manufacturer or trader engaged in the manufacture or trade in this product and established in the locality falsely indicated as the place of origin shall be regarded as an interested party.' "

The applications for writs of Certiorari should be denied.

Respectfully submitted,

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REPRODUCTION OF REGISTRANTS' EXHIBIT No. 37

The Baldwin Company claims it used this marking for pianos prior to 1912.

REPRODUCTION OF REGISTRANTS' EXHIBIT No. 26

Marking for Pianos which The Baldwin Company claims it has used since 1912.

REPRODUCTION OF REGISTRANTS' EXHIBIT No. 38

93

Marking for pianos which The Baldwin Company claims it has used since 1912.

REPRODUCTION OF REGISTRANTS' EXHIBIT No. 27

96

Marking for Player-Pianos which The Baldwin Company claims it has used since 1912.

APPLICANT'S EXHIBIT No. 65

R. S. Howard Company undisputedly used this mark for pianos since 1902 (except monogram.)

NOV 10 1920
JAMES D. MAHER,
CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1920.

Nos. 113 and 139.

THE BALDWIN COMPANY,

Appellant,

against

R. S. HOWARD COMPANY,

No. 113.

THE VALLEY GEM PIANO COMPANY (The Howard Piano Company, substituted) and THE BALDWIN COMPANY,

Appellant,

against

R. S. HOWARD COMPANY.

No. 139.

Brief for R. S. Howard Company.

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Supreme Court of the United States

OCTOBER TERM, 1920.

Nos. 113 and 139.

THE BALDWIN COMPANY, Appellant, against R. S. HOWARD COMPANY.	No. 113.
THE VALLEY GEM PIANO COMPANY (The Howard Piano Company, substituted) and THE BALDWIN COMPANY, Appellants, against R. S. HOWARD COMPANY.	No. 139.

BRIEF FOR R. S. HOWARD CO.

Note.

All references to the Record are to the paging of the complete record before the Court of Appeals of the District of Columbia.

Statement.

In August, 1914, R. S. Howard Company, a corporation, the respondent, presented its application to the Patent Office praying that Trade-Mark Registra-

tion No. 46,993, registered October 17, 1905, by The Baldwin Company, for pianos, and Trade-Mark Registration No. 31,411, registered March 8, 1898, by The Valley Gem Piano Company, for pianos, be cancelled.

The Baldwin Company claims to own both said trade-mark registrations.

Motion to Dismiss.

The Cases at Bar Should be Dismissed for Want of Jurisdiction, Following the Rule of Stare Decisis.

In the cases at bar the appeal from the decision of the Commissioner of Patents to the Court of Appeals of the District of Columbia was taken under Section 9 of the Trade-Mark Act of 1905 (c. 592, 33 Stat. 724). This is admitted by appellants (see Petition for Appeal, p. 5).

This Court four times, at least, has decided flatly and unanimously that a decision of the Court of Appeals of the District of Columbia on appeals from the Commissioner of Patents is *not* a final judgment or decree, and, therefore, not reviewable by this Court, either on an appeal, writ of error, or writ of certiorari, and in each of these four cases have dismissed the appeal or writ of error, or denied the certiorari, on the ground of want of jurisdiction. These cases are:

Franck vs. Moore, 211 U. S. 1, was an appeal, writ of error and certiorari, to review a decision of the Court of Appeals of the District of Columbia affirming a decision of the Commissioner of Patents requiring a division between process and apparatus claims in a patent application.

Johnson vs. Mwescr, 212 U. S. 283, was a writ of error to review a decision of the Court of Appeals of the District of Columbia which affirmed a decision of the Commissioner of Patents in a patent interference proceeding involving priority of invention.

Gaines vs. Knecht, 212 U. S. 561, was a writ of error to review a decision of the Court of Appeals of the District of Columbia which affirmed a decision of the Commissioner of Patents dismissing an opposition to an application to register a trade-mark.

Atkins vs. Moore, 212 U. S. 285 (the latest case, 1909), was an appeal and writ of error to review a decision of the Court of Appeals of the District of Columbia, which affirmed a decision of the Commissioner of Patents in a proceeding arising under an application to register a trade-mark.

In *Atkins vs. Moore (supra)*, the Chief Justice, speaking for the Court, said (p. 289):

> "In *Frasch vs. Moore*, 211 U. S. 1, 29 Sup. Ct. Rep. 6, it was held that decisions in the Court of Appeals of the District of Columbia in appeals from the Commissioner of Patents under Section 9 of the Act of February 9, 1893 (Chap. 74, 27 Stat. at L. 434, 436, U. S. Comp. Stat. 1901, p. 3391), were interlocutory and not final, and not reviewable by this Court under Section 8 of that act, because not final judgments or decrees within the meaning of that section. When certified to the Commissioner of Patents, they 'govern the further proceedings in the case' (Revised Statutes, Section 4914, U. S. Comp. Stat. 1901, p. 3392), but are not final judgments or decrees at law or in equity within the purview of Section 8.
>
> "In *Gaines vs. Knecht*, we applied the same rule to a writ of error to the decision of the Court of Appeals, rendered on appeal to that Court from a decision of the Commissioner of Patents in proceedings arising under an application for a trade-mark * * *.
>
> "*Gaines vs. Knecht* was a case of opposition to the registration of a trade-mark under Sections 6 and 7 of the Act of February 20, 1905, the objections being that the act was unconstitutional, and also that the applicant's mark was so similar to the mark of opponent that it would be likely to lead to confusion, and enabl:

applicant to perpetrate a fraud on the public. The Examiner of Interferences dismissed the opposition, and from his decision the case was appealed to the Commissioner, who affirmed the decision. An appeal was then taken to the Court of Appeals, and that Court affirmed the Commissioner, and 'ordered that this decision and the proceedings in this Court be certified to the Commissioner of Patents, as required by law.' * * *

"In the light of the various details of the Act of February 20, 1905, and of the specific provisions of Section 9, we were of the opinion that proceedings under the act were governed by the same rules of practice and procedure as in the instance of patents, and the writ of error was accordingly dismissed. The same result must follow in the present case. * * *

"Appeal and writ of error dismissed."

Appellants urge that *Johnson vs. Muezer (supra)*, may be distinguished on the ground that the loser had another remedy and could apply for a patent to a Court of Equity under Sec. 4915 of the Rev. Stat., and that under Sec. 4914 of the Rev. Stat. any person interested could contest the validity of the patent to the winner, notwithstanding the decision of the Court of Appeals of the District of Columbia. No effort is made, however, to distinguish the other three cases; the decision in each of these three cases was final in the same sense and to the same extent as the decisions in the cases now at bar. In the last two cases cited above substantial trade-mark rights were involved, in neither of which cases did the loser have any further remedy; in principle, these two cases are not distinguishable from the cases at bar.

Nor can the cases at bar be distinguished, as appellants urge, on the ground that here "rights of persons or property" are involved. The "right" claimed here, and the only claim of "right" involved, is the right to

a registration of the common surname "Howard." Such claim of "right," if not without merit on its face, has positively been foreclosed by the repeated decisions of this Court (*Howe Scales Co. vs. Wyckoff, Seamans & Benedict*, 198 U. S. 118; *Merriam Co. vs. Syndicate Pub. Co.*, 237 U. S. 618, and cases cited), and a contention, or an appeal, based upon such a claim of "right" would appear to be frivolous.

> "If * * * the averment as to a right arising under the Federal Constitution or statutes was unsubstantial and without real merit, either because of its frivolous character upon its face, or from the fact that reliance was based upon a claim of Federal or statutory right denied by former adjudications of this Court, then the appeal to this Court must be dismissed. *Newburyport Water Co. vs. Newburyport*, 193 U. S. 561, 576, 48 L. ed. 795, 799, 24 Sup. Ct. Rep. 553; *Equitable Life Assur. Soc. vs. Brown*, 187 U. S. 308, 311, 47 L. ed. 190, 192, 23 Sup. Ct. Rep. 123."
> *Merriam Co. vs. Syndicate Pub. Co.*, 237 U. S. 618, 621.

> "The claim must be real and substantial, not merely colorable or without reasonable foundation. * * * Whether the question * * * is real and substantial, or is merely colorable and without reasonable foundation, depends, *inter alia*, upon whether it is an open one in the Supreme Court, or has been solemnly and directly determined by that Court."
> *Harris vs. Rosenberger*, 145 Fed. (C. C. A.) 449, 452, and cases cited (Van Deventer, C. J.).

> "The right to appeal is one of substance, and not of mere form. Where a question has been foreclosed by the repeated decisions of this Court, that question can no longer be a ground for an appeal."
> *Kansas vs. Bradley*, 26 Fed. 289 (Brewer, J.).

There is no Judgment or Decree (Final or Otherwise) Before this Court for Review.

In appeals from decisions of the Commissioner of Patents under said Sec. 9 of the Trade-Mark Act of 1905, the Court of Appeals of the District of Columbia enters no judgment or decree (and is not authorized so to do), not even a judgment for costs, but merely certifies its decision to the Commissioner of Patents which "shall govern the further proceedings in the case" (Rev. Stat., Sec. 4914).

In *Wells vs. Reynolds,* 3 App. D. C. 43, a motion was made for judgment for costs. In denying the motion, the Court, through Chief Justice Alvey, said:

> "Upon consideration of this motion, the Court has concluded that under the law it has no power or jurisdiction to award costs, or to execute any judgment therefor, that might be entered to cases of appeals from the Commissioner of Patents. The motion is therefore denied" (Dec. 5th, 1894).

There has been no reversal, modification or exception to said ruling or practice.

The cases at bar should be dismissed on the ground that the Court is without jurisdiction; also on the ground that no "real or substantial" question is involved.

Claims to Right of Appeal.

1. Appellants claim the right of appeal on the ground that the existence or scope of a power or duty of an officer of the United States is drawn in question.

The appellants' claim under this ground is, that the Commissioner of Patents has no power or authority to cancel a trade-mark registration made under the

Trade-Mark Act of 1881; that Section 13 of the Trade-Mark Act of 1905 only authorizes the cancellation of registrations made under the Trade-Mark Act of 1905. Such claim can only apply to No. 139, and cannot apply to No. 113, as in No. 113 the registration was made under the Trade-Mark Act of 1905.

As to No. 139, if such claim of right of appeal has no real existence or real basis, is without merit or substance on its face, and nothing more than a bare assertion, it must be held insufficient.

> "The validity of a statute is not drawn in question every time rights claimed under such statute are controverted, nor is the validity of an authority, every time an act done by such authority is disputed * * *."
> *United States vs. Lynch*, 137 U. S. 280; repeated in *Taylor vs. Taft*, 203 U. S. 461, 465.

2. Appellants also claim the right of appeal on the ground that the construction of laws of the United States are drawn in question.

The laws referred to are:

(a) Sec. 13 of the Trade-Mark Act of 1905 which appellants claim does not authorize the cancellation of trade-mark registrations made under the Trade-Mark Act of 1905. Such claim cannot apply to No. 113, as in No. 113 the registration was made under the Trade-Mark Act of 1905.

(b) Sec. 905, Rev. Stat., in that the Court below did not give full faith and credit to the proceedings in the suit in the Second Circuit between the same parties. Such records and proceedings in the suit in the Second Circuit as are in the Record at bar (pp. 2599-2609; 2611-2646) were not certified or authenticated as required by Sec. 905, Rev. Stat., but are certified *only* by the clerks of the respective courts.

As appellants have not brought themselves within the provisions of said Sec. 905, Rev. Stat., it would seem obvious that they cannot claim that its construction is involved.

These Proceedings Were Brought Under Section 13 of the Trade-mark Act of 1905.

"Sec. 13. That whenever any person shall deem himself injured by the registration of a trade-mark in the patent office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The Commissioner shall refer such application to the examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the Commissioner shall cancel the registration. Appeal may be taken to the Commissioner in person from the decision of Examiner of Interferences.

"Cancellation is authorized by Section 13 of the Trade-Mark Act if it appears upon application therefor by any person deeming himself injured by the registration:

"1. That the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or

"2. That the mark was not used by the registrant, or

"3. That it has been abandoned. * * *.

"The right to use referred to in the first of the above conditions is believed to mean the right of exclusive use. The use referred to in the second condition is clearly a use of a mark

as a trade-mark for the goods mentioned in the registration." *Pioneer Suspender Co. vs. Louis Oppenheimer's Sons*, C. D. 1907, 144.
Illinois Hydraulic Cement Co. vs. Utica Hydraulic Cement Co., 120 O. G. 2505.
Magic Curler Co. vs. Porter, C. D. 1907, 163.
E. T. Fraim Lock Co. vs. Reading Hardware Co., C. D. 1909, 29

The Court of Appeals of the District of Columbia has repeatedly decided to the same effect; see opinion in cases now at bar.

"The remedy (cancellation for trade-mark registrations improvidently granted) is full, fair, and summary, with appeal from the Examiner to Commissioner, and with no time limit for the application." *Planten vs. Gedney*, 221 Fed. (C. C. A.) 281, 284.
E. T. Fraim Lock Co. vs. Reading Hardware Co., C. D. 1909, 29.

Registration is Solely a Statutory Right.

All provisions for the registration of trade-marks are purely statutory and may be modified or entirely withdrawn, at any time, at the will of the legislature. The Trade-Mark Act is nothing more than a law respecting a public policy for the encouragement of industry.

Registration confers no title; *prima facie*, it accords the mark the right of record and the benefits of the statute. The cancellation section follows the principles of the common law applicable to trade-mark good at common law, viz: the mark must be such a mark as may be exclusively appropriated, the registrant must be the user of the mark and entitled to its *exclusive* use both at the time of its adoption and at the time of applying for its registration, and registrant's right to it and to its record ceases upon its abandonment.

There is no vested right, or vested right of property, in a trade-mark registration and registration creates no new right or title.

Walders vs. International Mfg. Agency, 237 Fed. (C. C. A.) 502, 506.
Dyer Quarry Co. vs. Schuylkill Stone Co., 185 Fed. (C. C. A.) 557.
United Drug Co. vs. Theo. Rectanus Co., 248 U. S. 90.
Hanover Star Milling Co. vs. Metcalf, 240 U. S. 403.
Trade-Mark Cases, 100 U. S. 82, 92.
Stephano Bros. vs. Stamatopoulos, 238 Fed. (C. C. A.) 89, 91.
Phillips vs. Hudnut, 263 Fed. (App. D. C.) 643.
Aunt Jemima Mills Co. vs. Rigney, 247 Fed. (C. C. A.) 407, 409.

Appellants cannot be deprived, in a legal sense, of rights pertaining to registration if they were never entitled to registration.

"Ten Year" Clause not Involved.

The "ten year" clause of Sec. 5 of the Trade-Mark Act of 1905 is not involved, for the reason that use is not claimed by appellants prior to December 15, 1896.

Section 13 of the Trade-Mark Act of 1905 Plainly Provides for the Cancellation of the Registration of any Trade-Mark (if the Conditions Specified Exist) Irrespective of When Registered.

The wording of the statute clearly includes registrations made under the Trade-Mark Act of 1881. Such has always been the construction placed on the statute by the repeated rulings of the patent office and of the Court of Appeals of the District of Columbia.

Stamatopoulos vs. Stephano Bros., 41 App. D. C. 590.

Great Bear Springs Co. vs. Bear Lithia Springs Co., 47 App. D. C. 434; certiorari denied, 247 U. S. 505.

Fulton Water Works Co. vs. Bear Lithia Springs Co., 47 App. D. C. 437; certiorari denied, 247 U. S. 506.

Black Betsy Coal Co. vs. Hamilton Coal Co., 197 O. G. 998; 4 Trade-Mark Rep. 75.

Therefore,

"the case would seem to be brought within the rule announced at a very early day in this Court, and reiterated in a very large number of cases, that the construction given to a statute by those charged with the execution of it is always entitled to the most respectful consideration and ought not to be overruled without cogent reasons." *Heath vs. Wallace*, 138 U. S. 573, 582, and "unless it is clear that the departmental construction is obviously or clearly wrong."

Jacobs vs. Pritchard, 223 U. S. 200, 214.

United States vs. Hammers, 221 U. S. 220.

United States vs. Finnell, 185 U. S. 236, 244.

United States vs. Sweet, 189 U. S. 471, 472.

United States vs. Union Pac. Rwy., 148 U. S. 561, 572.

Ekin vs. United States, 142 U. S. 651, 660.

Pollack vs. Bridgeport Steamboat Co., 114 U. S. 411.

United States vs. Cerecedo Hermanas Y Co., 209 U. S. 338.

United States vs. Alabama G. S. R. Co., 142 U. S. 615, 621.

Hewitt vs. Schultz, 180 U. S. 139, 157.

Section 13 of the Trade-Mark Act of 1905 is Free From Ambiguity and Unmistakably Plain.

"When the intention of the legislature is so apparent from the face of the statute that there can be no question as to the meaning, there is no room for construction.

"It is not allowable to interpret what has no need of interpretation."

Hamilton vs. Rathbone, 175 U. S. 414.
Yerke vs. United States, 173 U. S. 439.
Lake Co. vs. Rollins, 130 U. S. 670.

"The legislature must be understood to mean what it has plainly expressed and this excludes construction." *Swartz vs. Siegel*, 117 F. (C. C. A.) 13, 18.

"If the language is clear it is conclusive. There can be no construction where there is nothing to construe." *United States vs. Hartwell*, 6 Wall. 385, 396.
United States vs. Goldenberg, 168 U. S. 95.
United States vs. Ninety-nine Diamonds, 139 Fed. (C. C. A.) 961.
Lewis vs. United States, 92 U. S. 618.

"But when the act is clear upon its face, and when standing alone is fairly susceptible of but one construction, that construction must be given it. Indeed, the cases are so numerous in this court to the effect that the province of construction lies wholly within the domain of ambiguity that an extended review of them is quite unnecessary." *Hamilton vs. Rathbone*, 175 U. S. 414, 421.

"I see no reason why Section 13 of the Trade-Mark Act of 1905 should not be held to apply to trade-marks registered under the earlier act. Section 13 does not alter in any way the right of a registrant to his mark, but merely provides a new remedy in case a trade-mark is registered by a party who never had or who has abandoned any right thereto.

"The language in Section 13 is broad enough to cover registrations under the earlier act, and there is no reason for limiting its plain meaning. The registration confers the privilege of suing in a particular court and may be used to make out a *prima facie* case of ownership. Where no fundamental right exists this privilege and advantage should not be enjoyed, and the legislature may properly provide a method of cancelling the registrations." *Black Betsy*

Coal Co. vs. W. J. Hamilton Co., 4 T. M. 75, 76, 197 O. G. 998.

"It would have been easy to say" had there been such an intention.
Baltimore, etc., R. Co. vs. Grant, 98 U. S. 403.
United States vs. Detroit Nat. Bank, 234 U. S. 245.

It is only by reference to the earlier Trade-Mark Act that any question can be raised to talk about That such reference avails nothing is shown by the repeated decisions of this Court.

> "The whole doctrine applicable to the subject may be summed up in the single observation that prior acts may be resorted to, *to solve*, but not *to create*, an ambiguity." *Hamilton vs. Rathbone*, 175 U. S. 414, 421, and cases cited.

Section 13 of the Trade-Mark Act of 1905 is Plainly Remedial

Said Section 13 takes away no right or defense on the merits. It creates no new right. It provides a remedy to redress an obvious existing wrong—and nothing more. It has been repeatedly decided by this Court, and was well established prior to *Sampeyreac vs. United States*, 7 Peters 222, that the retrospective operation of a law providing a remedy forms no objection to it. That said Section 13 is remedial is obvious on its face; a reference to the files of Congress puts the matter beyond question. Its first appearance is believed to have been in 1900 (then substantially in its present form). Concerning it the Commissioners said:

> "Section 13 provides for the cancellation of registration. Under the existing practice of many foreign countries, registration here must precede registration by a citizen of the United

> States there. The registration here is evidenced in the foreign country by a certified copy, and nothing except the refusal of the Commissioner of Patents to furnish a certified copy stands in the way of the use by a wrongful registrant of his registration here to obtain registration abroad; besides, the wrongful registration may be made use of to deceive."
>
> *Report of Commissioners Appointed to Revise the Statutes*, Senate Doc. No. 20, 56 Congress, 2nd Sess., p. 81, Nov. 27, 1900.

Section 13 being remedial will be "most liberally" construed to suppress the mischief, redress the existing wrong and advance the remedy.

> *Betchel vs. United States*, 101 U. S. 597.
> *Smithmeyer vs. United States*, 147 U. S. 358.
>
> "Where the statute acts upon the offender, and inflicts a penalty, as a pillory or a fine, it is then to be taken strictly; but when the statute acts upon the offense, by setting aside the fraudulent transaction, here it is to be considered liberally."
>
> 1 *Blackstone*, Com. 88; quoted with approval in *Smith vs. Townsend*, 148 U. S. 490, 497, 498.

There is no prohibition against retrospective or retroactive laws, generally, but only *ex post facto* penal or criminal laws.

> "Now it has been solemnly settled by this Court, that the phrase *ex post facto* laws is not applicable to civil laws, but only to penal and criminal laws, which punish no party for acts antecedently done which were not punishable at all, or not punishable to the extent or in the manner prescribed. In short, *ex post facto* laws relate to penal and criminal proceedings which impose punishments or forfeitures, and not to civil proceedings, which affect private rights retrospectively" (cases cited). *Watson*

vs. Mercer, 8 Peters 88, 109, 110 (Story, J.).
Wilkinson vs. Leland, 2 Peters 627.
Drehman vs. Stifle, 9 Wall. 595.
Henry vs. Speer, 201 Fed. (C. C. A.) 869.

Where the subject-matter is within the plenary power of Congress, subject only to the Constitution, remedial legislation cannot be questioned unless it is a violation of some provision of the Constitution.

Stephens vs. Cherokee Nation, 174 U. S. 445, 478.
Boske vs. Comingore, 177 U. S. 459, 468.

The Existence or Scope of a Power or Duty of an Officer of the United States, or an Authority Exercised Under the United States, is not Drawn in Question Here.

The claim of right of appeal, involving the above, is based upon the denial that the Commissioner of Patents has authority or power to cancel a trade-mark registration made under the Trade-Mark Act of 1881; that is, that Section 13 of the Trade-Mark Act of 1905 did not authorize such cancellation.

In *United States ex rel. South Carolina vs. Seymour, Commissioner of Patents*, 153 U. S. 353, the Commissioner of Patents had refused to register "Palmetto," as a Trade-Mark for liquors under the Trade-Mark Act of 1881, on application of the State of South Carolina, upon the ground that that state had no authorized trade outside of its own limits, was not the owner of any trade-mark and had not the right to the use of the trade-mark sought to be registered. Thereupon South Carolina petitioned the Supreme Court of the District of Columbia for a writ of mandamus to compel the Commissioner of Patents to register the trade-mark, which petition was granted. Upon appeal, the Court of Appeals of the District of Columbia reversed the judgment and dismissed the petition.

On writ of error, this Court held that:

> "In the light of previous decisions of this Court, it is quite clear that there was not 'drawn in question the validity of a treaty or statute of or an authority exercised under the United States.'
>
> "In order to come within this clause the validity, and not the construction only, of a treaty or statute of the United States, or of an authority exercised under the United States, must be directly drawn in question" (p. 358).

A number of decisions of this Court are analyzed (see quotation below), this Court stating that all that was drawn in question was whether there was or was not error in the administration of the statute and the *extent* of the authority claimed under it; not the validity of the statute, but only its construction and the *nature* and *extent* of the Commissioner's authority under it, the Court concluding (p. 360):

> "Nor was the existence or the lawfulness of the authority conferred by that act upon the Commissioner of Patents drawn in question. But from the beginning to the end of the proceedings the only controversy was as to the construction of the Act of Congress, and consequently as to the nature and extent of the Commissioner's authority. Neither the question whether the Commissioner rightly decided upon the presumptive lawfulness of the right of the State of South Carolina to the trade-mark sought to be registered, nor the question whether the Commissioner's duty was of such a character that a writ of mandamus would lie to compel its performance, involved a question of the validity of the authority exercised by him under the United States.
>
> "Writ of error dismissed for want of jurisdiction."
>
> "In *Snow vs. United States*, 118 U. S. 346, 363, in which it was contended that a court

established by Act of Congress * * * went beyond the authority which it (the Act) conferred, it was held that all that was drawn in question was whether there was or was not error in the administration of the statute, and not 'the validity of an authority exercised under the United States,' within the meaning of the Act of March 3, 1885, Chap. 355."

"In *Baltimore & P. R. Co. vs. Hopkins*, 130 U. S. 210, the question was whether a railroad corporation authorized by Acts of Congress to establish freight stations, and to lay as many tracks 'as its president and board of directors might deem necessary,' in the District of Columbia, had the right to occupy a public street for the purposes of a freight yard. It was argued that the validity of an authority, exercised under the United States, to so occupy the public streets was drawn in question. But this Court held that only the construction of the Acts of Congress, and the extent of the authority claimed under them, and not the validity, either of the statutes or of the authority, was drawn in question; or, in other words, it was 'a case which depends only on a judicial construction of an Act of Congress, there being no denial of the power of Congress to pass the act, or of the right to enjoy whatever privileges are granted by it.' *Clough vs. Curtis*, 134 U. S. 361, 370."

"In *United States vs. Lynch*, 137 U. S. 280, in which the Court below had denied a writ of mandamus to compel accounting officers of the Treasury to allow a claim for mileage, it was contended that under the Acts of Congress, and the construction given them by previous decision of this Court, the duty of the accounting officers 'was merely ministerial, and that by the disallowance of the relator's claim for mileage these officers exercised a discretion which they did not possess; that this was an invalid exercise of an authority under the United States; and that hence the validity of the authority was drawn in question.' To

> which this Court, speaking by the *Chief Justice*, answered: 'In order to justify this position, however, the validity of the authority must have been drawn in question directly and not incidentally. The validity of a statute is not drawn in question every time rights claimed under such statue are controverted; nor is the validity of an authority, every time an act done by such authority is disputed.'" *United States vs. Seymour*, 153 U. S. 353, 358, 359.

Durham vs. Seymour, Commissioner of Patents, 161 U. S. 235, was an appeal from a decree of the Court of Appeals of the District of Columbia affirming a decree of the Supreme Court of that district dismissing a bill in equity brought by Durham against the Commissioner of Patents to obtain a patent under Rev. Stat., Sec. 4915. In dismissing the appeal for want of jurisdiction, this Court said (p. 237):

> "It is essential to our jurisdiction that it should appear that the matter in dispute in the courts below was money to an amount exceeding $5,000 exclusive of costs, or some right the value of which could be ascertained in money and exceeded that sum; or that the validity of a patent or copyright was involved or of the validity of a treaty or statute of, or an authority exercised under, the United States was drawn in question."

In all the cases cited (*supra*, and others mentioned therein) this Court held that it was without jurisdiction to review.

Applying the principles of the cases cited (*supra*) to the cases at bar, the result is that "an authority exercised under the United States" is not drawn in question here, but merely the *construction* of the Trade-Mark Act of 1905, and the *extent* of the authority exercised thereunder; that for this Court to have jurisdiction to review the decisions at bar on

the ground that "an authority (or power) under the United States is drawn in question," there must be a complete denial of the authority or power of Congress to authorize the cancellation of trade-mark registrations (that is to enact Section 13 of the Trade-Mark Act of 1905), or a denial that said Section 13 was ever enacted by Congress. No such claims are made at bar, and it is obvious that if such claims were made they would be without merit.

3. Appellants, lastly, claim the right of appeal on the ground that the Court below failed to give "full faith and credit" to the records and proceedings in a suit in the Second Circuit between the same parties.

The Nature of the Suit in the Second Circuit.

After most of the testimony had been taken in these cancellation proceedings, The Baldwin Company brought an action against the R. S. Howard Company in the United States District Court for the Southern District of New York. This action (as stated by the Court in its decision) was

> "For infringement of Trade-Mark No. 31,411, registered March 8, 1898; also Trade-Mark No. 46,993, registered October 17, 1905; also the name 'Howard' as a common-law trade-mark for pianos and for unfair competition in that the defendant uses, or threatens to use, the name 'Howard' in marking and in connection with the sale of pianos, as distinguished from the name 'R. S. Howard Company,' 'R. S. Howard Co.,' or 'R. S. Howard' * * * The prayer of the bill is for the usual relief, and in addition that defendant be enjoined from further prosecuting certain cancellation proceedings now pending in the Patent Office in respect to said two trade-marks" (Rec., p. 2633, fol. 2706).

At the trial, the claim of infringement of the trade-mark registrations was withdrawn from consideration of the Courts (see opinion of the Circuit Court of Appeals, Rec., p. 2645, fol. 2734).

The Suit in the Second Circuit Involved Unfair Trade Competition Solely, and that Issue was the Only Issue or Controversy Determined.

The difference between causes of action based upon rights inherent in a valid and registrable trade-mark and those involved in unfair trade competition cases have been frequently pointed out:

Elgin Watch Co. vs. Illinois Watch Case Co., 179 U. S. 665;
Standard Paint Co. vs. Trinidad Asphalt Co., 220 U. S. 446;
Laurence Mfg. Co. vs. Tennessee Mfg. Co., 138 U. S. 537;
Hanover Star Milling Co. vs. Metcalf, 240 U. S. 416;
Hamilton-Brown Shoe Co. vs. Wolf Bros. & Co., 240 U. S. 256;
Notasceme Hosiery Co. vs. Straus, 240 U. S. 179;
Scandinavia Co. vs. Asbestos, etc., Works, 257 Fed. (C. C. A.) 937;
Samson Cordage Works vs. Puritan Cordage Mills, 221 Fed. (C. C. A.) 603.

This difference, as applicable to the cases at bar, is well illustrated by:

Thad. Davids Co. vs. Davids, 233 U. S. 461.
In re Hoff, 30 App. D. C. 233; 76 Fed. (C. C. A.) 959;
Hercules Powder Co. vs. Newton, 266 Fed. (C. C. A.) 169.

"The differences between them (trade-mark and unfair competition law) are perhaps as

> well marked by extreme cases under both doctrines as in any other way. The rigid yet far-reaching nature of a trade-mark is well illustrated by *Aunt Jemima, etc., Co. vs. Rigney* (247 F. R. 407), while the possibilties of relief against unfair competition find an extreme example in *Shredded Wheat Co. vs. Humphrey Cornell Co.* (250 F. R. 960)."
> *Hercules Powder Co. vs. Newton*, 266 Fed. (C. C. A.) 169, 174.

> "It is hardly necessary to cite authorities for the doctrine that in cases where the question is simply one of unfair competition in trade it is not essential there should be any exclusive or proprietary right in the words or labels used, in order to maintain the action."
> *Pillsbury-Washburn Flour Mills Co. vs. Eagle*, 86 Fed. (C. C. A.) 608, 628 (see cases cited).

In *Elgin National Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 665, the difference between a cause of action for infringement of a technical trade-mark (one which could be registered under the Act of 1881) and a cause of action for unfair competition, is stated thus (p. 677):

> "In the instance of a lawfully registered trade-mark, the fact of its use by another creates a cause of action. In the instance of the use in bad faith of a sign not in itself susceptible of being a valid trade-mark * * * the whole matter lies *in pais*.
>
> "It is to be observed, however, that the question we are considering is not whether this record makes out a case of false representation, or perfidious dealing, or unfair competition, but whether appellant had the exclusive right to use the word 'Elgin' as against all the world. Was it a lawfully registered trade-mark?
>
> "If the trade-mark were valid, the issue of unfair trade would be unnecessary to decide."

Standard Paint Co. vs. Trinidad Apt. Co., 220 U. S. 446, 457.

"Now a trade-mark, clearly such, is in itself evidence, when wrongfully used by a third party, of an illegal act. It is of itself evidence that the party intended to defraud, and to palm off his goods as another's."
Lawrence Mfg. Co. vs. Tenn. Mfg. Co., 138 U. S. 537, 549.

"The intent to deceive is presumed in the case of infringement of a trade-mark, while in cases of unfair competition, the intent must be proved, or what amounts to 'palming off' defendant's goods for complainant's (*Lawrence Mfg. Co. vs. Tenn. Mfg. Co.*, 138 U. S. 537, 549; *Elgin Watch Co. vs. Illinois Watch Co.*, 179 U. S. 665, 674; *Sampson Cordage Works vs. Puritan Mills*, 211 Fed. [C. C. A.] 603, 608; *Gaines & Co. vs. Turner-Looker Co.*, 204 Fed. [C. C. A.] 553, 556)."
Peninsular Chemical Co. vs. Levinson, 247 Fed. 658.

"In the case of infringement of a technical trade-mark the intention of the infringer is immaterial, as the essence of the wrong lies in the injury to a property right; while in the case of unfair competition the intention is material, to establish fraud on the part of the defendant in the use of the imitative device to beguile the public into buying his goods as those of his rival. In the former case fraud, if material, is presumed; while in the latter the complainant must prove a fraudulent intent, or show facts and circumstances from which it may reasonably be inferred."
Goldsmith vs. Savage, 229 Fed. (C. C. A.) 623.
Scandinavia Belting Co. vs. Asbestos, etc., Works, 257 Fed. (C. C. A.) 937.

The Records and Proceedings in the Suit in the Second Circuit were not Authenticated and Proved as Prescribed or Required by Law.

Neither the decree, decision, nor any of the proceedings in the suit in the Second Circuit (in New York), was pleaded in any manner or for any purpose. No judgment roll was produced or offered in evidence. All that appears in these proceedings is a copy of the pleadings, decree, writ and opinions of the two Courts (Rec., pp. 2599-2609, 2611-2646), certified *only* by the clerks of the respective courts, and these copies were offered merely "for the information of the Commissioner of Patents of the issues decided by the District Court," * * * and were admitted in evidence upon a motion contested by this appellee (Rec., pp. 2568-2573).

It is respectfully submitted that the certification by the clerks is not the authentication and proof prescribed or required by law (*Rev. Stat.*, Sec. 905); that when a prior judgment is not pleaded or properly proven, it is not a bar, an estoppel or *res adjudicata.*

> "If a party neither pleads nor proves what has been decided by a Court of competent jurisdiction in some other case between himself and his antagonist, he cannot insist upon the benefit of *res adjudicata,* and this although such prior judgment may have been rendered by the same Court. *Southern Pacific Railroad Company vs. United States,* 168 U. S. 1, suggests nothing contrary to this, for there the prior judgment was offered in evidence, and the only question considered and decided by this Court was the effect of an alleged failure to fully plead *res adjudicata.*"
> *United States vs. Bliss,* 172 U. S. 321, 326.

The Courts in the Suit in the Second Circuit did not Determine any Issues Involved in this Case.

Records and judicial proceedings have only such faith and credit as they have in the courts from which they are taken. If the courts in the Second Circuit determined nothing as to the issues in these proceedings (and those courts expressly and distinctly stated that they did not determine anything) then the whole question of faith and credit falls.

In the suit in the Second Circuit, appellants here asked that the prosecution of these cancellation proceedings be enjoined. Both Courts, *although expressly urged*, refused the injunction and expressly refused to interfere with these proceedings in any manner (Rec., p. 2636, fol. 2721; p. 2645, fol. 2734).

The Courts in the Second Circuit did not pass upon, or determine, the claims of infringement of the trade-mark registrations in suit, or the validity of these trade-mark registrations, or anything determinative of the issues at bar, as affirmatively appears in the opinion of the Circuit Court of Appeals (see quotation below).

Both Courts in the Second Circuit based their decision and decree "solely on principles of unfair competition" and relegated the Baldwin Company "solely to its common-law rights," but decreed that the R. S. Howard Company was entitled to use the name "Howard" as a mark for pianos with the initials "R. S.," or the name "Robert S." prefixed, and the word "Company" or "Co." affixed (Rec., p. 2639, fol. 2722; pp. 2641-42, fols. 2726-7). One of the Judges of the Circuit Court of Appeals was of the opinion that both registrations now sought to be cancelled should be declared invalid (Rec., p. 2646, fols. 2735-6).

The District Court, respecting the issues involved in these cancellation proceedings, said (Rec., p. 2639, fol. 2721):

"I am inclined to think if this Court has the power, it is inadvisable to seek to prevent the continuance of the cancellation proceedings in the (Patent) Office.

"It is plain to me that the object of these (cancellation) proceedings is primarily to get rid of something which constitutes an obstacle to the extension into certain foreign countries (*e. g.*, Cuba and Uruguay) of the business of the R. S. Howard Company.

"I doubt whether under our law the name 'Howard,' being a not infrequent surname and place name, can be appropriated as a strict trade-mark * * * but if he (R. S. Howard) could not make a strict trade-mark out of his own name, I am unable to see how anybody else could do it even with his consent.

"The defendant's counterclaim must be dismissed with costs, and the plaintiff given a decree with costs; but I incline to ground that decree solely on principles of unfair competition, and leave the trade-mark situation to take care of itself." * * *

The Circuit Court of Appeals in its opinion said (Rec., p. 2645, fol. 2734):

"The appellee's (the Baldwin Company) brief contains the following:

"'The appellant's brief attacks the plaintiff's right to its trade-mark registrations, but the validity of the registrations is not in issue in the case. At the final hearing below, plaintiff did not claim infringement of its registrations and confined its charge of infringement solely to its common-law rights in the name "Howard" and Judge Hough, at the close of his opinion said:

"'"I incline to ground that decree solely on principles of unfair competition and leave the trade-mark situation to take care of itself; but upon this point I am willing to hear further argument if the matter is pressed, as it was not much alluded to in argument."

> "'The matter was not pressed by either side and therefore there is no finding about it in the decree. It was evidently the opinion of the Court below that all questions concerning the validity of the registrations should be left to the cancellation proceedings instituted by the R. S. Howard Company in the Patent Office and now about to come to final hearing there.'"

The foregoing extracts from the decisions in the Second Circuit conclusively show that nothing whatsoever was there decided or determined respecting the issues at bar, and that "full faith and credit" are not involved.

The Subject-matter in Dispute at Bar is not the Right to the Name "Howard," as a Mark for Pianos, but the Right to Have it Registered.

> "* * * the benefits of the act cannot be availed of if the alleged trade-mark is not susceptible of exclusive ownership as such, and not, therefore, of registration."
> *Elgin Nat. Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 665, 672.

The same argument, as is now presented by appellants at bar, was urged before this Court and before the United States Circuit Court of Appeals, in *Standard Paint Company vs. Trinidad Asphalt Company* (the *"Rubberoid"* case, *supra*). The contention there was, as the contention here is, that the appellant was entitled "to appropriate the exclusive use of" a name incapable of exclusive appropriation, and appellant there, as here, claimed "that its rights were to be adjudged accordingly." In the *Rubberoid* case, this Court and the Circuit Court of Appeals squarely met such argument and contention and held that as the name claimed as an *exclusive* mark was not such as could be *exclusively* appropriated, appellant's argument and contentions were without merit.

As this Court made clear, in principle, in the *"Remington"* case (*Howe Scale Co. vs. Wyckoff, etc., supra*), in the *"Webster"* dictionary case (*Merriam Co. vs. Syndicate Pub. Co., supra*), and in the *"Rubberoid"* case (*supra*), a private monopoly (that is, a trade-mark registration) of the common surname "Howard" cannot exist under the circumstances of the cases at bar.

The same argument was also urged at length before the United States Circuit Court for the Second Circuit in the very recent case of *Hercules Powder Company vs. Newton, Commissioner of Patents, infra;* the answer of the Court, that such contentions and argument were without merit and were immaterial, fully appears from the quotation below.

Hercules Powder Co. vs. Newton, Commissioner of Patents, supra, was an action under Sec. 4915, Rev. Stat., to procure registration of "Infallible" as a trade-mark for powder. In refusing registration the Circuit Court of Appeals said (266 Fed. 169, 170, 171):

> "Plaintiff has, we think, sought to complicate the issue by pressing upon us as a fact proven beyond doubt, that dealers and buyers of powder do not associate 'Infallible' with that explosive except as indicative of its origin—'Infallible' means made by Hercules Co.
>
> "If this be true, it doubtless strengthens plaintiff's rights against infringements or trespassers; it shows the existence of a business to which the mark is appurtenant, and tends to prove rights which should be protected from unfair, *i. e.*, deceptive competition. * * *
>
> "Therefore, the evidence offered by plaintiff (as to unfair trade competition and the decree based solely on unfair trade issues) is immaterial, and we regard the case as presenting nothing but an inquiry as to the meaning of a statute."

In re Hoff, supra, is identical in principle with the cases at bar. In the *Hoff* case it was sought to register "Hoff's" as a trade-mark for malt extracts. Prior to the application to register, applicant had sued Tarrant & Company (79 Fed. [C. C. A.] 959) to enjoin the use of the name "Hoff's" for malt extracts, and was successful in that the defendants were enjoined from using "Hoff's" except with the prefix "Leopold," it appearing that the extracts sold by Tarrant & Company were made by Leopold Hoff. The Court said (p. 235):

> "The suit, however, against Tarrant & Company, did not involve use of the word as a trade-mark, but was to prevent unfair competition. This leaves the question open for our consideration, whether the word 'Hoff's' and the words 'Leopold Hoff's,' when applied to malt extracts, are so nearly similar as to create confusion in trade. A trademark is determined by its dominant feature. In these marks, the word 'Hoff's' is the dominant feature; and we think the goods marked 'Hoff's Malt Extract' might easily be mistaken by the purchasing public for the goods of Leopold Hoff; on the other hand, the goods of Leopold Hoff might be mistaken for the goods of appellant. Applying the rule announced by this Court in *Kentucky Distilleries & Warehouse Co. vs. The Old Lexington Club Distilling Co., supra,* neither the mark 'Hoff's' nor the mark 'Leopold Hoff' are entitled to registration. * * * Where two marks are so nearly identical as to tend to confuse and mislead the public, neither is entitled to registration, even under the ten-year clause of the Act of 1905."

As it Affirmatively Appears from the Opinions of the Courts in the Suit in the Second Circuit (Which Suit was for a Different Cause of Action) that Nothing Material to the Matters in Issue at Bar was There Determined, the Opinions and Decree There Cannot Constitute a Bar or Estoppel Here.

"But where the second action between the same parties is upon a different claim or demand, the judgment in the prior action operates as an estoppel only as to those matters in issue or points controverted, upon the determination of which the finding or verdict was rendered. In all cases, therefore, where it is sought to apply the estoppel of a judgment rendered upon one cause of action to matters arising in a suit upon a different cause of action, the inquiry must always be as to the point or question actually litigated and determined in the original action; not what might have been thus litigated and determined. Only upon such matters is the judgment conclusive in another action.

"These cases, usually cited in support of the doctrine that the determination of a question directly involved in one action is conclusive as to that question in a second suit between the same parties upon a different cause of action, negative the proposition that the estoppel can extend beyond the point actually litigated and determined. The argument in these cases, that a particular point was necessarily involved in the finding in the original action, proceeded upon the theory that, if not thus involved, the judgment would be inoperative as an estoppel.

"* * * On principle a point not in litigation in one action cannot be received as conclusively settled in any subsequent action upon a different cause, because it might have been determined in the first action. * * *

"There is nothing in this language applied to the facts of the case which gives support

> to the doctrine that, whenever in one action a party might have brought forward a particular ground of recovery or defense, and neglected to do so, he is, in a subsequent suit between the same parties upon a different cause of action, precluded from availing himself of such ground."
>
> *Cromwell vs. Sac County*, 94 U. S. 351, 353, 356, 358.

It must appear by the record, or by parol evidence in addition thereto, that the successful party in the former action prevailed upon the very issue in support of which he offers the record in evidence.

> "It is undoubtedly settled law that a judgment of a Court of competent jurisdiction, upon a question directly involved in one suit, is conclusive as to that question in another suit between the same parties. But to this operation of the judgment it must appear, either upon the face of the record or be shown by extrinsic evidence, that the precise question was raised and determined in the former suit. If there be any uncertainty on this head in the record * * * the whole subject-matter of the action will be at large, and open to a new contention, unless this uncertainty be removed by extrinsic evidence showing the precise point involved and determined. * * *
>
> "* * * to render the judgment conclusive, it must appear by the record of the prior suit that the particular matter sought to be concluded was necessarily tried or determined; that is, that the verdict in the suit could not have been rendered without deciding that matter; or it must be shown by extrinsic evidence, consistent with the record, that the verdict and judgment necessarily involved the consideration and determination of the matter. * * *
>
> "According to Coke, an estoppel must 'be certain to every intent'; and if upon the face of a record anything is left to conjecture as to what was necessarily involved and decided, there is no estoppel in it when pleaded, and

> nothing conclusive in it when offered as evidence." *Russell vs. Place*, 94 U. S. 606, 608, 610.

A judgment or decree is not conclusive "of any matter to be inferred by argument from the judgment." *Dutchess of Kingston Case, 2 Smith, Leading Cases, 7th Am. Ed. 610.*

> "The point of controversy must be the same in both cases." *Hughes vs. United States*, 71 U. S. 4 Wall. 232.

To make a judgment an estoppel it must appear that the "peculiar controversy sought to be concluded" was tried and determined. *Steam Gauge, etc. vs. Meyrose*, 27 Fed. 213 (Brewer, J.).

> "Now, it is the essence of estoppel by judgment that it is certain that the precise fact was determined by the former judgment." *De Sollar vs. Hancome*, 158 U. S. 216, 221.

Questions "neither pleaded or litigated" are not *res adjudicata* or estoppels. *Chanbrun vs. Schermerhorn*, 59 Fed. 504, 508.

> "There must have been a right adjudicated or released in the first suit in order to constitute it a bar, and this must appear affirmatively." *Haldeman vs. United States*, 91 U. S. 584, 586.
>
> "To give the verdict (or judgment) the effect of an estoppel, the facts must be distinctly put in issue." *Richardson vs. City of Boston*, 19 How. 263, 267.

The burden of showing an estoppel or her is on appellants.

> *In re White*, 45 Fed. 239.
> *Southern Minn. Ry. vs. St. Paul, etc., R. Co.*, 55 Fed. 594, 595.
> *Lewis vs. Ocean Co.*, 125 N. Y. 348.
> *Zoeller vs. Riley*, 100 N. Y. 107.

Allegations of the Application to Cancel Registration No. 31,411.

The R. S. Howard Company applied to cancel Registration No. 31,411 on the ground that registrant was not entitled to the use of the mark or to register the mark at the date of its application for registration, in that:

(1) Registrant (or its predecessors in business) was not the first to adopt and use the name "Howard" as a trade name and mark for pianos, but that applicant's predecessor in business, Robert S. Howard, was the first to adopt and use the name "Howard" as a trade name and mark for pianos, and that the applicant to cancel and its said predecessor in business have continuously used the name "Howard" as a trade name and mark for pianos since such first adoption and use, which was long prior to the time when registrant claims to have first adopted and used said mark.

(2) Registrant, prior to its application to register same, had never used the mark in commerce between the United States and foreign nations or Indian tribes.

(3) Registrant had never used the mark prior to its application to register same, or at any time.

(4) The principal feature of the mark is the word "Howard," an individual or proper name, a common surname, and also a common geographical term, which was not registrable under the Trade-Mark Act in force at the date of its registration.

(5) The name "Howard" is the predominating and dominant feature of applicant's corporate name, and registrant or its successors in business had never made use of the name "Howard" as a trade-mark for pianos prior to the date of applicant's incorporation.

(6) The mark is not used by the registrant or its successors in business, but has been abandoned by registrant and its successors in business.

Allegations of the Application to Cancel Registration No. 46,993.

The R. S. Howard Company applied to cancel Registration No. 46,993, on the ground that registrant was not entitled to the use of the mark, or to register the mark, at the date of its application for registration thereof, in that:

(1) Registrant or its predecessors in business were not the first to adopt and use the name "Howard" as a trade name or mark for pianos, but that applicant's predecessor in business was the first to adopt and use the name "Howard" as a trade name and mark for pianos, and applicant and its predecessor in business have continuously used the name "Howard" as a trade name and mark for pianos since such first adoption and use, which was long prior to the time when registrant or its predecessor in business claims to have first adopted and used said mark.

(2) The mark consists merely in the name of an individual, a common surname, not written, printed, impressed or woven in some particular or distinctive manner, or in association with the portrait of the individual, is also a geographical term, and not registrable under the Trade-Mark Act in force at the date of its registration.

(3) The registration was obtained by fraud because the statement and declaration forming a part of the application to register the mark were false in that:

(a) The mark had not been continuously used in the business of registrant and its predecessor since December, 1896.

(b) The name "Howard" was never at any time used by registrant, or its predecessors in business, printed or impressed in a particular, distinctive or peculiar manner.

(c) Registrant or its predecessors in business had never made statutory use of the mark prior to its registration; and

(4) The name "Howard" is the predominating and dominant feature of applicant's corporate name, and registrant or its predecessors in business had never made use of the name "Howard" as a trade-mark for pianos prior to the date of applicant's incorporation.

The Answers to the Applications to Cancel.

The answers were in the nature of general denials and alleged that said The Valley Gem Piano Company was the first to adopt and use the name "Howard" as a mark for pianos, and first adopted and used same about December 15, 1896, and that said The Valley Gem Piano Company and its successor, said The Baldwin Company, had used said name "Howard" and said registered marks continuously since about December 15, 1896, as a mark for pianos, the said The Baldwin Company claiming title exclusively through an assignment from said The Valley Gem Piano Company, and as the successor to said The Valley Gem Piano Company, an Ohio corporation, said assignment from said The Valley Gem Piano Company to said The Baldwin Company having been made about December 6, 1901; also that applicant to cancel was not injured.

It is not contended that this respondent failed to allege sufficient facts to show jurisdictional "interest in the subject-matter."

Procedure in Cancellation Proceedings.

Practice and procedure in cancellation proceedings conform as nearly as possible to that of the United States Courts in equity proceedings. *Patent Office*

Rule 55 governing proceedings under the Trade-Mark Acts; Rule 153 of Practice in the United States Patent Office.

The Reasons Shown Why Registration No. 31,411 Should be Cancelled.

1. It stands decided (*Merriam Co. vs. Syndicate Pub. Co.*, 237 U. S. 618; *Howe Scale Co. vs. Wyckoff, Seamans & Benedict*, 198 U. S. 118; *Thad. Davids Co. vs. Davids Mfg. Co.*, 233 U. S. 461; and cases therein cited) that the personal name "Howard," the dominant feature of the mark registered, "is manifestly incapable of exclusive appropriation as a valid trade-mark" or for registration; therefore, "the registrant was not entitled to the use of the mark at the date of his application for registration" (see Section 13, Trade-Mark Act 1905, "use" meaning "exclusive use"; see p. 8 *infra*).

"Howard" is also a common geographical term (see any atlas) and was not registrable under the Trade-Mark Act of 1881. *Elgin Watch Co. vs. Illinois Watch Case Co.*, 178 U. S. 665; *Delaware & Hudson Canal Co. vs. Clark*, 13 Wall 321.

2. It stands conclusively shown by the testimony of The Baldwin Company's own officers and from said company's own records (and there is no contradiction) that the registrant:

(a) Never used the mark in foreign commerce or in commerce with Indian tribes prior to registration, *or at any time.*

The declaration in Registration No. 31,411 was verified November 8, 1897; application was filed November 15, 1897.

Levi D. Sargent (Appellants' factory manager, Rec., p. 1232, Qs. 1-15) testified that no Howard pianos

were shipped to any Indian or Indian tribe during the years 1896 or 1897. (Rec., pp. 763-4, Qs. 22-25) and that the first shipment of a Howard piano to any foreign country was made to Canada on November 29, 1897. (Rec., pp. 1704-6, XQs. 115-121; pp. 1938-40, XQs. 26-37.)

(b) Never used the mark in any manner *at any time*, as it had no business and never did any business *at any time*.

The registrant had no plant. It never made any pianos. It never marked any pianos. It never sold pianos. It never did any work on, or in connection with any pianos. (Rec., p. 1234, Q. 17; p. 1287, Q. 32; p. 1314, XQ. 292, 293; p. 1315, XQ. 297; p. 1259, Qs. 119-123; p. 1238, Qs. 38-40; pp. 1306-7, Qs. 264, 265; pp. 1262-8, Qs. 135-154; pp. 1436-9, Qs. 15, 16, 21-26, 31; p. 1695, Qs. 85, 86; p. 1347, XQ. 445; pp. 1692-6, Qs. 78-88; p. 2389, XQ33; pp. 2389, 90, XQs. 92-102; pp. 2392-4, XQs. 111-118.)

> "There is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed." *United Drug Co. vs. Rectanus Co.*, 248 U. S. 90, 96.
>
> *Hanover Star Milling Co. vs. Metcalf*, 240 U. S. 403, 412-14.

3. It stands decided that Registration No. 31,411 is invalid, as there had been no statutory use of the mark prior to application; also as the registration was obtained by fraud, on false affidavits, it is invalid. *Elgin Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 665; *Warner vs. Searle & Hereth Co.*, 191 U. S. 195; *South Carolina vs. Seymour*, 2 App. D. C. 240; *Bronson Co. vs. Duell*, 17 App. D. C. 471; *Planten vs. Canton Pharmacy Co.*, 33 App. D. C. 268

Statutory Use Prior to Application to Register Must be Shown or Registration is Invalid.

Elgin Watch Co. vs. Illinois Watch Case Co., 179 U. S. 665.
Bronson Co. vs. Duell, 17 App. D. C. 471.
Merriam Co. vs. Syndicate Pub. Co., 237 U. S. 618.
Howe Scale Co. vs. Wyckoff, etc., 198 U. S. 118.
Warner vs. Searle & Hereth Co., 191 U. S. 195, 204, 206.

> "By the 2nd Section (of the Trade-Mark Act of 1881) the application prescribed by the 1st 'must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration' 'that such party has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm or corporation has the right to such use * * * that such trade-mark is used in commerce with foreign nations or Indian tribes, as above indicated * * *'" (See also 3rd Section of the Trade-Mark Act of 1881). *Elgin National Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 665, 671.

In *Bronson Co. vs. Duell*, 17 App. D. C. 471 (a case often cited), the Court considered the Trade-Mark Act of 1881, and said:

> "The phrase 'owners of trade-marks' manifestly limits the right of registration to such person or persons, natural or artificial, as possess the legal title to that for which registration is sought, and it further limits the right of registration to that which is a trade-mark.
> * * * * * *
> "If he (the Commissioner) finds that the 'alleged trade-mark' is the name of the applicant, or any other name which cannot be lawfully converted into a trademark at common law * * * or that it is not the property of the applicant, he cannot admit it to registration *

* *. (Quoting with approval the language used in *Seymour vs. South Carolina*, 2 App D. C. 240.) * * *

"The Commissioner, in office at the time of the passage of the existing law, had no doubt that the lawful right to convert a word or symbol into a trade-mark was intended to remain a prerequisite condition of registration * * *. And that practice has not, since that time, been departed from; until recently, indeed, its soundness seems never to have been questioned. * * *

"Section 3 expressly declares that 'no alleged trade-mark' shall be registered unless the same appear to be *lawfully used as such* by the applicant. (Italics by the Court.) * * *

"In our judgment, then, 'the owners of trade-marks,' who, by the first section, are permitted to obtain registration of the same, are those that, in the manner and under the conditions prescribed, shall have used such words and symbols only as, at common law, are susceptible of exclusive appropriation as trade-marks; and this is one of the essential elements of 'the presumptive lawfulness of claim to the alleged trade-mark'" * * *.

The Court said that if the Commissioner is bound to register anything claimed as a trade-mark, provided the claimant shall have used it in lawful commerce and it be not identical or a deceptive resemblance of the known trade-mark of another, it would follow that Congress must have intended to create lawful trade-marks in words and symbols not capable of appropriation as such at common law, making registration *prima facie* evidence of ownership and infringers liable to the penalties provided by the Act, thereby opening the door to harassing and fruitless litigation and the acquisition of *prima facie* rights of ownership of words and symbols incapable of exclusive appropriation as lawful trade-marks, the Court holding that such was not the intention of Congress and not the proper interpretation of the Act.

> "The Trade-Mark Act of 1881 limits the registration of trade-marks to such only as may have been actually used in commerce with foreign nations or the Indian tribes. A trade-mark that may have been in undisturbed use for years in domestic trade, and invested with all the characteristics of a trade-mark good at common law, is nevertheless not a trade-mark in the sense of this statute unless it shall have been lawfully used in commerce with foreign nations or the Indian tribes." *South Carolina vs. Seymour*, 2 App. D. C. 240.

A certificate of registration cannot be taken as evidence that the requirements of the law have been met. *Smith vs. Reynold*, 10 Blatch. 85.

A Nonregistrable Name, Word, or Term, Does not Become Registrable by Combining it with Registrable Subject-matter.

Nonregistrable names, words or subject-matter must be disclaimed.

> *Estate of Beckwith vs. Commissioner of Patents* 40 Sup. Ct. Rep. 414.
> *Ex parte Farnum & Co.*, 19 O. G. 412.
> *Ex parte Hanes Knitting Co.*, C. D. 1913, 205.
> *In re Crescent Typewriter Co.*, 30 App. D. C. 324.

4. The Baldwin Company claims to be the owner of the registration and mark No. 31,411. It stands admitted by The Baldwin Company's own officers that the mark registered (No. 31,411)has been abandoned. (See Sec. 13 of Trade-Mark Act of 1905.)

George W. Armstrong, Jr. (appellant's president), testified (Rec., p. 2399):

> "XQ173. When was it that you discountinued the initials V. G. P. Co? A. I don't recall.
>
> "XQ174. Well, ten years ago or five years ago, or when? A. I don't recall. I haven't the faintest recollection.

"XQ175. But you don't use that any more? A. No.

"XQ176. You abandoned that? A. Yes.

"XQ177. And it has been several years since you have used them? A. I don't recall when the date was.

"XQ178. When you changed the name of The Valley Gem Company to The Howard Piano Company, didn't you abandon the initials V. G. P. Co.? A. I suppose so; that would be the most natural thing to do.

"XQ179. When you did discontinue it you didn't intend ever to take it up again? A. The V. G. P.—no."

Levi D. Sargent (appellants' factory manager) testified (Rec., p. 762):

"Q14. And when you changed the name of the corporation, did you change the marking on the fall-board from the monogram 'VGPCo.' to 'HPCo.'? A. The monogram was changed just as soon as we could have designs submitted and transfers made.

"Q15. And you ceased to use the marking 'VGPCo.' on it at that time? A. Yes, sir.

"Q16. And never used it any since, on the fall-board? A. Not unless there happened to be some old ones around when the men would get hold of them, not knowing it; there may have been a few used, but none to my knowledge.

"Q17. Did you use the monogram 'VGPCo.' on any other part of the piano after you changed the name of The Valley Gem Piano Company to The Howard Piano Company? A. No, the monogram 'VGPCo.' was not used after that."

(See also Rec., p. 1201, Qs. 162-4; p. 1238, Qs. 35-41; pp. 1277, 1278, Qs. 186-189; pp. 1306-7, Qs. 264, 265; all of appellants' markings are reproduced, *infra*, pp. 86-89.)

The Reasons Shown Why Registration No. 46,993 Should be Cancelled.

1. It stands conclusively shown by the testimony of appellants' own officers that the name "Howard" without the monogram "VGPCo."), had never been used by appellants as a mark for pianos prior to 1912.

The testimony of the officers of The Baldwin Company is that The Baldwin Company and its associated concerns used at different periods four markings, and *four markings only*, for marking their "Howard" pianos, viz: Registrant's Exhibits Nos. 37 and 39 (No. 39 being an impression of No. 37), reproduced at p. 86 *infra;* Registrant's Exhibits Nos. 26 and 40 (No. 40 being a reproduction of No. 26), and reproduced *infra*, page 87; Registrant's Exhibits Nos. 38 and 41 (No. 41 being a reproduction of No. 38) and reproduced *infra*, page 88; and Registrant's Exhibits Nos. 27 and 42 (No. 42 being a reproduction of No. 27) and reproduced *infra*, page 89; (Rec., p. 1238, Qs. 35, 36, 40, 41; pp. 1277, 1279, Q. 186, as to Exhibits 26 and 27; Q. 189 as to Exhibit 38; pp. 1306, 1307, Qs. 264, 265; see also Rec., p. 761, Qs. 9-21; p. 1201, Qs. 162-164; p. 2399, XQs. 173-179).

The above testimony conclusively establishes that the only markings used by appellants for marking "Howard" pianos and piano boxes prior to 1912, were "Howard" with the monogram "VGPCo.," and the name of the City "Cincinnati," identical with Registrant's Exhibit 37, reproduced at page 86 *infra*; that is, that there never was statutory use of the mark registered October 17, 1905, prior to 1912.

The file wrapper and contents of Registration No. 46,993 (Rec., p. 20) shows that in the original application papers the statement and drawing of No 46,993 was substantially identical with the statement and drawing of Registration No. 31,411.

As is shown by the answers and affidavits herein (Rec., p. 1085, par. 1; p. 1090, par. 8; p. 1092, par. 9;

p. 1095, par. 11; p. 1055, par. 8; p. 1058, par. 9; p. 1061, par. 11; p. 20, affidavit), Registration No. 46,993 was based upon the adoption and use of the mark registered by The Valley Gem Piano Company No. 31,411.

Reference to the file wrapper and contents of No. 46,993 (Rec., pp. 16-23) shows that in the original application to register this mark, the mark was described substantially the same as in No. 31,411, "and consists of the arbitrary word 'Howard' in connection with the initials 'VGPCo.' in the form of a monogram." This is followed by a description substantially verbatim to that contained in the statement in Registration No. 31,411, including the following phrase: "The form of lettering of Howard may be differently arranged without materially altering the character of the trade-mark, the principal feature of which is the word 'Howard.'" Use is claimed from the same date as claimed in No. 31,411 (Dec. 15, 1896).

Registration of No. 46,993 was at first refused on the ground, among others, of prior Registration No. 31,411. Whereupon an affidavit of Lucien Wulsin (then president of The Baldwin Company, and formerly president of The Valley Gem Piano Company), verified May 22nd, 1905, was filed and made a part of the application papers (see File Wrapper, Rec., p. 20), and registration requested on the ground that The Baldwin Company was the assignee of the word "Howard" as a trade-mark from The Valley Gem Piano Company, the affidavit stating and claiming that The Valley Gem Piano Company adopted, applied and used the mark until it transferred the same to The Baldwin Company (which was a false statement, both as to the use and the assignment).

The original drawing in the Application No. 46,993 was identical with the drawing in Registration No. 31,411, and the drawing was changed to the word "Howard" alone without a new declaration; this was

improper and without authority of law. *Ex parte Newman*, C D. 1910, 194.

The statement was also materially modified and changed without a new declaration; such changes were without authority of law. *Ex parte Felten & Guilleaume-Lahmeyerwerke Actien-Gesellschaft*, C. D 1910, 7.

The foregoing (which is entirely uncontradicted) shows failure of statutory use.

Statutory Use is a Prerequisite to the Right to Register Under the Act of 1905; the Use of "Howard" with the Monogram 'VGPC' is not Sufficient to Confer Right to Register "Howard" Alone.

Ammon & Person vs. Narragansett Dairy Co., 252 Fed. 276, (and cases cited); Aff. 262 Fed. 880.
Richter vs. Reynolds, 59 Fed. (C. C. A.) 577.
Johnson vs. Brandau, 32 App. D. C. 348.
Planten vs. Canton Pharmacy Co., 33 App. D. C. 268.
Quaker City Flour Mills Co. vs. Quaker Oats Co., 43 App. D. C. 260.
In re Motz Tire & Rubber Co., 40 App. D. C. 487.

In *Corbin vs. Gould*, 133 U. S. 308, complainants had registered a mark "the essential features of which are the symbol of a diamond and the arbitrary selected word 'Tycoon.'" Defendant used "Tycoon" as a part of his label.

> "The trade-mark for tea (No. 9952) registered in the Patent Office by plaintiff's predecessor, was for the combination of the figure of a diamond and the words 'The Tycoon Tea' enclosed in it; and its registration conferred no exclusive right to the use of the word 'Tycoon' considered by itself." Headnote to *Corbin vs. Gould*, 133 U. S. 308.

> "He can register only what he has used." *Elgin Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 665.

In *Quaker City Flour Mills Co. vs. Quaker Oats Co.*, 43 App. D. C. 260, the mark used was "Quaker City Mills" and "Quaker City," while the mark sought to be registered was the word "Quaker." The Court, in refusing registration, said:

> "But the difficulty here is that 'the mark as claimed' has not been used. It is only part of the mark which actually designated the product to which it was applied. * * *
>
> "We think that the law requires that the mark applied for must be the same as the mark shown to have been used. To hold otherwise would permit appellant, in this instance, to convert a mark which the statute prohibits from being registered, because of its geographical signification, into a technical trade-mark by eliminating the word which makes it geographical, while the geographical term is the one which has actually been used. The law will not permit that which it expressly prohibits to be legally accomplished by indirect methods."

In *Planten vs. Canton Pharmacy Co.*, 33 App. D. C. 268, the mark used was "Planten's C. & C. or Black Capsules," which had been registered. In refusing to register "Black Capsules" the Court said:

> "Statutory use of the mark is a prerequisite to the right of registration * * * having described and shown one thing, he cannot, when the exigencies of the situation demand, limit his claim to a particular feature of the original mark. *Johnson vs. Brandau*, 32 App. D. C. 348. * * *
>
> "When, therefore, the Commissioner is satisfied that the applicant is attempting to register a particular feature of a registered mark, he should require evidence that the mark of the application has actually been used as a trade

mark. Not having limited his claims in his original application, the applicant cannot prove statutory use of the mark of the second application by showing such use of the registered mark. In other words, proof of the use of the words, 'Planten's C & C. or Black Capsules' in the case where those words have been registered as a trade-mark, does not establish the use of the words, 'Black Capsules' as a trade-mark, for the words eliminated from the registered mark are, under the prior application, an essential part of that mark.

"There being no evidence in the record of statutory use of the words, 'Black Capsules' as a trade-mark by Planten, the Commissioner should have refused registration to Planten on that ground."

In *Ammon & Person vs. Narragansett Dairy Co.*, 252 Fed. 276 (aff. 262, Fed. 880), the mark used was "Queen of the West"; the mark registered was the word "Queen," and it was shown that the goods were commonly known as "Queen" goods. On complaint of the owner of the registered mark "Queen" the Court held that use of "Queen of the West" did not show statutory use or authorize the registration of "Queen," and refused to hold the defendant guilty of infringement of the registered trade-mark, although the defendant used "Queen" on goods of the same description. The defendant was held guilty of unfair trade.

> "While the plaintiff has registered 'Queen' as its trade-mark, we agree with the Court below that the case must be determined on common law principles, and that no rights now in question have been acquired out of registration." *Ammon & Person vs. Narragansett Dairy Co.*, 262 Fed. (C. C. A.) 880, 881.

2. It stands conclusively shown by the testimony of The Baldwin Company's own officers and by its answers and affidavits, in evidence (see reference to

record under next preceding heading), that the title of The Baldwin Company to the mark registered (No. 46,993) totally fails, in that it claims no rights to this mark *except* as the assignee and successor to the business of The Valley Gem Piano Company. As The Valley Gem Piano Company *at no time* ever had any business or did any business, it had no trade-mark rights and could not acquire any trade-mark rights, and therefore had nothing to transfer.

3. It stands decided that the personal name "Howard" (also a common geographical term), was not registrable under the Trade-Mark Act of 1905, except under circumstances not existing in this case. *Merriam Co. vs. Syndicate Pub. Co.*, 237 U. S. 618; *Thad. Davids Co. vs. Davids Mfg. Co.*, 233 U. S. 461; *Howe Scale Co. vs. Wyckoff, etc.*, 198 U. S. 118.

The Trade-Mark Act of 1905, Sec. 5, *expressly prohibits* registration of a personal name except under circumstances not present in this case. *Rogers vs. International Silver Co.*, 34 App. D. C. 410.

The statutory prohibition relates back to the date of adoption. If it were then "incapable of exclusive appropriation," the validity of its registration may be assailed. *Priority of use* is immaterial, as is shown by cases cited and analyzed (*infra*, pp. 47-50). The Trade-Mark Act (Sec. 2) requires that a registrant ***must be entitled to the exclusive use*** of the mark *at the date of the application* for registration. It follows that the registration was secured in direct violation of the express terms of the Trade-Mark Act (see cases cited, p. 8, *supra*).

4. The mark is not displayed in a particular or distinctive manner. *Oliver Plow Works vs. William J. Oliver Mfg. Co.*, 40 App. D. C. 125. The Baldwin Company does not seriously contend that the mark is

displayed in a particular or distinctive manner. The mark speaks for itself.

It follows from the foregoing that the registrants, as to both registrations, were neither entitled to the "exclusive use" nor the "use" of the marks as trade-marks, at the date of their applications for registration.

In the cases at bar no serious attempt is made to defend the validity of the registration, or to deny that they were improperly and improvidently made without authority of law.

In Opposition Proceedings Under Section 6 and in Cancellation Proceedings Under Section 13 of the Trade-Mark Act of 1905, the Requirements as to "Interest in the Subject-matter" are the Same.

Such has been the repeated decisions of the Patent Office and Court of Appeals of the District of Columbia.

Underwood Typewriter Co. vs. A. B. Dick Co., 36 App. D. C. 175, 178.
Battle Creek Sanitarium Co. vs. Fuller, 30 App. D. C. 411, 415.

In Cancellation and Opposition Proceedings Where the Mark is a Nontechnical Mark, the Questions of "First Use" or "Acquiescence" are Immaterial.

Von Alstyne Co. vs. Boutwell Milling Co., 43 App. D. C. 530.
Duluth Superior Milling Co. vs. Koper, 37 App. D. C. 115.
Heaton-Peninsular Co. vs. Independent Button Fastener Co., 43 App. D. C. 264.

Von Alstyne Co. vs. Boutwell Milling Co., supra, a cancellation case, where the registration was under the

ten-year clause of the words "Upper Hudson" for flour, the registration was cancelled although the *registrant was the first user*. We take the following from the headnote:

> "the Commissioner of Patents properly cancelled the registration * * * on the ground that the dealer had not exclusively used the mark for the ten years * * * (following *Duluth Superior Milling Co. vs. Koper*, 37 App. D. C. 115), irrespective of the questions of first use, abandonment and acquiescence."

In *Duluth Superior Co. vs. Koper, supra*, the registration was had under the ten-year clause of the words "A. A. Freeman & Co." over the word "Superlative," for flour. It was *admitted that the registrant was the first user* and had been the exclusive user for some years prior to any use by the applicant to cancel. Cancellation was granted solely on the ground that the registrant was not the sole and exclusive user during the ten-year period. Priority of use and ownership or title were considered immaterial, and the Court passed these questions without considering them. See *Carroll vs. Duluth Superior Milling Co.*, 232 Fed. (C. C. A.) 675, same mark involved; ruling of the Court of Appeals of the District of Columbia approved.

In *Heaton-Peninsular Co. vs. Independent Button Fastener Co.*, 43 App. D. C. 264, the registrant was the first user and had registered under the "ten-year clause" an illustration of a button fastener as a trade-mark. As the mark was not such a mark as could be properly appropriated or registered, cancellation was granted.

Joseph Lay Co. vs. Indianapolis Brush Mfg. Co., 40 App. D. C. 36, was a proceeding to cancel a trade-mark consisting of a red band around the body of a broom, registered under the ten-year clause, registration of the mark as a technical trade-mark had been

previously refused. Cancellation was decreed although the applicant to cancel did not claim priority of use and adoption but only claimed use during the ten year period.

In *McIlhenny Sons vs. The New Iberia Extract Co.*, 34 App. D. C. 43, the mark sought to be cancelled was "Tobasco" for pepper sauce, adjudged to be a geographical term or name. The registrant was conceded to be the first user. Cancellation was granted as it was improperly registered; registrant not entitled to the exclusive use.

In *Kentucky Dist. & Warh. Co. vs. Old Lexington C. Dist Co.*, 31 App. D. C. 223, it was held that as "Old Lexington Club" was not a technical mark, priority of use was immaterial. Applicant to register was the prior user.

Brown-Forman Co. vs. Beech Hill Distilling Co., 30 App. D. C. 485.
Familton vs. Alonzo Bliss Co., C. D. 1907, 180.
Hansen vs. Inland Type Foundry, C. D. 1908, 122.

"Inasmuch as the ground of opposition is that the mark is descriptive, it matters not whether the opponent's use of it was before or after that of the applicant." *Piston Ring Co. vs. Sta-Tite Packing Co.*, 118 Ms. Dec. 8. *Brakeley vs. Sears & Nichols Co.*, C. D. 1912, 144.

In *Magic Curler Co. vs. Porter*, C. D., 1907, 163, an early cancellation proceeding, the Commissioner said:

"The right registered is a supposed right to exclusive use. The evident intention of Congress was to permit any person deeming himself injured by a registration to question the validity thereof in the Patent Office, and to obtain cancellation thereof if the registrant had no trade-mark right therein at the time

> of his application for registration, or if, having had such a right at that time, he has subsequently lost the same. There is more reason why a party who has himself no trade-mark right, but who is harassed in his business through an improper registration, should be permitted to overthrow that registration than there is for according this relief to one who is the possesser of a trade-mark right. The latter party may obtain relief against injury through the invalid registration by interference proceedings, registration to himself and suit thereon. The former party though liable to the same injury, has not the same opportunity for combating it."

The Patent Office Decisions.

The Assistant Commissioner cited no cases in support of his decision. The Examiner of Interference held that applicant "has no interest in the mark" and relied on the three following cases:

McIlhenny's Sons vs. New Iberia Extract of Tobasco Co., 30 App. D. C. 337, was a case where the petition for cancellation failed to contain any averment that the petitioner had used the mark in question "Tobasco" as a mark for pepper sauce, the Court holding that:

> "The averment that it had used the word as a trade-mark is not sufficient, for the obvious reason that, unless the word had been used in the same business as that in which it was used by appellant, no injury contemplated by the statute would have resulted and no right to intervene would have followed" (p. 340). Such was the ground of this decision.

The *Hump Hairpin Co. vs. De Long Hook & Eye Co.*, 39 App. D. C. 484, was an opposition, where the opposer alleged that it had used the word "Hump" as a trade-mark for hooks and eyes. The

application to register was for the words "The Hump" (with other matter) for hairpins. The Court held, that *hooks and eyes* and *hairpins* were not goods of the same descriptive properties, and as the opposer had shown no use of the word "Hump" on hairpins it could not sustain injury or damage, the Court saying:

> "If he has not used the mark as a trade-mark upon goods of a like description, he can suffer no damage from its registration by another."

In *Standard Brewing Co. vs. Interborough Brewing Co.*, 44 App. D. C. 193, the petition to cancel averred:

> "That the Massachusetts Breweries Company, a third party, has a right to said trade-mark superior to that of appellant" (registrant).

The Court held that:

> "The appellee (applicant to cancel), on its own showing, has no right whatever to the use of this trade-mark. How, then, can it be injured by its registration by the appellant? It is not concerned with the question whether the appellant's right to the mark is superior to that of the third party" (p. 195).

It is respectfully submitted that the foregoing cases, cited, are not in point. Furthermore, there is no suggestion that respondent has not alleged, in good faith, amply sufficient facts to show jurisdictional "interest in the subject-matter." *Fair vs. Kohler Die Co.*, 228 U. S. 22.

The grounds of the Patent Office decisions were, in substance, that, as The Baldwin Company had the right to use the word "Howard" *(simpliciter)*, and this respondent the right to use "R. S. Howard Co.," the registration of "Howard" could not injure or damage this respondent, and its decisions were based largely, if not wholly, on its finding that this respond-

ent had failed to prove any specific damage or actual loss.

By its decisions, the Patent Office ignored the fundamental equity principle, formulated by a long line of decisions, that to show jurisdictional injury and damage in equitable actions it is not necessary to *prove* actual damage; it is sufficient if injury to respondent's business is threatened; respondent is not required to wait until it has suffered actual pecuniary loss or damage.

> "It is sufficient if injury to plaintiff's business is threatened or imminent."
> *T. A. Vulcan vs. Myers*, 139 N. Y. 364, 367.
> *Mfg. Co. vs. Trainer*, 101 U. S. 51.

> "If it is likely to cause confusion" it is sufficient; not necessary to show loss of sales or actual deception.
> *Wm. P. Stark vs. Stark Bros.*, 257 Fed. (C. C. A.) 9.

> "* * * facts showing an interest in the subject-matter from which damage might be inferred."
> *Hump Hairpin Co. vs. De Long Co.*, 39 App. D. C. 484, 490.

> "One who can show an interest in the subject-matter entitling him to claim that he would be damaged by the registration" is entitled to maintain an opposition.
> *Battle Creek Sanitarium Co. vs. Fuller*, 30 App. D. C. 411, 415.

> It is sufficient to show facts "from which damage might be inferred; * * * the likelihood of confusion" is sufficient.
> *Magnolia Cotton Oil Co. vs. Proctor & Gamble Co.*, 120 Ms. Dec. 191.

> "The question is, would its use be likely to result in confusion? If so, it is unregistrable."
> *Proctor & Gamble Co. vs. Ency Shortening Co.*, 278 O. G. (App. D. C.) 369, 370.

It is not required "to show a superior right in order that he may successfully resist the application." If he "can show probable damage, that will be enough."
Atlas Underwear Co. vs. B. V. D. Co., 48 App. D. C. 425, 426.

"The test is whether the use is likely to deceive."
Hilton vs. Hilton, 105 Atl. Rep. (N. J.) 65. Aff. 107 Atl. Rep. 263.

"It was sufficient that it had any rightful use inconsistent with its rival's registration."
Denny Tag Co. vs. Dennison Mfg. Co., 258 O. G. 221, aff. 48 App. D. C. 213

The essence is whether confusion is likely or probable.

"The conflict implies damage not only to the party * * * but to the public." *N. Wolf & Sons vs. Lord & Taylor*, 41 App. D. C. 514, 516.

"The likelihood of confusion depends as much upon the probability of the future as upon the experience of the past." *Wadsworth Howland & Co. vs. Trussed Concrete Steel Co.*, 48 App. D. C. 592, 593.

"The statute is prospective, in that it forbids the registration of a mark which is *likely* to create confusion in the public mind, or is *likely* to deceive purchasers. It is not necessary that actual confusion be shown; the mere probability of confusion is sufficient." Italics are by the Court. *Rookwood Pottery vs. Wilhelm Co.*, 43 App. D. C. 1.

"There is no testimony as to any actual confusion in trade, by reason of the opposing marks. Looking at the marks, it would seem

that there is such a similarity as would probably tend to confusion in trade." This held to be sufficient "interest in the subject-matter." *Nofsiger vs. Schulze Baking Co.*, 46 App. D. C. 292.

In the very recent case of *Goodrich Drug Co. vs. Cassada Mfg. Co.*, 46 App. D. C. 146, a cancellation case, where no actual confusion in trade was shown, the conflicting marks being "Velvelite" and "Velvetina" for face powder, this Court said:

> "The decision, after all, must be based largely upon the impression conveyed to the mind of the Court as to the probable result of the use of these marks upon the same kind of goods. That it would be likely to lead to confusion we have no doubt. But if a doubt existed, it should be resolved for the protection of the public, in whose interest the prohibition of the statute as to the registration of trade-marks likely to create confusion in trade was enacted." Cancellation granted.

> "Opposer is not bound to establish damages in order that he may succeed. It is sufficient for it to show that the applicant's mark would be 'likely to cause confusion or mistake in the mind of the public * * *.' (Sec. 5, 33 Stat. L. 725; *Patton Paint Co. vs. Orr's Zinc White, Ltd.*, 48 App. D. C. 223; *Thomas Manufacturing Co. vs. Aeolian Co.*, 47 App. D. C. 378.)" *William Waltke & Co. vs. George H. Schafer & Co.*, 263 Fed. (App. D. C.) 650, 652.

Business History of R. S. Howard Co.

R. S. Howard Company was organized as a New York corporation in April, 1902; succeeded to the business, goodwill and name of Robert S. Howard, acquired a factory in New York City, and began the manufacture and sale of pianos marked "Howard," "R. S. Howard Co.," commonly called "Howard" pianos (Rec., p. 200, Qs. 5-8; p. 248, XQs. 203-5; p. 251).

Robert S. Howard's Business History.

1877 to 1889: Robert S. Howard became a piano salesman in 1877 and continued until 1889 to sell pianos, at retail on his own account and at wholesale in the principal cities of the United States as representative of leading piano manufacturers, such as John Church & Co., Cincinnati; Chickering & Sons, of Boston; Hallett & Comston, of Boston; Sohmer & Company, of New York; during this period he became proficient in piano tuning, piano tone regulating, piano action regulating, the details of piano manufacture, and a practical piano manufacturer (Rec., p. 173, Q124; p. 2417, Qs. 81, 82; p. 85, XQ140; p. 201, Qs. 12, 13).

August, 1889, to December 31st, 1892: In August, 1889, Robert S. Howard became connected with the New England Piano Company, of Boston, one of the largest piano manufacturing concerns in the country, and continued this connection until December 31, 1892. At the outset of his connection with the New England Piano Company, Mr. Howard spent some time about their factory suggesting improvements in construction, methods of manufacture, design, etc., and arranged to have pianos manufactured by that concern marked with his own name "Howard" (Rec., p. 203, Qs. 15, 16), "it was a part of the arrangement" (Rec., p. 2409, Q34). These "Howard" pianos, in addition to the regular lines of the New England Company, Mr. Howard sold to his trade, old customers and acquaintances in the piano business throughout the United States and Canada (Rec., p. 204, Qs. 17, 18).

These pianos were marked, beginning in 1889, "Howard, New York," "R. S. Howard & Co., Boston"; also "Howard & Co., Boston," beginning in 1893 (Rec., pp. 199-203, Q. 6-21).

January 1, 1893, to 1896: Robert S. Howard was connected with J. & C. Fischer, piano manufacturers, of New York, selling their product all over the United States, and also selling "Howard" pianos for his own account and risk, made by the New England Piano Company (Rec., pp. 206-208, Qs. 30-36; pp. 2481-2, XQs. 223- 230). These "Howard" pianos were supplied to Mr. Howard at a fixed factory price, Mr. Howard guaranteeing payment for same and receiving the difference between the factory price and the price at which he sold them (Rec., pp. 206-208, Qs. 30-36; pp. 2481-2, XQs. 220-223). These "Howard" pianos were sold by Mr. Howard in the principal cities of the United States (Rec., p. 2409, Q33; p. 2425, XQs. 132-138; p. 2494, Q60; Applicant's Exhibit 112 Rec., pp. 786-792; p. 2523, XQs. 245-252; p. 476, Q53; p. 529, Qs. 11-13).

Judge Hough finds that

> "there were thousands sold under the title 'R. S. Howard & Co.,' 'Howard, New York,' 'Howard & Co., Boston,' and 'R. S. Howard & Co., Boston'" (Rec., p. 2636, fol. 2713).

Judge Hough finds that:

> "No other salesman except Howard sold pianos with the 'Howard' mark upon them. * * * There is no doubt that from the time any variant of 'Howard' was inscribed upon pianos, the retail trade, the user and the public generally spoke of them as 'Howard' pianos" * * * (Rec., p. 2636, fol. 2712).

The New England Piano Company never claimed to own the mark or brand "Howard" for pianos, but, on the contrary, recognized that it belonged to Robert S. Howard (Rec., p. 2455, Qs. 63-64; p. 154, Qs. 41, 42; p. 2422, Q111; p. 2030, Q10; p. 2043, XQs. 88, 89).

In 1896 the New England Piano Company became financially embarrassed and stopped the manufacture of all pianos for about a year and a half (Rec., p. 207, Q. 34, p. 268, XQ. 302; p. 2414, Qs. 61-63; p. 2421, Qs. 107-10; p. 2451, Qs. 38-46; p. 2477, XQs. 198-200; p. 96, RDQs. 224-226; p. 2495, Qs. 67-77; p. 2537, XQs. 335-339).

The record contains photographs of three of these pianos sold by Robert S. Howard prior to 1896 (Rec., pp. 477, 1000, 287, 1001; Applicant's Exhibits 8, 9, 10, 11, 12, 25, 26).

The record contains the testimony of forty-eight witnesses who knew about or dealt in "Howard" pianos sold by Robert S. Howard and R. S. Howard Company, all of whom testified that such pianos were always known and designated as "Howard" pianos. Thirty-five of these witnesses sold or handled pianos marked "Howard" (either "Howard," "R. S. Howard & Co." or "Howard & Co.") bought from Robert S. Howard PRIOR to 1896. The following are the names of these witnesses: Leander S. Sherman, San Francisco, Cal. (Rec., p. 465); Frank T. Bowers, Belvedere, Cal. (Rec., p. 502); Erastus P. LaSalle, Richmond, Cal. (Rec., p. 521); Frank Anrys, San Francisco, Cal. (Rec., p. 528); Joseph E. Whitney, Portland, O. (Rec., p. 537); Frank J. Hart, Los Angeles, Cal. (Rec., p. 442); A. G. Bartlett, Los Angeles, Cal. (Rec., p. 456); I. W. Gardner, Los Angeles, Cal. (Rec., p. 392); J. F. Sayler, Los Angeles, Cal. (Rec., p. 400); Edward A. Geissler, Los Angeles, Cal. (Rec., p. 360); F. W. Blanchard, Los Angeles, Cal. (Rec., p. 417); Geo. S. Marygold, Los Angeles, Cal. (Rec., p. 431); Wm. S. Lanneau, Charleston, S. C. (Rec., p. 310); John F. Greer, Charleston, S. C. (Rec., p. 328); Platt P. Gibbs, Chicago, Ill. (Rec., p. 580); Orvin L. Fox, Chicago, Ill. (Rec., p. 568); Joseph A. Stewart, Atlanta, Ga. (Rec., p. 698); Charles A. Schlichter, Burlington, Ia. (Rec., p.

599); James Vaughn, Detroit, Mich. (Rec., p. 733); Edwin A. Kieselhorst, St. Louis, Mo.)Rec., p. 771); Benjamin B. Crow, Atlanta, Ga. (Rec., p. 1861); John E. Mulvey, Boston, Mass. (Rec., p. 1986); Noble E. Hill, Boston, Mass. (Rec., p. 2016); J. H. Bremner, San Francisco, Cal. (Rec., p. 2092); Charles H. Dewing, Oakland, Cal. (Rec., p. 2109); George A. Heidinger, Portland, O. (Rec., p. 2182); Fergus Coalter, Salt Lake City, Utah (Rec,. p. 2204); William B. Turlington, Jr., Baltimore, Md. (Rec., p. 628); George B. Kennedy, Washington, D. C. (Rec., p. 650); Percy S. Foster, Washington, D. C. (Rec., p. 678); William C. Dierks, Pittsburgh, Pa. (Rec., p. 612); George J. Dowling, Chicago, Ill. (Rec., p. 592); Sheridan Daboll, Rochester, N. Y. (Rec., p. 99); William P. Bubel, Rochester, N. Y. (Rec., p. 861); Benjamin S. Wise, New York City (Rec., p. 106); Frederick G. Howe, Springfield, Mass. (Rec., p. 124); Arthur A. Sternberger, Philadelphia, Pa. (Rec., p. 137); Frederick A. Hindermister, Scranton, Pa. (Rec., p. 194); Herbert G. Reed, Portland, O. (Rec., p. 548); Hjalmar J. Carlson, Denver, Colo. (Rec., p. 559); George W. Markens, Brooklyn, N. Y. (Rec., p. 118); John L. Stowers, Havana, Cuba (Rec., p. 688); Thomas F. Scanlon, Boston, Mass. (Rec., pp. 67, 2446); George J. Mulcahy, Boston, Mass. (Rec., pp. 145, 2406); William J. Simonson, Ann Arbor, Mich. (Rec., p. 706); George J. Husbands, Boston, Mass. (Rec., p. 2028); Walter L. Ishelman, St. Joseph, Mo. (Rec., p. 2249); Robert S. Howard, New York City (Rec., pp. 200, 2487).

Beginning in December, 1896, Mr. Howard testifies that he obtained "Howard" pianos on the same general plan and basis from D. H. Baldwin & Company of Cincinnati; these pianos were made by The Ellington Piano Company of Cincinnati, O.

1896 to December 31, 1898: Robert S. Howard continued with J. & C. Fischer, as before, up till January 1st, 1898, and then with the Schuberts and Sohmer & Company, piano manufacturers, till December 31, 1898; during all this period Robert S. Howard continued to sell "Howard" pianos on his own account and risk made by The Ellington Piano Company, Cincinnati, Ohio, and furnished to him at a fixed factory price, under an arrangement similar to that which he had with the New England Piano Company (Rec., pp. 2496-9, Qs. 79-93; p. 2527, XQs. 266-270; p. 2529, XQs. 276-278; p. 206, Qs. 30-39; pp. 2502-03, Qs. 127-131).

Robert S. Howard had no connection or business arrangements of any kind with D. H. Baldwin & Company or any of its allied concerns, except the arrangement respecting these "Howard" pianos, until January 1, 1899; up to January 1, 1899, he was still employed by the Fischers, Schuberts and Sohmer & Co., selling "Howard" pianos on the side. All "Howard" pianos made by the Baldwin concerns for a number of months after Mr. Howard made his arrangements with them were sold by Mr. Howard; after several months, stray "Howard" pianos began to be sent from time to time to the retail stores of D. H. Baldwin & Co. Mr. Howard's letters and orders in evidence (Applicant's Exhibit 117 and Registrants' Exhibit 229) show that the prices at which Mr. Howard sold these "Howard" pianos were fixed by Mr. Howard and varied as between different dealers, and the books of the Ellington Piano Co. show that he was credited with the difference between the fixed factory price and his selling prices, varying from $2.50 to $15.00 per piano (Registrants' Exhibit 31, Rec., pp. 1348-51).

January 1, 1899, to March 31, 1902: Beginning January 1, 1899, Robert S. Howard was associated with D. H. Baldwin & Co. selling their several grades

of pianos under a salary, expense and profit-sharing agreement, whereby the several grades of pianos of the Baldwin concerns were supplied at fixed factory prices, and Mr. Howard's business kept in a separate account. Mr. Howard received a salary and expense account and a large exclusive territory. After the profits earned equalled the salary and expense account, Mr. Howard was to receive all profits up to $1,700. and also a percentage of all profits after that amount had been earned. The selling arrangement covering the "Howard" pianos was placed in a separate paragraph of the contract, Mr. Howard retaining the exclusive territory of the whole United States for "Howard" pianos *"excepting"* a certain limited territory in the Central West, immediately contributory to D. H. Baldwin & Co.'s retail stores. The factory prices of the different makes of pianos were changed from time to time, the selling price of all grades of the pianos was fixed by Mr. Howard, and the account was charged with all bad debts. The agreement is printed Rec., pp. 1065-1070, and was terminated by Mr. Howard, according to its terms, on March 31, 1902 (Rec., pp. 2498-9, Qs. 92, 93).

April, 1902, to the present time: Robert S. Howard organized the R. S. Howard Company in April, 1902, became its president, general manager and active executive head, and has continued as such to the present time. This company forthwith acquired a complete piano factory in the City of New York, and also the business, good will, trade-name and trademarks of Robert S. Howard, and immediately after its organization began the manufacture of pianos which were marked "Howard" and "R. S. Howard Co." on their fallboards; this company has continued the manufacture of pianos continuously since 1902, which have been sold in the principal cities of the United States from the Atlantic to the Pacific, north and south, and also in a long list of foreign countries

(Rec., pp. 2498-2500, Qs. 91, 94, 105; p. 200, Qs. 2-8; p. 2121, Q59; p. 119, Q10; p. 122, XQs. 27-33).

THIS RESPONDENT DAMAGED.

I.

Respondent damaged by appellants' intimidating letters to respondent's customers.

The Record shows that appellants have been sending threatening and intimidating letters to respondent's customers claiming rights under trade-marks "duly registered by us in the United States Patent Office," and "will take all necessary steps to protect our rights against infringement."

Samples of these threatening and intimidating letters are set out in Applicant's Exhibit 111 (Rec., p. 960) admitted to have been written and sent by The Baldwin Company (Rec., p. 2300, XQs. 91-94).

It is respectfully submitted that any use by appellants of the registrations sought to be cancelled which threatens to cause damage or injury is sufficient to give respondent a standing to cancel.

Any conduct or language which influences or tends to influence customers or the public to withdraw or withhold its custom from respondent is damage and injury.

It is immaterial whether such effect is produced by persuasion, by threats, or by falsehood. *Am. Wells Works Co. vs. Layne & Bowler Co.*, 241 U. S. 257.

In the case at bar, appellants threaten respondent's customers with the penalties incurred under the statutes for infringing registered trade-marks, such registration being *prima facie* valid. This is obviously a

threatened injury and damage, directly founded upon the improper registrations.

It must be presumed that the public and respondent's customers know the additional penalties imposed for infringing a registered trade-mark and the burdens imposed by registration.

The direct and obvious purpose of the letters was to intimidate respondent's customers, threaten them with litigation, and cause them to cease to buy respondent's pianos. However vague the language of such intimidating letters may be, to intelligent business men they have no doubtful meaning and their purpose and result are plain.

> "Why it is to intimidate these people or prevent them from dealing in complainant's beer. That far it is oppressive of the business of complainant and tends to destroy its business. There is no question about that, insofar as it would intimidate these people. It must be remembered that there are many timid people in this world, who would be much influenced by danger of even small losses." *Seattle Brewing Co. vs. Hansen*, 144 Fed. 1011, 1014.

Anything that unfairly obstructs or unlawfully interferes with appellant's business would be an injury and its continuance *a menace*. To disturb or annoy, or to threaten with annoyance or injury, is an actionable wrong.

> "Nor does it matter whether the wrongdoer effects his object by persuasion or by false representations.
>
> "Now, intentionally to do that which is calculated in the ordinary course of events to damage another in that other person's property or trade, is actionable, if done without just cause or excuse. Such intentional action when done without just cause or excuse, is what the law calls malicious wrong." * * *

> "Loss of business is the only natural result to be expected from such action and if continued the failure of the enterprise would inevitably follow." *Barr vs. Essex Trades Council*, 30 Atl. Rep. (N. J. Eq.) 881, 886. 887.

Nor is it essential that the statement contained in the circular or letters be false, or in disparagement of respondent's business; it is sufficient if the scheme of using improper registrations is used to intimidate respondent's customers and as a continuing menace to all who would deal or wish to deal with respondent. Such is, in substance, the language (paraphrased) of the Courts in *Barr vs. Essex Trades Council*, 30 Atl. Rep. (N. J. Eq.) 881, and *Sherry vs. Perkins*, 147 Mass. 212, both cited with approval in *Seattle Brewing Co. vs. Hansen*, 144 Fed. 1011.

In *Emack vs. Kane*, 34 Fed. 47 (a case cited with approval in a number of instances by the U. S. Circuit Court of Appeals), the defendant sent circulars to plaintiff's customers threatening to bring suit against them for infringement of patents. In granting an injunction, Judge Blodgett, among other things, said:

> "Statements and charges intended to frighten away a man's customers, and intimidate them from dealing with him, may wholly break up and ruin him financially."
>
> * * * * *
>
> "The average business man undoubtedly dreads, and avoids, if he can, a lawsuit of any kind, and a suit for infringement of a patent is so far outside of the common man's experience that he is terrified by even a threat of such a suit." The Court might with equal truth have said the same of a trade-mark infringement suit.

In *Racine Paper Goods Co. vs. Dittgen*, 171 Fed. (C. C. A.) 631, the defendant had been circulating among plaintiff's customers and the trade generally,

by letters and otherwise, representations that plaintiff was infringing defendant's letters patent. After citing with approval *Emack vs. Kane*, 34 Fed. 47, *Farquhar Co., Ltd., vs. National Harrow Co.*, 102 Fed. (C. C. A.) 714, *Advance Platt & Co. vs. National Harrow Co.*, 121 Fed. (C. C. A.) 827, the Court in granting an injunction, said:

> "In the cases cited, *supra*, the means employed to injure the business of the three complainants was by circulars, addressed to the trade differing from the acts of appellant herein more in volume and method of distribution than in substance. The distinction goes to the degree of certainty in establishing the malicious motive, not to the question of amount of damage sustained. In other words, it requires no prolonged or extensive series of damaging assaults upon one's business to call into service the restraining hand of the law, provided it satisfactorily appears that the acts are done with the purpose of injuring the business, and have injured, and are calculated to injure. When this is proven, fraud will be implied." (See also decision below, 164 Fed. 85, and *Kidd vs. Horry*, 28 Fed. 773, Mr. Justice Bradley.)

In *Ogilvie Co. vs. Merriam Co.*, 149 Fed. 858, both parties were enjoined from sending out circulars, the Merriam Co. from sending out circulars to the effect that they had the exclusive right to the use of the name "Webster" in the title of dictionaries, and the Ogilvie Co. from sending out circulars conveying the impression that their book was published by the Merriam Co.

In *Drake Hardware Co. vs. Wrought Iron Range Co.*, 78 N. Y. Supp. 1114, the injunction (approved on appeal) contained the following language which was approved in *Spaulding vs. Everson*, 149 Fed. 913:

> "It is hereby ordered that said defendants * * * be and they are hereby restrained, prohibited and enjoined * * * from resorting to

> any species of threats, intimidations, coercion or force, for the purpose of preventing plaintiff from selling its stoves and ranges and carrying on its business * * *."

In *Am. Wells Works Co. vs. Layne*, 241 U. S. 257, the defendant wrote letters to plaintiff's customers claiming that plaintiff's pump infringed defendant's rights, whereupon plaintiff sued the defendant for damages to its business caused by such threats. In sustaining plaintiff's declaration as disclosing a good cause of action, Mr. Justice Holmes, speaking for this Court, said:

> "It is evident that the claim for damages is based upon conduct, or more specifically, language, tending to persuade the public to withdraw its custom from the plaintiff and having that effect to its damage. Such conduct having such effect is equally actionable whether it produces the result by persuasion, by threats, or by falsehood. *Moran vs. Dumphy*, 177 Massachusetts 485, 487. And it is enough to allege and proves the conduct and effect, leaving the defendant to justify if he can.
>
> "Finally, we see no sound distinction between persuading by malevolent advice and accomplishing the same result by falsehood or putting in fear. * * * It appears to us not to matter which motive is relied upon. If accomplishing the end by one of them is a wrong to the plaintiff, accomplishing it by either of the others must be equally wrong.
>
> "It follows from what we have said that we are of the opinion that both counts of the declaration disclose a good cause of action * * *." *Rollman Mfg. Co. vs. Universal Hardware Works*, 238 Fed. (C. C. A.) 568.

II.

Respondent damaged by appellants' suit for infringement of registrations, which suit may be renewed against respondent or its customers at any time.

In *Elgin National Watch Co. vs. Illinois Watch Case Co.*, 179 U. S. 655, this Court expressed the inevitable damage resulting from improper registrations in the following language:

> "Thus it is seen that under the act registration is *prima facie* evidence of ownership; that the certificate is evidence in any suit or action in which the registered trade-mark is brought in controversy; that the act practically enables treaty stipulations to be carried out and affords the basis for judicial redress for infringement in foreign countries, where such redress cannot ordinarily be had without registration, * * * though the benefit of the act cannot be availed of if the alleged trade-mark is not susceptible of exclusive ownership as such, and not, therefore, of registration.
>
> "Should registrants be permitted to retain their registration they would be * * * in a position to institute expensive and troublesome litigation basing their suits upon said registration and attacking both the petitioner's purchasing trade as well as the purchasing public in general, and they would be in a position to threaten and intimidate the purchasing public. In this way the business of petitioner would be seriously and permanently damaged; its sales * * * would necessarily fall off, * * * and the trade and business of petitioner would be seriously injured were the registrants to be allowed to retain their registration * * *." *Electro Steel Co. vs. Lindenberg Steel Co.*, 43 App. D. C. 270.

In *Old Kentucky Club D. Co. vs. Kentucky D. & W. Co.*, 234 Fed. 464 (affirmed on the opinion below, 247 Fed. 1005), plaintiff sought to register "Old Kentucky Club" for whiskey. Defendant opposed, claiming to be the owner of "Kentucky Club" as a mark for whiskey. The Court found that the marks were simliar, that plaintiff was the prior user, but had lost the *exclusive* right through laches, and that the defendant would be damaged by the registration. The Court said (p. 469):

> "It is urged by the plaintiff that as it has shown a prior adoption and use of the mark, and as the registration thereof would be only *prima facie* evidence of ownership, the defendant could not be damaged by the registration, because it would have the same right to assert the defense, which it now urges, in any suit which might be brought for an infringement of the trade-mark so registered, as if it were not registered. There are, I think, several answers to this contention. * * *
>
> "Under any of these theories the defendant would be damaged by the registration of the trade-mark, because it would confer upon the plaintiff a right to which it is not entitled, and which it could assert against the defendant, namely, a *prima facie* title. * * * In addition, I can readily see that damage would result to the defendant if the plaintiff were permitted to register this trade-mark, because in any suit hereafter brought against the defendant for infringement thereof the burden of disproving the plaintiff's title to the trade-mark as against the defendant would be cast upon the latter."

In *Heaton-Peninsular Button Fastener Co. vs. Independent Button Fastener Co.*, 43 App. D. C. 264, 124 Ms. Dec. 396, *Familton vs. Alonzo Bliss Co.*, C. D. 1908, 189, *Hydraulic Press Brick Co. vs. Hocking Valley Products Co.*, 120 Ms. Dec. 196, and in *Needham Tire Co. vs. Hood Rubber Co.*, 124 Ms. Dec. 396, held that suing or threatening to sue was "damage"

and a "sufficient interest in the subject-matter" to cancel.

> "It is not at all necessary to show that the Denny Company used the mark as a trade-mark. It was sufficient that it had had any rightful use inconsistent with its rival's registration (*Tim & Co. vs. Cluett, Peabody & Co.*, 42 App. D. C. 222); * * * Moreover, it is not here material how the attacking party has used the mark since it is attacking in self-defense, having been charged by the Dennison Company, the registrant, with so using the mark as to infringe its own apparent rights under the registration in question and threatened with suit therefor (Denny Exhibit No. 28). The registration is itself a standing threat, interfering with the exercise by the Denny Company of its right to use the mark in some way, and this is an injury." *Denny Tag Co. vs. Dennison Mfg. Co.*, 258 O. G. 221; affi. 48 App. D. C. 213.

III.

Respondent damaged by the registrations because the registrations are prima facie evidence of exclusive ownership of a valid trade-mark of the name "Howard."

Registrations of the name "Howard" being *prima facie* evidence of *exclusive* ownership of a *valid trade-mark* of the name "Howard," registrant would be *prima facie* entitled to the exclusive use of "Howard" in any form, whether used *simpliciter*, or with prefixes or with suffixes; the use of "R. S. Howard Co." by respondent would be, *prima facie*, an infringement.

Thad. Davids Co. vs. Davids, 223 U. S. 461.
Elgin Nat'l Watch Co. vs. Illinois Watch Case Co., 179 U. S. 665.
Rice-Stix Dry Goods Co. vs. Schwarzenbach-Huber Co., 47 App. D. C. 249.

"The question is always commercial; we ought not to impose any burdens which * * * will operate to give the plaintiff such advantage in the market as will substantially handicap his competitors." *Shredded Wheat Co. vs. Humphrey Cornell Co.*, 250 Fed. (C. C. A.) 960.

"If registration be allowed it becomes *prima facie* evidence of the applicant's ownership of it as a valid trade-mark, under Section 16 of the Act, in any action which he may institute against the opposer or others who may use the word as a general trade name for similar articles of goods." *Johnson vs. Brandau*, 32 App. D. C. 348, 351.

It has been said by this Court that one entitled to register his mark should not be deprived "of the benefits of the statute" (*Beckwith vs. Commissioner of Patents*, 40 Sup. Ct. Rep. 414, 417). May it not be said with equal force that no one should be subjected to the penalties of the statute by reason of illegal, improper or improvident registrations? It would seem obvious that no one should be allowed "to enjoy the benefits of the statute" to the disadvantage, damage and injury of another, unless entitled to registration.

Guth vs. Guth Chocolate Co., 224 Fed. (C. C. A) 932, and cases cited under heading V.

IV.

Respondent damaged by registration of the personal name "Howard."

The improper registration of the name "Howard" will be PRESUMED to damage any person or concern entitled to use the name "Howard," in any form,

as a trade name or business name, in the same line of business. Confusion is inevitable and damage is obvious. See cases under heading V.

Thad. Davids Co. vs. Davids, 233 U. S. 461.

V.

Damaged by registration because of similarity of "Howard" and "R. S. Howard Co."

Respondent has been adjudged entitled to use "R. S. Howard Co." and "R. S. Howard Company" and to so mark its pianos (Rec., p. 2842).

The pianos bearing the name "Howard," or any name of which the name "Howard" formed a part, have always been called "Howard" pianos by practically everybody, because "Howard" was the dominant feature of the name on the fallboard; and this was true whether it was "Howard, New York," or "R. S. Howard & Co., Boston" or "Howard & Co., Boston," or "R. S. Howard Co., New York." Whichever of these markings was used, the piano was referred to and distinguished as a "*Howard*" piano, that is, by the dominant feature of the name.

> "There is no doubt that from the time any variant of 'Howard' was inscribed upon pianos the retail trade, the user, and the public generally spoke of them as 'Howard' pianos" (Opinion of Judge Hough, Rec., p. 2636, fol. 2712).

Prefixes and suffixes are entirely disregarded by the trade and public generally (see Testimony of Armstrong, Appellants' President, Rec., p. 2396, XQs. 143-145; Dickinson, Appellants' Vice President, Rec., p. 1807, XQ64; p. 1809, RDQ75; p. 1810, RXQ77;

Chas. H. Steinway, of Steinway & Sons, Rec., pp. 804-806, Qs. 9-14; Geo. J. Dowling, president of the Cable Company, Rec., p. 593, Q11).

In *Guth vs. Guth Chocolate Co.*, 224 Fed. (C. C. A.), 932, the Court said:

> "It is the surname which catches the public, and few purchasers would notice the difference between one form and the other. In the nature of things confusion was inevitable."

In this connection, the case of *Thad. Davids Co. vs. Davids*, 233 U. S. 461, becomes conclusive. In this *Davids* case the mark registered was "Davids," under the ten-years' clause. The Circuit Court of Appeals held the trade-mark valid (178 Fed. 801), but held that there was no infringement of the registered mark by the use of "C. I. Davids Co." (192 Fed. 915). The Supreme Court, in reversing this decision and holding the registered mark infringed, said (p. 469):

> "The further argument is made that, assuming that the complainant has a valid registered trade-mark, still the protection is limited to its use when standing alone (as the complainant has used it on its labels) and that there can be no infringement unless it is used in this precise manner. The statutory right cannot be so narrowly limited. Not only exact reproductions, but a 'colorable imitation' is within the statute: otherwise, the trade-mark would be of little avail as by shrewd simulation it could be appropriated with impunity * * *. Moreover, in view of this statutory right, it could not be considered necessary that the complainant in order to establish infringement should show wrongful intent in fact on the part of the defendant, or facts justifying the inference of such an intent (citing cases). Having duly registered under the act, the complainant would be entitled to protection against any infringing use; * * *.
>
> "We agree with the Circuit Court that infringement was shown. The complainant put

its mark 'Davids' prominently at the top of its labels. The defendant, in the same position on its labels, put 'C. I. Davids Co.' At the bottom of their labels the defendants placed 'Davids Mfg. Co.' The use of the name in this manner was a mere simulation of the complainant's mark which it duly registered; it constituted a 'colorable imitation' within the meaning of the Act.

"A validly registered trade-mark cannot be used, either in part or as a whole, by any other than the owner, even with words explaining that the article to which it is attached is not manufactured by the owner of the trade-mark." *Manitou Spring Co. vs. Schueler*, 239 Fed. (C. C. A.) 593.

In re Hoff, 30 App. D. C. 233.

William P. Stark vs. Stark Bros., 257 Fed. (C. C. A.) 9.

Ammon & Person vs. Narranganiett Dairy Co., Ltd., 252 Fed. 276.

Nashville, etc., Co. vs. Coca Cola Co., 215 Fed. 527.

"Davids" infringed by "C. I. Davids Co." and "Davids Mfg. Co." *Thad. Davids Co. vs. Davids*, 233 U. S. 461.

"William P. Stark Nurseries" infringes the registered trade-mark "Stark Trees." *Wm. P. Stark vs. Stark Bros.*, 257 Fed. (C. C. A.) 9.

"Tucker" and "J. C. Tucker" similar and confusing. *Brown-Forman Co. vs. Beech Hill Dist. Co.*, 30 App. D. C. 485.

"Taylor," "Old Taylor," "G. A. Taylor," "Kentucky Taylor," were all held to be similar and confusing. *In re Wright*, 33 App. D. C. 510.

"Lexington Club" and "Old Lexington Club" held to be similar and in conflict. *Kentucky Dist. & W'arch. Co. vs. Old Lex. Club Dist.*, 31 App. D. C. 223.

"Hoff" and "Leopold Hoff" so similar as to create confusion. *In re Hoff*, 30 App. D. C. 233.

"J. Hilton, Prop." and "Hilton Company" held deceptively similar. *Hilton vs. Hilton,* 105 Alt. Rep. 65 (*N. J.*).

"Queen" and "Queen of the West" held to conflict. *Ammon & Person vs. Narragansett Dairy Co., 252* Fed. *276.*

"Myers" and "H. M. Myers" substantially similar and in conflict, and the goods would be known as "Myers' Shovels." *Ex parte Ames Shovel & Tool Co.,* 120 Ms. Dec. *242.*

"Guth" and "Guth Chocolate Co.," similar and confusion inevitable. *Guth vs. Guth Chocolate Co.,* 224 Fed. (C. C. A.) 932.

It was not necessary for the complainant to attempt to discover whether a purchaser had been actually deceived, for a manifest liability to deception exists. *Tacad Stickefabriks Aktiebolagat Vulcan vs. Myers,* 139 N. Y. 364; *Manufacturing Co. vs. Trainer,* 101 U. S. 51, 25 L. Ed. 993; *Biscuit Co. vs. Baker* (C. C. A.) 95 Fed. 135; *Fuller vs. Huff.* 104 Fed. (C. C. A.) 141.

VI.

Respondent damaged by registration of the name "Howard," the dominant feature of respondent's corporate name.

Respondent was incorporated in April, 1902 (Rec., p. 200, Q5).

Appellants have admitted throughout these proceedings that the respondent is entitled to use "R. S. Howard Co." and "R. S. Howard Company" as a mark for its pianos (*e. g.,* Rec., p. 1138); it is so adjudicated in the suit in the Second Circuit which is relied on by the appellants.

Confusion (which implies damage as a matter of law) is inevitable and obvious:

> "We agree with the Circuit Court that infringement is shown (between 'Davids' and 'C. I. Davids Co.')."
> *Thad. Davids Co. vs. C. I. Davids Co.*, 233 U. S. 461.
> *Guth vs. Guth Chocolate Co.*, 224 Fed. (C. C. A.) 932.
> *Mfg. Co. vs. Trainer*, 101 U. S. 51.

Where a name or mark is the dominant and distinguishing feature of the corporate name of a corporation which was incorporated prior to the use of the word or name as a trade-mark, damage and injury to the corporation will be implied as a matter of law, and a sufficient showing of "interest in the subject-matter" made.

> *Asbestone Co. vs. The Philip Carey Mfg. Co.*, 41 App. D. C. 507.
> *Mansfield Tire & Rubber Company vs. Ford Motor Company*, 44 App. D. C. 205.
> *In re United Drug Co.*, 222 O. G. 729; 44 App. D. C. 209.
> *D. H. Burrell & Co. vs. Simplex Electric Heating Co.*, 44 App. D. C. 452.
> *N. Wolf & Sons vs. Lord & Taylor*, 41 App. D. C. 514.
> *Investor Pub. Co. vs. Dobinson*, 72 Fed. 603.

Furthermore, the Trade-Mark Act of 1905 (Sec. 5) expressly prohibits the registration as a trade-mark of a common surname, except under circumstances not prevailing in these cases.

VII.

Damage to R. S. Howard Co.'s foreign business by appellants' foreign registrations of "Howard."

The Baldwin Company admits that it has registered the name "Howard" as a trade-mark for pianos in a number of foreign countries and at the time this admission was made applications were pending for registration in a number of other foreign countries (Rec., pp. 820, 821).

Frank A. McGee, appellants' auditor, in December, 1915, testified that the word "Howard" had been registered as a trade-mark for pianos in Argentine Republic, Brazil, Panama, Colombia, Italy and Mexico (Rec., p. 879, Q9). All these registrations had been applied for since these proceedings were begun (Alice G. Donegan's testimony, Rec., p. 2368, XQ8), and that a number of other applications were pending in April, 1916 (Rec., p. 2368), and that some fifteen applications had been filed, many of them based on the United States registration (Miss Donegan's testimony, Rec., p. 2368, XQs. 10, 11).

Appellants' answer contains the following (Rec., p. 1074):

> "* * * admits that it has applied to register and has secured registration of the word 'Howard' as a trade-mark for pianos in many foreign countries; admits that applications to register the trade-mark 'Howard' are now pending in certain foreign countries; * * * admits that the applications to register the word 'Howard' as a trade-mark for pianos in some foreign countries are based upon its United States Registration No. 46,993; admits that registration in the United States is a necessary prerequisite to registration in certain foreign countries; * * * admits that in certain foreign countries in which applica-

tions have been made to register its trade-mark 'Howard' for pianos, persons selling pianos bearing an infringing trade-mark are liable to criminal prosecution." * * *

Respondent's Foreign Business.

ROBERT S. HOWARD, president and manager of R. S. Howard Company, testified that immediately after the company was organized in 1902, it began the sale of pianos in this and foreign countries and that since 1902 they have been sold extensively "throughout the world" (Rec., p. 212, Q59). He testified that these pianos from the beginning were marked "Howard" and "R. S. Howard & Co." (some one way, some the other, indiscriminately) and that said markings had been continued ever since (Rec., p. 293, RDQs. 418-422; p. 210, Qs. 50-55).

GEORGE W. MARKENS, who has looked after the selling and shipping of pianos made by the R. S. Howard Company since 1903, testified (Rec., p. 119):

"Q10. In what countries have you sold or arranged a sale of the pianos made by the R. S. Howard Company of New York? A. Argentine Republic, Brazil, Chile, Panama, Colombia, Spain, Portugal, France, Italy, Belguim, Australia, New Zealand, India, Japan, and have been attending to all their export shipping and requirements in Cuba and Mexico and Porto Rico."

ROBERT S. HOWARD testified (Rec., p. 2548):

"Q398. Will you please tell us why the R. S. Howard Company began the cancellation proceedings in the United States Patent Office, which has been referred to in the testimony in this action, the record of which has been filed in this case? A. Because of troubles that started in Cuba in connection with the

business there. After doing business there about twelve years, shipping in several thousands of instruments, and having as a matter of record in the Custom House eighty per cent of the business of Cuba, the Howard piano was the easiest instrument to sell there, and one of my dealer's agents started in business for himself and got the pianos manufactured by the plaintiff in this action.

"Q400. Do you know whether in connection with activities in selling pianos in Cuba, the plaintiff company did anything to oust you, or prevent you from selling your pianos in Cuba? A. They did, in applying for a trade-mark on the Howard name.

"Q401. For pianos? A. For pianos.

"Q403. What was the advice given you, or R. S. Howard Company by its attorneys in Cuba, as to the effect of the registration of the name 'Howard' by The Baldwin Company in Cuba as a trade-mark for pianos? A. That the Howard pianos in possession of our dealers there would be attached, and he would be arrested and go to jail; the goods would be confiscated."

JOHN L. STOWERS, a retail piano dealer of Havana, Cuba, testified that he had been selling pianos made by the R. S. Howard Company throughout Cuba for eleven years, having twenty-two agencies in the island; that the biggest portion of the pianos received from R. S. Howard Company have been marked "R. S. Howard Co., New York," some with the word "Howard," but none marked "Howard," alone, in recent years (Rec., p. 688, Qs. 1, 2, 4, 11, 12, 25).

Mr. Stowers also testified (Rec. p. 697):

"Q1. Please state, if you know, what the effect would have been upon you personally, and upon your business, if that application to register the trade-mark 'Howard' by the Baldwin Company in Cuba, referred to in Applicant's Exhibit No. 109, had been consummated?

> "The Witness: The effect in Cuba is criminal for selling a piano that is suppposed to conflict with any other make of pianos, and my stock of pianos would have been taken by the agent of The Baldwin Company and confiscated, and I would have been subject to several years in prison."

Judge Hough, in his opinion in the Second Circuit, recognizes the damage and injury to respondent's business by reason of the registration of "Howard," and in refusing to enjoin the continuance of these cancellation proceedings now at bar, said:

> "I am inclined to think if this Court has the power, it is inadvisable to seek to prevent the continuance of the cancellation proceedings in the office.
>
> "It is plain to me that the object of these proceedings is primarily to get rid of something which constitutes an obstacle to the extension into certain foreign countries (*e g.*, Cuba and Uruguay) of the business of the R. S. Howard Company" (Rec., p. 2639, fol. 2721).

ARTHUR W. BARBER, 43 years old, a lawyer, educated in and familiar with the laws relating to trade-mark registration, trade-mark protection and trade-mark litigation in the United States and foreign countries, and widely recognized as an authority on the same, testified that this respondent would unquestionably, in his opinion, suffer damage in its business by the appellants' foreign registrations of "Howard." This testimony stands entirely uncontradicted or impeached.

Mr. Barber's testimony shows that:

(a) In a long list of foreign countries (20 odd) registration of a trade-mark cannot be made by a foreigner until registration is made in the foreigner's home country and a certified copy of the home registration included as a part of the application;

(b) The effect of registration in foreign countries is to prevent the sale of goods bearing marks similar, in whole or in part;

(c) The penalties for infringement are criminal, subjecting the seller to imprisonment, the stock of goods to confiscation, and the seller to a fine;

(d) What may be considered a "similar" marking is quite indefinite and undeterminable, but that any mark bearing any dominant features of the registered mark would be considered "similar";

(e) In most foreign countries the distinction between trade-marks and business names is not clearly understood, particularly in South American countries;

(f) The standing which a registered trade-mark in these countries gives would undoubtedly cause great injury and damage to a concern using a similar business name, with the probability of a ruined trade and years of expense of litigation before there could be any hope of securing from a Court the right to sell under a business name which in any degree bore resemblance to a registered trade-mark;

(g) Registration of a trade-mark in any country belonging to the International Trade-Mark Union, is generally secured *pro forma,* by submitting an application accompanied by a certified registration in the home country;

(h) Most of the principal countries of the world belong to the International Trade-Mark Union including Cuba, Brazil, Italy and Mexico.

Mr. Barber testified (Rec., p. 885):

> "Q4. If you know, please state which of the following countries, namely: Argentine Republic, Brazil, Panama, Colombia, Italy, Cuba and Mexico, if any, require, as a condition precedent to the registration of a trade-

mark in such country or countries by an Ohio corporation, prior registration in the United States and the submission of a certified copy of such prior registration in the United States as a part of the application before registration can be had in such foreign country or countries? A. I have had charge of trade-mark registration in all of these countries to the number of scores and probably hundreds in each country and am familiar with the requirements for registration for each of them. Under the circumstances indicated in the question, prior registration in the United States is required for Brazil, Panama, Colombia and Cuba.

"Q5. State, if you know, which of the countries enumerated in my last question, if any, make infringement of registered trade-marks a criminal or penal offense under their laws? A. In each of the countries enumerated in the last question the infringement of the trade-marks registered therein is a criminal or penal offense.

"Q6. State, if you know, in what foreign countries, if any, enumerated in the second preceding question, pianos made and offered for sale in such countries by a New York corporation, and bearing marks or names identical with, similar to, or imitations of, a trade-mark for pianos registered in such foreign countries by an Ohio corporation, would be subject to confiscation under the laws of such country or countries? A. In each of the countries enumerated, with the possible exception of Cuba. With respect to Cuba the trade-mark law makes no provision for the confiscation of goods under these circumstances, but I have been several times advised by Cuban attorneys that goods could be confiscated under the circumstances mentioned by virtue of the provisions of the Penal Code."

(Rec., p. 901):

"XQ40. * * * A. * * * I would certainly believe that the registration of the name

'Howard' in Brazil by The Baldwin Company, would give it the opportunity to do incalculable damage to the trade of the R. S. Howard Company in that country by lending countenance to threats that might be made against its agents and dealers in its goods and by affording a basis for criminal prosecutions and suits which might be successfully defended by the R. S. Howard Company, if it could persuade Brazilian Courts to accept the interpretation of the International Convention contained in my answer to Q39. Even in that event, however, it is clear that the R. S. Howard Company would be subjected to great expense and its business might be damaged considerably, if not irreparably, in the meantime. The idea I aim to convey is: that in all Latin-American countries the assertion of the rights theoretically clear in law is very expensive and may be made very difficult by any one who is able to entrench himself behind a shadow of right and able to command or willing to pay for political influence."

(Rec., p. 900):

"XQ39. * * * A. * * * It is, of course, always to be understood in dealing with Latin-American countries, that to have a right is one thing under their laws and to be able to enforce it is another thing."

(Rec., p. 906):

"XQ53. * * * A. I know no way that anyone can be prevented from making threats whether with or without foundation, but the important difference between the status of The Baldwin Company and of the R. S. Howard Company in Brazil, as disclosed in this examination, is, that The Baldwin Company has a certificate of registration of a trade-mark in Brazil consisting of the name 'Howard' and can produce a certificate as proof of its right to use the name before any court or tribunal, while the R. S. Howard Company, would be at a very great disadvantage without a cer-

tificate of registration and forced to rely upon the provisions of the International Convention. I would consider it a very difficult proposition to find a lawyer in Brazil who could properly appreciate the difference between a trade-mark and a trade name and recognize the right of the R. S. Howard Company as secured by the International Convention and having found him, I would consider that he would have a very difficult task to convince a court in that country of the justice of his view. In my experience there is only one Latin-American country where the principles of trade-mark law are understood or the nature of trade-mark rights are adequately recognized and that country is not Brazil, and is not among the countries referred to in my testimony."

(Rec., p. 931):

"XQ90. * * * A. * * * The registration of the name 'Howard' by The Baldwin Company might very readily be made the basis of proceedings in those (foreign) countries, or any of them, against dealers in the goods of the R. S. Howard Company, which proceedings made under color of trade-mark registration might be used to work great damage to the trade in the goods of the R. S. Howard Company. The timidity of dealers in the handling of goods the trade-mark on which is questioned or is the subject of dispute is very well recognized in all countries and is quite as pronounced in Spanish-American countries as in the United States."

(Rec., p. 932):

"XQ92. * * * A. The continued liability to such threats or proceedings would seem to me a very material present damage." * * *

(Rec., p. 932):

"XQ93. * * * A. There are very few decisions reported in accessible form in any of the countries of Latin-America. I have known

of a case with which I was occupied for a year or two in Brazil and in many other of the Latin-American countries in behalf of a client located in the United States who was doing business under his surname as a trade name and applying it to his goods in the form of his facsimile signature. A competitor in the United States obtained a registration in Brazil of a similar trade name, differing only from the one previously mentioned in that it terminated in the letter 'y' instead of 'ie.' By means of this registration in Brazil, the party in question was able to put my client to an expense of about two thousand dollars for the establishment of his rights, and to kill his trade in that country for more than a year and to such an extent that it has never recovered."

(Rec., p. 942):

"RDQ115. Please state what countries are members of the International Convention of 1883? A. Austria, Belgium, Brazil, Cuba, Denmark (including the Faroe Islands), Dominican Republic, Germany, Spain, United States, Hungary, France, including Algiers, Great Britain, Australia, Ceylon, New Zealand, Trinidad and Tobago, Italy, Japan, Mexico, Norway, Holland, Dutch East Indies, Surinam, Curacao, Portugal (including the Azores and Madeire), Servia, Sweden, Switzerland, Tunis, German Colonies. This is the list published by the International Bureau of Berne, Switzerland, under date of January 1, 1915. There have been no changes since that date, so far as I have been informed.

"RDQ116. Do you know of any changes that have occurred in 1914? A. There have been no changes, so far as I know, since January 1, 1909.

"RDQ117. For the convenience of the Commissioner of Patents, will you kindly read into the record Articles 6, 9 and 10 of the International Convention to which you have alluded in your testimony? A. The provi-

sions of Articles 6, 9 and 10 of the International Convention of 1883 are as follows:

(Rec., p. 943):

"'Article 6: Every trade or commercial mark regularly registered in the country of origin shall be admitted to registration and so protected in all the other countries of the Union.

"'The country where the registrant has his principal establishment shall be considered as the country of origin.

"'If its principal establishment is not located in one of the countries of the Union, the country to which the registrant belongs shall be considered as the country of origin.

"'The registration may be refused if the object for which it is asked is considered contrary to morals or to public order.

"'Article 9: Every product unlawfully bearing a trade or commercial mark or a commercial name, may be seized upon importation into those of the States of the Union in which this mark or this commercial name has a right to the protection of the law.

"'The seizure shall be made, either at the instance of the public prosecutor, or of the party interested, according to the domestic legislation of each state.

"'Article 10: The provisions of the preceding article shall be applicable to every product falsely bearing, as an indication of origin, the name of a definite locality, when this indication is joined to a fictitious commercial name or a name borrowed with a fraudulent intent.

"'Every manufacturer or trader engaged in the manufacture or trade in this product and established in the locality falsely indicated as the place of origin shall be regarded as an interested party.'"

For International Convention, or Trade-Mark Union, see *Singer on Trade-marks*, pp. 676, 683.

The petitions for writs of certiorari should be denied. The appeals should be dismissed for want of jurisdiction or the decisions below affirmed.

Respectfully submitted,

SAMUEL S. WATSON,
Attorney for R. S. Howard Company,
120 Broadway,
New York City, N. Y.

REGISTRANTS EXHIBIT No. 39

The Baldwin Company claims it used this marking for pianos prior to 1912.

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REGISTRANTS' EXHIBIT No. 40

87

Marking for Pianos which The Baldwin Company claims it has used since 1912.

REGISTRANTS' EXHIBIT No. 41

88

Marking for pianos which The Baldwin Company claims it has used since 1912.

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Homage

Edward W. Sparrow

REGISTRANTS' EXHIBIT No. 42

89

Marking for Player-Pianos which The Baldwin Company claims it has used since 1912.

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APPLICANT'S EXHIBIT No. 65

90

R. S. Howard Company claims to have used this marking for pianos since 1902 (except monogram.)

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B. J. HOWARD CO.
NEW YORK

Office Supreme Court, U. S.
FILED
DEC 13 1920
JAMES D. MAHER,
CLERK.

SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1920

No. 139

The Baldwin Company, et al., Appellants,

vs.

R. S. Howard Company.

Appeal from the Court of Appeals of the District of Columbia.

REPLY BRIEF FOR APPELLANTS.

It is a well settled principle of law, that in construing statutes all parts of the same statute must be taken together and, where possible, every clause given effect in such a manner as to produce a consistent and harmonious whole.

Section 13 of the Trade-Mark Act of 1905, c. 592, 32 Stat. 728, is as follows:

> "That whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The commissioner shall refer such application to the examiner in charge of interferences who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear

after a hearing before the examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the commissioner shall cancel the registration. Appeal may be taken to the commissioner in person from the decision of examiner of interferences."

This section is qualified by section 12, which provides in part:

"Certificates of registration in force at the date at which this Act takes effect shall remain in force for the period for which they were issued, but shall be renewable on the same conditions and for the same periods as certificates issued under the provisions of this Act, and when so renewed shall have the same force and effect as certificates issued under this Act."

And also by section 30, which provides as follows:

"That this Act shall be in force and take effect April first, nineteen hundred and five. All Acts and parts of Acts inconsistent with this Act are hereby repealed except so far as the same may apply to certificates of registration issued under the Act of Congress, approved March third, eighteen hundred and eighty-one, entitled, 'An Act to authorize the registration of trade-marks and protect the same,' or under the Act approved August fifth, eighteen hundred and eighty-two, entitled, 'An Act relating to the registration of trade-marks.'"

The excepting clause of section 30 relates only to

certificates of registration issued under the Acts of 1881, c. 138, 21 Stat. 502, and 1882, c. 393, 22 Stat. 298. The terms of this section taken in connection with section 12, would seem to indicate that certificates of registration procured under the Act of 1881 are to remain in force for the period for which they were issued, upon the terms prescribed by the Act of 1881, and that this period is not to be curtailed by any inconsistent provisions in the Act of 1905.

To secure the benefits of the Act of 1905, it is necessary to re-register the mark; and hence it would seem that if the Act is not retroactive as to its benefits and privileges it can hardly be retroactive as to its penalties. The Commissioner of Patents has authority under the Patent Act, to issue a second patent to an inventor who proves priority of invention over a prior patent, but he has no authority to cancel the prior patent. This was precisely the situation as regards trade-mark registration before the Act of 1905 went into effect, and we find nothing in the said Act of 1905 altering the situation as regards registrations effected under the Act of 1881.

We submit, therefore, that the Court of Appeals of the District of Columbia erred in holding that the Commissioner of Patents was authorized by the Trade-Mark Act of 1905 to cancel registration No. 31411, issued March 8, 1898, under the Act of 1881.

Lawrence Maxwell,
John E. Cross,
Counsel for Appellant.

THE BALDWIN COMPANY ET AL. v. R. S. HOWARD COMPANY.

THE BALDWIN COMPANY v. R. S. HOWARD COMPANY.

APPEAL FROM AND ON PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

Nos. 139 and 113. Argued January 14, 1921.—Decided April 11, 1921.

1. A decision made by the Court of Appeals of the District of Columbia upon an appeal from the Commissioner of Patents under § 9 of the Trade-Mark Act of February 20, 1905, is not reviewable in this court by appeal or certiorari under §§ 250, 251, of the Judicial Code,

since such decisions are merely certified to the Commissioner to govern his further proceedings in the case, as in patent matters (Rev. Stats., § 4914), and are not, therefore, final judgments. P. 38.

2. Assumption of jurisdiction by this court in a case where no question of jurisdiction was raised or considered, does not establish its jurisdiction over that class of cases. P. 40.

Appeal to review 48 App. D. C. 437, dismissed; petition for a writ of certiorari denied.

THE case is stated in the opinion.

Mr. Lawrence Maxwell, with whom *Mr. John E. Cross* was on the briefs, for appellants and petitioner.

Mr. Samuel S. Watson for appellee and respondent.

MR. JUSTICE DAY delivered the opinion of the court.

No. 139 is here upon an appeal from a decision of the Court of Appeals of the District of Columbia reversing the decision of the Commissioner of Patents.

No. 113 is an application for a writ of certiorari to review the same decision of the Court of Appeals of the District of Columbia. The case is reported in 48 App. D. C. 437.

The Commissioner of Patents refused to cancel the certificates of registration of a trade-mark consisting of the word "Howard" registered by the Baldwin Company, October 17, 1905, and made a like ruling refusing to cancel the certificate of registration of the word "Howard" arranged in monogram with the initials "V. G. P. Co." registered March 8, 1898, which marks were registered as trade-marks for pianos. The appeals were heard together in the District Court of Appeals upon the appeal of the Howard Company.

Proceedings were brought in the Patent Office by the Howard Company against the Baldwin Company to

cancel the certificates of registration. It appears that a suit was begun in the District Court of the United States for the Southern District of New York by the Baldwin Company against the Howard Company while the cancellation proceedings were pending, which resulted in a decree in favor of the Baldwin Company restraining the Howard Company from making or selling pianos bearing the word "Howard," but permitting it to use the marks "R. S. Howard Company" and "Robert S. Howard Company." 233 Fed. Rep. 439. This decree was affirmed by the Circuit Court of Appeals for the Second Circuit. 238 Fed. Rep. 154.

The Baldwin Company filed in the Patent Office a certified copy of the record in the federal courts in New York, and in the Patent Office the Examiner of Interferences and the Commissioner of Patents, on appeal to him, held that the adjudication in the New York courts was a bar to the claim of the R. S. Howard Company to cancel the certificates of registration of the trade-mark "Howard," and dismissed the petition of the Howard Company; thereupon, appeal was taken from the decision of the Commissioner to the Court of Appeals of the District. That court reversed the decision of the Commissioner of Patents, and directed the clerk to certify its decision as required by law.

The application in the Patent Office to cancel the trade-marks was under § 13 of the Trade-Mark Act of February 20, 1905, c. 592, 33 Stat. 728, which provides:

"SEC. 13. That whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The Commissioner shall refer such application to the examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the

examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the Commissioner shall cancel the registration. Appeal may be taken to the Commissioner in person from the decision of examiner of interferences."

The appeal from the decision of the Commissioner to the Court of Appeals of the District was under § 9 of the act, which provides: "SEC. 9. That if an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed opposition to the registration of a trade-mark, or party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the court of appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the Commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable."

A motion is made to dismiss the appeal. No specific provision is made for an appeal from the decision of the District of Columbia Court of Appeals reviewing the decision of the Commissioner of Patents, but the decision is to be certified to the Commissioner to govern further proceedings in the case. Section 4914, Rev. Stats.; 8 U. S. Comp. Stats., § 9459.

If the decision of the Court of Appeals of the District of Columbia is not final, then the motion to dismiss the appeal should be sustained, and we have no authority to grant a writ of certiorari. Judicial Code, §§ 250, 251.

The nature of proceedings of the character now under consideration was considered in *Frasch* v. *Moore*, 211 U. S. 1, in which the opinion of Chief Justice Alvey, speaking

for the Court of Appeals of the District of Columbia in *Rousseau* v. *Brown*, 21 App. D. C. 73, 80, explaining the nature of this statutory proceeding and affirming that it did not authorize a judgment but only the return by the Court of Appeals of a certificate to the Commissioner of Patents, to be there entered of record to govern further proceedings in the case, was fully approved.

In *Atkins & Co.* v. *Moore*, 212 U. S. 285, application for registration of a trade-mark was refused by the Examiner, which action was approved by the Commissioner, and affirmed on appeal by the Court of Appeals of the District of Columbia, an appeal and writ of error were allowed, both of which were dismissed in this court. The previous decisions of this court were reviewed by Chief Justice Fuller, speaking for the court, and in concluding the opinion he said: "In the light of the various details of the Act of February 20, 1905, and of the specific provisions of § 9, we were of opinion [*Gaines* v. *Knecht*, 212 U. S. 561] that proceedings under the act were governed by the same rules of practice and procedure as in the instance of patents, and the writ of error was accordingly dismissed. The same result must follow in the present case. Under § 4914 of the Revised Statutes no opinion or decision of the Court of Appeals on appeal from the Commissioner precludes 'any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question,' and by § 4915 a remedy by bill in equity is given where a patent is refused, and we regard these provisions as applicable in trade-mark cases under § 9 of the Act of February 20, 1905."

We are of opinion that the principle there announced controls this case. No provision is made which permits this statutory proceeding to be carried beyond the decision of the Court of Appeals of the District of Columbia, the decision of which court is directed to be certified to the Commissioner of Patents. It is in no sense a final

judgment reviewable here upon writ of certiorari or appeal.

It is true that in *Estate of Beckwith* v. *Commissioner of Patents*, 252 U. S. 538, this court allowed a writ of certiorari from a decision of the Court of Appeals of the District of Columbia, affirming a decision of the Commissioner of Patents, in an application to register a trade-mark. No question of the jurisdiction of the court was considered in that case, and an inadvertent allowance of the writ of certiorari does not establish the jurisdiction of the court. *Fritch, Inc.* v. *United States*, 248 U. S. 458, 463.

It follows that the appeal must be dismissed, and the petition for a writ of certiorari denied.

So ordered.